

United States  
Court of Appeals  
for the Ninth Circuit.

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WILLIAM J. DUBIL, EDWARD J. HUBIK and  
EARL F. SHORES,

Appellants.

vs.

RAYFORD CAMP & CO., and RAYFORD CAMP,  
Appellees.

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Transcript of Record

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Appeal from the United States District Court,  
Southern District of California,  
Central Division.



No. 12403

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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur.]

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In the United States District Court, Southern  
District of California, Central Division

In Equity No. 8649-Y

WILLIAM J. DUBIL, EDWARD J. HUBIK, and  
EARL F. SHORES,

Plaintiffs,

vs.

RAYFORD CAMP & CO., RAYFORD CAMP,  
JOHN DOE, JANE DOE, and JOHN DOE  
CO.,

Defendants.

BILL OF COMPLAINT—INFRINGEMENT OF  
UNITED STATES LETTERS PATENT No.  
2,052,221

The plaintiffs complaining of the herein named defendants allege:

I.

That the plaintiff William J. Dubil, a resident of Turlock, County of Stanislaus, State of California, is the inventor of the Method of Preparing Fresh Meat covered by U. S. Patent No. 2,052,221, hereinafter referred to as the patent in suit, and the said Dubil is the owner of an undivided one-half ( $\frac{1}{2}$ ) interest in and to the entire right, title and interest of the patent in suit. That the plaintiff Edward J. Hubik, a resident of North Long Beach, County of Los Angeles, State of California, is the owner of the other undivided one-half ( $\frac{1}{2}$ ) interest in and to the patent in suit, as shown by an instru-

ment of assignment duly recorded in the United States Patent Office prior to the issuance of said patent and as shown upon the face of said patent.

## II.

That on August 25, 1936, United States Letters Patent No. 2,052,221 were duly and legally issued to the plaintiffs Dubil and Hubik for an invention in Method of Preparing Fresh Meat; and since that date plaintiffs Dubil and Hubik have been and still are the owners of the said Letters Patent.

## III.

That the plaintiff Earl F. Shores, a resident of Los Angeles, County of Los Angeles, State of California, who is and has been doing business under the fictitious firm name of Chip Steak Company of Los Angeles, California, has the exclusive right to practice the method covered by said patent, throughout the County of Los Angeles, State of California, except the cities of Long Beach and Pomona, and except that territory which is bounded on the north by Slauson Avenue, on the south by Century Boulevard, on the west by Santa Fe Boulevard, and on the east by Atlantic Boulevard, the latter bounded territory lying wholly within the cities of Huntington Park and South Gate, in the County of Los Angeles, State of California. The County of Los Angeles, in the State of California (with the foregoing exceptions), is hereinafter referred to as said territory.

## IV.

That, upon information and belief, the above-

named defendants are citizens of California, and residents of the County of Los Angeles, State of California, and are carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co., that the true names of the defendants John Doe, Jane Doe and John Doe Co., are unknown to the plaintiffs at this time, but leave of court is requested to substitute their true names when ascertained by the plaintiffs.

#### V.

This Honorable Court has jurisdiction of the cause of action herein, as the same is a suit in equity arising under the patent laws of the United States. [3\*]

#### VI.

That the defendants have been and are infringing said Letters Patent in said territory by preparing, selling and using slices of fresh meat, prepared in accordance with the patented invention, and will continue to do so unless enjoined by this Court.

#### VII.

That the plaintiffs have placed the required statutory notice on sheets of paper separating slices of fresh meat prepared and sold by them under the patent in suit, and have given written notice to the defendants of their said infringement.

For a Second, Further and Additional Cause of Action Against the Defendants, the Plaintiffs Allege:

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\* Page numbering appearing at bottom of page of original certified Transcript of Record.

## VIII.

That the plaintiff Hubik originally adopted and used the trade-mark "Chip Steak" and registered same in the office of the Secretary of the State of California, at Sacramento, California, on September 14, 1936, Registration No. 20515, and ever since such date notice of registration thereof has appeared on the labels used successively by the plaintiffs Hubik and Shores, and each of them. That the label used by the plaintiff Shores since approximately May, 1938, in connection with the sale in said territory of thinly sliced fresh meat, has consisted of waxed paper sheets bearing the trade-mark "Chip Steaks," with the trade-mark "Chip Steaks" appearing on said labels in a curve or arch adjacent a prominent and central picture of the head of a beef animal. That plaintiff Shores has continuously since the latter date used said label in said territory by placing same between series of slices of thinly sliced meat produced in accordance with the patent in suit and sold by the plaintiff Shores in said territory. That the plaintiff Shores has continuously used said trade-mark and label in said territory since approximately May, 1938, which trade-mark and label have come to be associated with the [4] plaintiff Shores, in the mind of the public.

## IX.

That the defendants are and have been for some time using in said territory, in connection with the sale of thinly sliced fresh meat, a label simu-

lating the label of the plaintiff Shores, that defendants' label contains the words "Camp Steak" arranged in a curve or arch adjacent the picture of the head of a beef animal, with the picture of the head of the animal arranged prominently and centrally of the label. That the defendants, and each of them, use said label in the advertising of defendants' thinly sliced fresh meat by placing such labels, printed on waxed paper, between series of said slices of fresh meat in the same manner as plaintiff Shores does and has done for many years. That the thinly sliced meat of the plaintiffs and defendants, sold under said labels, is indistinguishable at the time same is offered to the public. That the use of such label of the defendants in said territory in connection with the sale of thinly sliced fresh meat is calculated to and will deceive the public into believing that they are buying the thinly sliced fresh meat of the plaintiff Shores when they are in fact buying the thinly sliced fresh meat of the defendants, whereby irreparable injury is being done the plaintiffs, and each of them, by the actions of the defendants, and each of them, herein complained of.

## X.

That the plaintiffs have given the defendants due notice of the infringement upon plaintiff's said trade-mark and of defendants' unfair competition in the manner of displaying, advertising and using its mark herein complained of, but the defendants neglected and refused, continue to neglect and re-

fuse to cease any of said acts complained of, and will continue to do so unless restrained by this court. The plaintiffs have no speedy or adequate remedy at law. [5]

Wherefore, plaintiffs demand (a) preliminary and final injunctions against further infringement upon said patent and trade-mark and against further unfair competition by the defendants and those controlled by the defendants, (b) defendants' profits, (c) general damages not less than a reasonable royalty, and (d) an assessment of costs against the defendants.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs. [6]

State of California,  
County of Los Angeles—ss.

Earl F. Shores, being by me first duly sworn, deposes and says: that he is one of the Plaintiffs in the above-entitled action; that he has read the foregoing Bill of Complaint and knows the contents thereof; and that the same is true of his own knowledge, except as to the matters which are therein stated upon information or belief, and as to those matters that he believes it to be true.

/s/ EARL F. SHORES.

Subscribed and sworn to before me this 15th day of September, 1948.

[Seal]      /s/ VESTA NELSON,  
Notary Public in and for said County and State of  
California.

[Endorsed]: Filed September 16, 1948. [8]

[Title of District Court and Cause.]

MOTION TO DISMISS THE SECOND COUNT  
OF PLAINTIFFS' COMPLAINT FOR  
LACK OF JURISDICTION

Now Come the defendants Rayford Camp & Co. and Rayford Camp in the above entitled cause and move this Honorable Court for an order dismissing the second count of plaintiffs' Complaint herein for lack of jurisdiction of this Court.

In support of this motion the above defendants will rely on the Memorandum of Points and Authorities annexed hereto and the pleadings and proceedings heretofore had herein.

Dated: At Los Angeles, California, this 21st day of October, 1948.

HARRIS, KIECH, FOSTER &  
HARRIS.

FORD HARRIS, JR.,  
WARREN L. KERN.

By /s/ FORD HARRIS, JR.,  
Attorneys for Defendants.

Receipt of Copy acknowledged.

[Endorsed]: Filed October 21, 1948. [9]

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At a stated term, to wit: The September Term, A.D. 1948, of the District Court of the United States of America, within and for the Central Di-

vision of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles on Monday, the 1st day of November, in the year of our Lord one thousand nine hundred and forty-eight.

Present: The Honorable Leon R. Yankwich,  
District Judge.

[Title of Cause.]

For hearing motion of defendants filed Oct. 21, 1949, to dismiss second count of complaint; C. G. Stratton, Esq., appearing as counsel for plaintiffs; W. L. Kern, Esq., appearing as counsel for defendants;

Plaintiffs points and authorities re defendants' motion are filed, and plaintiffs' motion to strike part of complaint is filed.

Attorneys Kern and Stratton argue. Court orders said motions denied, defendant to have 10 days to answer. [20]

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[Title of District Court and Cause.]

PLAINTIFFS' POINTS AND AUTHORITIES  
RE DEFENDANTS' MOTION TO DISMISS  
THE SECOND COUNT

Now Come the plaintiffs in the above-entitled cause and move the Honorable Court for an order denying the defendants' motion to dismiss the second count of the plaintiffs' complaint.

## I.

This response is directed to the defendants' motion to dismiss the second count of the plaintiffs' complaint for lack of jurisdiction. It is the plaintiffs' contention that this Court does not lack jurisdiction over the cause of action alleged.

It is admitted by the defendants that original jurisdiction of this Court over the matter pleaded is conferred under the Patent laws of the United States. As will be shown, this Court may retain derivative jurisdiction of the element of unfair competition as it is a ground in support of the cause of action.

## II.

The case of *Hurn v. Oursler*, 289 U. S. 238, 77 L.Ed. 1148 (1933), relied upon heavily by the defendants, appears detrimental to their contention. Therein was alleged the existence of two versions of a play, only one of which was copyrighted under Federal law. The complaint alleged (1) Copyright infringement, (2) Unfair competition with the copyrighted version, and (3) Unfair competition with the uncopyrighted version.

The Supreme Court had original jurisdiction over the copyright infringement and retained derivative jurisdiction over the related unfair competition. However, since there did not exist the requisite original jurisdiction for the uncopyrighted version, a dismissal as to that part was ordered.

The present cause of action for patent infringement is comparable to the sustained federal jurisdiction in the *Hurn* case with respect to the copy-

righted version of the play, the uncopyrighted version being immaterial to the present cause. The allegation of infringement of the patent confers the federal court with jurisdiction and the element of unfair competition follows by way of derivative jurisdiction.

### III.

The case of *Lewis v. Vendome Bags, Inc.* 108 Fed. (2d) 16, (C.C.A. 2, 1939) (Cert. denied 309 U. S. 660, 84 L.Ed. 1008, 1940) also relied upon by the defendants rendered its interpretation of the Hurn rule. Said Judge Swan at page 17:

“ . . . It held that the federal question raised by the charge of copyright infringement gave the district court jurisdiction of the case; that rejection of the federal claim on the merits did not deprive the court of jurisdiction to decide the claim of unfair competition in respect to the copyrighted play, and that this claim should also have been dismissed on the merits; . . . ”

### IV.

The case of *Edelmann & Co. v. Triple-A Specialty Co.* 88 Fed. (2d) 852 (C.C.A. 7, 1937), (Cert. denied 300 U. S. 680, 81 L.Ed. 884, 1937) involved issue as to infringement of a patent and whether damages for unfair competition in violation of a common-law right could also be rendered in the same action. Said Judge Lindley at page 854:

“ . . . Here appellee might have sought relief from unfair competition in the state court, but it could not there obtain relief declaring the patent

invalid or not infringed. Under *Hurn v. Oursler*, 289 U. S. 238, 53 S.Ct. 586, 77 L.Ed. 1148, the court was endowed with jurisdiction also to determine the issues as to fair competition."

## V.

The element of unfair competition arises not merely because of the palming off by the defendants of their goods for that of the plaintiffs but basically stems from the unlawful use by the defendants of the patented process of the plaintiffs. Were it not for such unlawful use, the defendants would not be apt to be successful in marketing their product, for it would lack the application of the patented process.

Activities resulting in unfair competition are not necessarily confined to display and sale of the product to the public but entails numerous consecutive acts from the inception to fulfillment of the unlawful purpose. One such act is the appropriation by the defendants of the process patented by the plaintiffs.

The decision rendered in the case of *Musher Foundation v. Alba Trading Co.*, 127 Fed. (2d) 9, (C.C.A. 2, 1942) as cited by the defendants, purports to be based upon the doctrine of the *Hurn* case. The majority of the court interpreted the *Hurn* doctrine as applicable to the particular facts and utilized the rule in a narrow and technical sense. The natural implication of the *Hurn* case was avoided. The dissent rendered by Judge Clark in the *Musher* case is more coextensive with a proper

interpretation of the doctrine, for the repudiation of the "second circuit rule" by the Hurn case liberalized the concept of federal jurisdiction in accordance with policies of equitable jurisprudence. Said Judge Clark at page 11:

"... Be that as it may, the Hurn doctrine seems to me logical and vastly saving of unnecessary duplication of litigation. If the roast must be reversed exclusively for the federal bench, it is anomalous to send the gravy across the street to the state court house. Of course, there was left a certain indefiniteness, even ambiguity, as to the outer reaches of the doctrine and the extent of a single cause of action, but perhaps not more than occurs in any judicial drawing of boundary lines. See my remarks in *Lewis v. Vendome Bags, Inc.*, supra, 108 F. 2d at pages 19, 20. At any rate, it has been reiterated by a unanimous court in *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, supra; and we should do our best to follow it."

The fundamental basis of the present cause of action is a violation by the defendants of a right to exclusive use by the plaintiffs of a patented property interest. Infringement of the patent is an interference with this property right. It follows that unfair competition in the sale of a product which infringes a patented process is also a violation of the right to exclusive use. The sale of the infringing product of the patent process is not to be disregarded in determination of the element of unfair competition. Such element constitutes a basis and ground for the cause of action and should

be accorded consideration in view of the surrounding circumstances.

## VI.

In an action for alleged patent and trade-mark infringement and unfair competition where there was no diversity of citizenship, the invalidity of the patent and trade-mark did not divest the federal courts of jurisdiction over the question of unfair competition.

See: N.S.W. Co. v. Wholesale Lumber & Mill-work, Inc., 123 Fed. (2d) 38, (C.C.A. 6, 1941)

## VII.

In the case of Prince Matchabelli, Inc. v. Anhalt & Co., Inc., 40 F. Supp. 848 (D.C., S.D.N.Y. 1941), the suit was for alleged patent infringement and also for unfair competition. Said Judge Coxe at page 849:

“In the present case, the complaint charges the defendant with unfair competition in the manufacture and sale of purse kits embodying the invention; the two grounds of relief are inseparably connected, and grow out of the same facts; and there is no contention that the claim of patent infringement is not made in good faith. I think, therefore, that the charge of unfair competition has been properly joined in the complaint, and that the court has jurisdiction.”

## VIII.

The majority of the above cited cases are interpretations of the doctrine announced in the case of

Hurn v. Oursler. The rule laid down in that case is not susceptible of any definite line of demarkation as is evident from the mass of case law upon the issue of jurisdiction. The cause of action presented in the complaint is unquestionably and admittedly one of federal jurisdiction under the patent laws of the United States. The element of unfair competition as evidenced by the infringement of the State trade-mark registration is an integral part of the cause of action. As per the authorities cited therefor, the complaint should be accorded recognition and the motion of the defendants denied.

## IX.

Where a patent is held valid and infringed the unfair competition feature may be included in accounting for profits and damages though the parties are citizens of the same state.

See: N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co., 25 Fed. (2d) 659, C.C.A. 6, 1928)

## X.

Under the Henry Act, 35 U.S.C.A. §70, the plaintiff is entitled to recover general damages "for making, using, or selling."

Determining the damages to be assessed for infringement of a process patent the plaintiff should actually be entitled to prove the extent to which the process has been used in making steaks for public sale.

The plaintiffs' damages will be to some degree commensurate with the number of infringing steaks

made and sold by the defendants. Thus the sales by the defendants are an important issue in this case.

Therefore, a single cause of action is believed established in this case, since the sales of steaks made in infringement of the patent in suit is not only the basis for determining the amount of damages due the plaintiffs for infringement, but also are the identical sales that are complained of in the second count under unfair competition.

### XI.

The case of *Tilghman v. Proctor*, 125 U.S. 136, 31 L.Ed. 664 involved infringement of a patent on a process. Relative to the recovery by the plaintiff, Mr. Justice Gray said at page 144:

“But upon a bill in equity by the owner against infringers of a patent, the plaintiff is entitled to recover the amount of gains and profits that the defendants have made by the use of his invention.”

### XII.

The law and cases referred to in the above paragraphs IX, X, and XI are indicative of the manner of ascertaining the measure of damages sustained by the plaintiffs. The allegations of the complaint are appropriately directed to this end. Consequently the motion of the defendants should be denied.

Respectfully submitted,

/s/ C. G. STRATTON,

Attorney for Plaintiffs.

Receipt of copy acknowledged.

[Endorsed]: Filed November 1, 1948.

[Title of District Court and Cause.]

PLAINTIFFS' MOTION TO STRIKE PART  
OF COMPLAINT

Come Now the above-named plaintiffs, by their counsel, and move to strike lines 12 and 13 of page 3 of the complaint and as grounds therefor show that the paragraphs in the complaint are consecutively numbered, arise from the same cause of action and the complaint is in no way rendered indefinite by the deletion of these lines.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

Receipt of Copy acknowledged.

[Endorsed]: Filed Nov. 1, 1948. [21]

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[Title of District Court and Cause.]

ANSWER AND COUNTERCLAIM OF DE-  
FENDANTS RAYFORD CAMP & CO. AND  
RAYFORD CAMP

Come now the defendants Rayford Camp & Co. and Rayford Camp and in answer to the Complaint allege, aver, and deny as follows:

I.

Answering paragraph I of the Complaint, defendants deny that the plaintiff William J. Dubil is the inventor of the Method of Preparing Fresh

Meat covered by United States Letters Patent No. 2,052,221 and allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations of paragraph I of the Complaint.

## II.

Answering paragraph II of the Complaint, defendants admit that United States Letters Patent No. 2,052,221 were issued on August 25, 1936, to [23] the plaintiffs Dubil and Hubik for an alleged invention in Method of Preparing Fresh Meat, and defendants allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations of paragraph II of the Complaint.

## III.

Answering paragraph III of the Complaint, defendants deny that anyone has the exclusive right to practice the method alleged to be covered by said patent and allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations of paragraph III of the Complaint.

## IV.

Answering paragraph IV of the Complaint, defendants allege that defendant Rayford Camp is a citizen of California and resident of the County of Los Angeles, State of California, and is carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford

Camp & Co., but generally and specifically deny each and every remaining allegation contained in said paragraph.

#### V.

Answering paragraph V of the Complaint, defendants admit that this Honorable Court has jurisdiction of the claim or cause of action for patent infringement stated in paragraphs I through VII of the Complaint herein, but defendants deny that this Honorable Court has jurisdiction of the claim, cause or causes of action stated in paragraphs VIII through X of said Complaint.

#### VI.

Answering paragraph VI of the Complaint, defendants generally and specifically deny each and every allegation contained therein. [24]

#### VII.

Answering paragraph VII of the Complaint, defendants deny committing any act or acts of infringement and admit the remaining allegations of paragraph VII of the Complaint.

#### VIII.

Answering paragraph VIII of the Complaint, defendants deny that any trade-mark and label have come to be associated with the plaintiff Shores in the minds of the public, and defendants allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations contained in paragraph VIII of the Complaint.

## IX.

Answering paragraph IX of plaintiffs' Complaint, defendants admit that defendants' label contains the words "Camp Steak" arranged in a curve or arch adjacent the picture of the head of a beef animal, with the picture of the head of the animal arranged prominently and centrally of the label, but defendant generally and specifically deny each and every remaining allegation contained in paragraph IX of plaintiffs' Complaint.

## X.

Answering paragraph X of plaintiffs' Complaint, defendants deny committing any acts of infringement and/or unfair competition and deny that they will continue to do so unless restrained by this Court, and defendants admit the remaining allegations of paragraph X of the Complaint.

Further Answering Plaintiffs' Complaint with respect to the Claim or Cause of Action for Patent Infringement alleged in Paragraphs I through VII thereof, and for Separate, Alternate and Further Defenses Thereto, Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

A. That these defendants have not infringed pretended Letters [25] Patent No. 2,052,221 or any claim or claims thereof;

B. That pretended Letters Patent No. 2,052,221 were not granted by the Commissioner of Patents within the authority granted him under due form of law or after due proceedings were had with respect to the application filed by or on behalf of

plaintiffs, or any of them, and said pretended Letters Patent were irregularly granted without proper or due consideration of the application for same;

C. That William J. Dubil was not the original or first inventor of that which is alleged to be patented in said pretended Letters Patent, No. 2,052,-221, in suit, or any material or substantial part thereof, but on the contrary, prior to the supposed invention or discovery thereof, the method or other thing or things alleged to be patented by said pretended Letters Patent No. 2,052,221, and particularly that which is described in the pretended claims thereof and are material and substantial parts thereof, have been patented and/or described in certain prior printed publications and/or Letters Patent, the numbers of which, the names of the patentees thereof, and the dates of the said Letters Patent or publications these defendants have not yet fully located and for which they are diligently searching and pray leave to add to this answer;

D. That, prior to any supposed discovery and/or invention by William J. Dubil, that which is alleged to be patented by pretended Letters Patent No. 2,052,221, and particularly that which is described and claimed therein and are material and substantial parts thereof, had been invented, used by, and/or known to certain persons in this country whose names and places of residence these defendants have not fully learned, and for which these defendants are diligently searching and pray leave to add to this answer;

E. That in view of the state of the art at and before the alleged invention or inventions of pretended Letters Patent No. 2,052,221, or attempted to be defined in any claim or claims of said pretended Letters Patent, said claims, or any of them, cannot now be so interpreted as to bring within their purview as an infringement thereof, any method of process as used by these defendants; [26]

F. That while the alleged application under the requirements of the Commissioner of Patents that plaintiffs, or any of them, cannot now seek for or obtain a construction for any claim of said pretended Letters Patent sufficiently broad to cover any method or process used by these defendants;

G. That the alleged invention of pretended Letters Patent No. 2,052,221, in view of the state of the art as it existed at the date of the alleged invention or inventions, does not involve invention or contain any patentable novelty but consists of the mere adaption of well known methods or devices for the required uses, involving merely the skill expected of one in the art to which said pretended Letters Patent pertain;

H. That pretended Letters Patent No. 2,052,221, and each and every of the claims thereof, is invalid and void because the patentee thereof failed to particularly point out and distinctly claim the parts, combinations, or methods alleged to constitute the invention or discovery thereof;

I. That plaintiffs have employed and are now employing said pretended Letters Patent No. 2,052,221 improperly and without the sanction of law to restrain commerce in and secure a limited monopoly of unpatented material, to wit, thinly sliced beef, in an effort to extend the monopoly of said pretended Letters Patent No. 2,052,221 beyond its lawful scope, wherefore plaintiffs are not entitled to assert said Letters Patent against these defendants.

Further Answering Plaintiffs' Complaint with respect to the Claims or Causes of Action for Trade-Mark Infringement and Unfair Competition alleged in paragraphs VIII through X of Plaintiffs' Complaint and for Separate, Alternate, and Further Defenses Thereto, Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

J. That the alleged trade-mark "Chip Steak" is merely descriptive of the goods or merchandise with which it is used, or of the class, [27] character, or quality of said goods or merchandise and is not and has not, at any time since the alleged use thereof by plaintiffs, been the proper subject of any trade-mark registration;

K. That the alleged trade-mark "Chip Steak" comprises or consists of words which are and have been, prior to the alleged use thereof by plaintiffs, in the public domain and may not be exclusively appropriated by plaintiffs for use in connection with the sale of thinly sliced steaks;

L. That this Honorable Court has no jurisdiction

tion over the cause or causes of action for trademark infringement and unfair competition alleged in paragraphs VIII through X of the Complaint herein.

For a Counterclaim against Plaintiffs Edward J. Hubik and William J. Dubil to the Claim or Cause of Action for Patent infringement Alleged in Paragraphs I through VII of Plaintiffs' Complaint Herein, Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

### I.

That defendant-counter claimant Rayford Camp is a citizen of the State of California and resident of the County of Los Angeles, State of California, and is carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co.

### II.

That on information and belief plaintiff-counter defendants William J. Dubil and Edward J. Hubik are each citizens of the State of California and are the alleged owners of pretended United States Letters Patent No. 2,052,221.

### III.

That this is an action arising under the patent statutes of the United States, and the jurisdiction of this Court is founded thereon. [28]

### IV.

That this counterclaim is brought under § 247(d) of the Judicial Code, 28 U.S.C.A. Sec. 400, because

there is an actual controversy now existing between the parties in respect of which these defendants need a declaration of their rights by this court, which controversy arises over the question of validity and infringement of United States Letters Patent No. 2,052,221 alleged to be owned by plaintiffs William J. Dubil and Edward J. Hubick, and of each and every of the claims thereof, in that these plaintiffs have charged these defendants with infringing said Letters Patent.

## V.

That defendants adopt, repeat and reallege as paragraphs V to XIII, inclusive, of this counterclaim each and every of the allegations contained in paragraphs A to I, inclusive, of defendants' answer above set forth with like effect as if fully herein repeated.

For a Counterclaim Against Plaintiff Edward J. Hubik to the Claim or Cause of Action for Trade-Mark Infringement Alleged in Paragraphs VIII through X of Plaintiffs' Complaint herein, Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

## I.

That defendant-counterclaimant Rayford Camp is a citizen of California and resident of the County of Los Angeles, State of California, and is carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co.

## II.

That on information and belief plaintiff-counter-defendant Edward J. Hubik is a citizen of California and resident of the County of Los Angeles, State of California. [29]

## III.

That on information and belief plaintiff-counter-defendant Edward J. Hubik on September 14, 1936, registered or caused to be registered in the office of the Secretary of the State of California at Sacramento, California, Registration No. 20515, the alleged trade-mark "Chip Steak."

## IV.

That the alleged trade-mark "Chip Steak" was and is not a proper subject of trade-mark registration and was and is registered contrary to and in violation of the laws of the State of California and is subject to cancellation thereunder in that said alleged trade-mark is merely descriptive of the goods or merchandise with which it is used, or of the class, character, or quality of such goods or merchandise, and comprises and consists of words which are and have been, prior to any use thereof by the plaintiff-counterdefendant, in the public domain.

Wherefore, these defendants pray for judgment against plaintiffs herein as follows:

- (a) That the Complaint herein be dismissed.
- (b) For declaratory judgment adjudging said Letters Patent No. 2,052,221, and each of the claims thereof, invalid and void and that said Letters Pat-

ent have not been infringed by these defendants.

(c) That said trade-mark "Chip Steak" is invalid and void and ordering the registration thereof cancelled pursuant to Section 14246 of the Business and Professions Code of the State of California.

(d) That these defendants have not been guilty of any acts of unfair competition or trade-mark infringement.

(e) That these defendants recover from plaintiffs, and each of them, reasonable attorneys' fees.

(f) That these defendants recover from plaintiffs the taxable costs of this action. [30]

(g) That these defendants be granted such other and equitable relief as may be proper.

Dated: At Los Angeles, California, this 10th day of November, 1948.

HARRIS, KIECH, FOSTER &  
HARRIS, FORD HARRIS,  
JR., WARREN L. KERN,

By /s/ FORD HARRIS, JR.,

Attorneys for Defendants  
Rayford Camp & Co. and  
Rayford Camp.

RAYFORD COMP & CO. and  
RAYFORD CAMP,

By /s/ RAYFORD CAMP.

Receipt of copy acknowledged.

[Endorsed]: Filed November 10, 1948.[31]

[Title of District Court and Cause.]

**NOTICE UNDER 35 U.S.C. 69**

To William J. Dubil, Edward J. Hubik, and Earl F. Shores, Plaintiffs; and C. G. Stratton, Esq., their Attorney;

Please Take Notice that Defendants at the trial of this action will rely on the following United States Letters Patent to prove the defenses stated in Paragraph C of the Answer on file herein:

Patent No.	Patentee	Date of Application	Date of Grant
1,864,284	Harden F. Taylor	July 1, 1929	June 21, 1932
1,864,285	Harden F. Taylor	May 23, 1931	June 21, 1932
2,137,897	Harry H. McKee and Floyd Seaver	Oct. 6, 1930	Nov. 22, 1938
2,140,162	Harry H. McKee	June 6, 1929	Dec. 13, 1938

Defendants at the trial of this action will rely on the following prior usages to prove the defenses stated in Paragraph D of the Answer on file herein:

By Whom Used	Where Used
Rayford Camp	Los Angeles County, Calif.
S. D. Baird	Los Angeles County, Calif.
Edward Joseph Hubik	Los Angeles County, Calif.

Dated: At Los Angeles, California, this 4th day of February, 1949.

**HARRIS, KIECH, FOSTER  
& HARRIS,  
FORD HARRIS, JR.,  
WARREN L. KERN,**

By /s/ **FORD HARRIS, JR.,**

Attorneys for Defendants Rayford Camp & Co. and Rayford Camp.

Receipt of Copy acknowledged.

[Endorsed]: Filed February 7, 1949. [34]

[Title of District Court and Cause.]

## DEFENDANTS' INTERROGATORIES UNDER RULE 33

Now come the defendants, Rayford Camp & Co. and Rayford Camp, and, pursuant to the provisions of Rule 33 of the Federal Rules of Civil Procedure, propound the following interrogatories to be answered separately and fully in writing under oath by each of the plaintiffs herein:

I. Did plaintiffs, or any of them, or others, prior to September 13, 1935, practice the method claimed in the patent in suit?

II. If the answer to Interrogatory I is in the affirmative, state:

- (a) When said method was first practiced;
- (b) By whom said method was first practiced;
- (c) Where said method was first practiced;
- (d) The minimum temperature of the meat at the time of [36] slicing thereof in the practice of said method prior to September 13, 1935.
- (e) The earliest date, or approximate date, upon which the products made by the practice of said method were sold to the public or members thereof.

III. Did plaintiffs, or any of them, prior to the issuance of the patent in suit, test or determine the temperature range within which meat must be at the time of slicing in order to practice the method or methods claimed in the patent in suit.

IV. If the answer to Interrogatory III is in the affirmative, state:

- (a) When and where said test or determination was made;
- (b) By whom said test or determination was made;
- (c) The temperature range determined to be suitable;
- (d) The method of temperature measurement employed in making such test or determination;
- (e) Whether it was found by such test or determination that meat at a temperature of 28° F. could be thinly sliced;
- (f) Whether it was found by such test or determination that meat at a temperature below 28° F. could be thinly sliced.

V. State:

- (a) The exact temperature range or limits within which meat must be at the time of slicing in performing the method of the patent in suit;
- (b) Whether plaintiffs, or any of them, will contend at the trial of this action that the method claimed by the patent in suit may be performed by slicing the meat at a temperature of 28° F.
- (c) Whether plaintiffs, or any of them, will contend at the trial of this action that the method claimed by the patent in suit may be performed by slicing the meat at a temperature of 27° F. [37]

VI. State which of the claims of the patent in suit plaintiffs, or any of them, will contend at the trial of this action are or have been infringed by defendants, or either of them, and in connection therewith:

(a) State separately which of such claims are or have been infringed by each of the defendants as a result of the preparing of fresh meat, and which are, or have been infringed by each of the defendants, as a result of their selling and using fresh meat prepared in accordance with the alleged patented invention.

VII. Referring to the transcript of the deposition of defendant Rayford Camp taken on January 18, 1949, page 27, lines 4 to 10 thereof, state whether the method described by said defendant therein will be contended by plaintiffs, or any of them, at the trial of this action to infringe the patent in suit, and, if so, the particular claims which it will be urged are infringed thereby.

VIII. Referring to the transcript of the deposition of defendant Rayford Camp taken on January 18, 1949, page 29, lines 6 to 14 thereof, state whether the method described by said defendant therein will be contended by plaintiffs, or any of them, at the trial of this action to infringe the patent in suit, and, if so, the particular claims which it will be urged are infringed thereby.

IX. State whether any method other than that identified in Interrogatories VII and VIII, above,

will be contended by plaintiffs, or any of them, at the trial of this action to be, or have been, performed by defendants, which other method it will be urged at the trial of this action infringes the patent in suit.

X. If the answer to Interrogatory IX is in the affirmative, briefly describe each such other method, and state separately when, where, and by whom performed, and which claims of the patent in suit will be claimed to [38] be infringed thereby.

XI. State whether plaintiffs, or any of them, will contend at the trial of this action that the patent in suit is infringed by a method of preparing fresh meat identical to that described and claimed in said patent except that the meat is at a temperature of 28° F. throughout at the time of slicing, instead of at a temperature of approximately 30° F. to 32° F.

XII. State whether plaintiffs, or any of them, will contend at the trial of this action that the patent in suit is infringed by a method of preparing fresh meat identical to that described and claimed in said patent except that the meat is at a temperature of 27° F. throughout at the time of slicing, instead of at a temperature of approximately 30° F. to 32° F.

XIII. State whether plaintiffs, or any of them, will contend at the trial of this action that the patent in suit is infringed by a method of preparing fresh meat identical to that described and claimed in said patent except that the meat is at a temperature of

less than 27° F. throughout at the time of slicing, instead of at a temperature of 30° F. to 32° F., and if so, state the lowest temperature at which the meat can be to practice the method described and claimed in said patent.

XIV. State the exact meaning of the following expressions appearing in the specification or claims of the patent in suit:

- (a) "Very thin slices of fresh meat";
- (b) "To freeze the meat solid";
- (c) "Partially thawing";
- (d) "Thawing the meat";
- (e) "Approximately 30° to 32° F.".

XV. State whether plaintiffs, or any of them, have at any time granted any license or other right to any parties other than any plaintiffs herein under the patent in suit, and, if the answer is in the affirmative, give [39] the names and addresses of each of such parties and attach a copy of each of said licenses or instruments granting other rights.

XVI. How or in what manner will plaintiffs, or any of them, contend at the trial of this action that the use of the defendants' label in the territory of plaintiff Shores is calculated to or will deceive the public into buying defendants' meat as the product of plaintiffs, or any of them.

XVII. State the names and addresses of all members of the general public known to plaintiffs,

or any of them, who have been deceived by defendants' label on thinly sliced meat into believing they were buying the thinly sliced meat of plaintiffs, or any of them.

XVIII. State the names and addresses of all retail butchers known to plaintiffs, or any of them, who have been deceived by defendants' label on thinly sliced meat.

XIX. State whether it will be urged by plaintiffs, or any of them, at the trial of this action that defendants, or any of them, are or have been engaging in any acts of unfair competition in connection with the preparation of thinly sliced meat and apart from the use or sale thereof.

XX. If the answer to Interrogatory XIX is in the affirmative, state briefly the unfair acts which will be claimed to have been performed by defendants in preparing thinly sliced meat.

XXI. If fresh steer beef frozen when it is at a temperature of 31° F. throughout?

XXII. If you cannot answer Interrogatory XXI, explain why.

XXIII. Is fresh steer beef frozen when it is at a temperature [40] of 30° F. throughout?

XXIV. If you cannot answer Interrogatory XXIII, explain why.

XXV. With reference to frozen fresh meat, is "tempering" synonymous with "thawing"?

XXVI. If your answer to Interrogatory XXV is in the negative, define the word "tempering" as used in connection with the handling of fresh meat.

XXVII. In the processing of frozen fresh meat, is there any difference in the resulting product in the practice of the following two methods:

(a) Take fresh meat at atmospheric temperature (e.g. 55° F.); cool it to a minimum temperature of 30° F. to 32° F. throughout; and then slice while the meat is at a temperature of 30° F. to 32° F. throughout; and

(b) Take fresh meat at atmospheric temperature (e.g. 55° F.); cool it to a minimum temperature of 0° F.; raise its temperature to 30° F. to 32° F. throughout; and then slice while the meat is at a temperature of 30° F. to 32° F. throughout.

XXVIII. If your answer to Interrogatory XXVII is in the affirmative, state in detail every such difference in the product.

Dated: At Los Angeles, California, this 7th day of February, 1949.

HARRIS, KIECH, FOSTER  
& HARRIS,  
WARREN L. KERN,  
By /s/ FORD W. HARRIS, JR.,  
Attorneys for Defendants.

Receipt of Copy acknowledged.

[Endorsed]: Filed February 8, 1949. [41]

[Title of District Court and Cause.]

## PLAINTIFFS' INTERROGATORIES UNDER RULE 33

Now come the plaintiffs, pursuant to the provisions of Rule 33 of the Federal Rules of Civil Procedure, and propound the following interrogatories, each division of which is to be answered separately and fully in writing under oath by each of the defendants Rayford Camp & Co., and Rayford Camp.

1. Are the patents cited in your Notice under 35 U.S.C. 69, served in this case, and the oral testimony of the three witnesses named therein, all that will be relied upon at the trial of this case:

- (a) To anticipate the patent in suit?
- (b) To show the state of the art? [43]

2. If the answer to either part of interrogatory 1 is in the negative, please give:

- (a) The numbers, patentees and dates and all additional patents to be used at the trial;
- (b) The names and addresses of all additional persons alleged to have used the method covered by the patent in suit; and
- (c) Full information about any exhibits to be used in support thereof.

Dated at Los Angeles, California, this 16th day of February, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

Affidavit of service by mail attached.

[Endorsed]: Filed February 17, 1949. [44]

[Title of District Court and Cause.]

### STIPULATION

It Is Hereby Stipulated by and between counsel for the above-named plaintiffs and for the defendants Rayford Camp & Co., and Rayford Camp, that the plaintiffs may file the annexed Amended Reply in this case, and that it may be used in lieu of the Reply heretofore filed herein.

Dated at Los Angeles, California, this 11th day of February, 1949.

/s/ C. G. STRATTON,

Attorney for the Plaintiffs.

HARRIS, KIECH, FOSTER &  
HARRIS

FORD HARRIS, Jr.,

WARREN L. KERN,

By /s/ FORD HARRIS, JR.,

Attorneys for Defendants Rayord Camp & Co., and  
Rayford Camp.

It Is Ordered that the annexed Amended Reply  
be filed.

/s/ PAUL J. McCORMACK,

U.S. District Judge. [46]

[Title of District Court and Cause.]

AMENDED REPLY OF PLAINTIFFS WILLIAM J. DUBIL AND EDWARD J. HUBIK TO COUNTERCLAIMS OF DEFENDANTS

Now Come the plaintiffs William J. Dubil and Edward J. Hubik, hereinafter referred to as said plaintiffs, and as an amended reply to the counterclaims of the defendants, allege, admit and deny as follows:

I.

In reply to the first counterclaim against the said plaintiffs beginning on page 6, line 12, and extending to and including line 15 on page 7 of the Answer and Counterclaim of the defendants, hereinafter referred to as the First Counterclaim, the said plaintiffs admit, allege and deny as follows:

(a) Admit the allegations contained in Paragraph I of the First Counterclaim. [47]

(b) Admit that said plaintiffs are residents of the State of California, and that said plaintiffs are the owners of United States Letters Patent No. 2,052,221.

(c) Admit the allegations contained in Paragraph III of the First Counterclaim.

(d) Admit the allegations contained in Paragraph IV of the First Counterclaim, except that as to the averment that the defendants need a declaration of their rights by this Court, the said plain-

tiffs are without knowledge or information sufficient to form a belief as to the truth of such averment.

(e) Deny each and every allegation contained in Paragraphs V to XIII, inclusive, of the First Counterclaim.

## II.

In reply to the second counterclaim against the plaintiff Edward J. Hubik, beginning on page 7, line 17, and extending to and including line 15 on page 8 of the Answer and Counterclaim of the defendants, hereinafter referred to as the Second Counterclaim, the plaintiff Hubik admits, alleges and denies as follows:

(a) Admits the allegations contained in Paragraph I of the said Second Counterclaim.

(b) Admits that he is a resident of the County of Los Angeles, State of California.

(c) Admits the allegations contained in Paragraph III of the Second Counterclaim.

(d) Denies each and every allegation contained in Paragraph IV of the Second Counterclaim.

## III.

That in both the First Counterclaim and Second Counterclaim, the defendant Rayford Camp is suing under the fictitious name of Rayford Camp & Co. That the said plaintiffs are informed and believe and upon information and belief allege that

the defendant Rayford Camp continuously since approximately the spring of 1948 [48] has been and is doing business in Los Angeles County, State of California, under the fictitious name of Rayford Camp & Co., but that such fictitious name has not not been published or recorded in Los Angeles County, State of California.

Wherefore, the said plaintiffs pray:

- (a) that the First and Second Counterclaims herein be dismissed;
- (b) that the registration in the State of California, No. 20,515, of the trade-mark "Chip Steak" be declared valid and infringed by the defendants herein;
- (c) that the plaintiffs in this action recover reasonable attorney's fees from the defendants herein; and
- (d) for such other and further relief which to the Court appears just and equitable in the premises.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

[Endorsed]: Filed February 18, 1949. [49]

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[Title of District Court and Cause.]

## NOTICE

Notice is hereby given that on Monday, February

28, 1949, at 10:00 a.m., or as soon thereafter as counsel can be heard, the undersigned will present to the Honorable Leon R. Yankwich, United States District Judge of the above-entitled court, the annexed Objections to defendants' interrogatories. The time of this notice is shortened by reason of the closeness of the trial, which is set for March 8th, 1949.

Dated at Los Angeles, California, this 17th day of February, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

#### PLAINTIFFS' OBJECTIONS TO DEFENDANTS' INTERROGATORIES

Plaintiffs object to the following interrogatories propounded by defendants:

1. Defendants' interrogatory V is objected to on the grounds that it asks for an opinion, is indefinite, calls for a conclusion which is within the province of the court to decide, and calls for the contentions that the plaintiffs will make at the trial of the case.
2. Defendants' interrogatories VII to XIII, inclusive, are objected to on the ground that each of them calls for the contention that the plaintiffs will make at the trial of this case.
3. Defendants' interrogatory XIV is objected to on the ground that it calls for an opinion, calls for

conclusions which are within the province of the court to decide, and calls for the contentions that the plaintiffs will make at the trial hereof.

4. Defendants' interrogatory XV is objected to as immaterial in this case and not tending to prove or disprove any of the issues of this case. Further objection is made to the request for copies of licenses, since the procedure set forth in Rule 34 should be followed for the production of documents.

5. Defendants' interrogatories XVI, XIX and XX are objected to on the ground that they call for the contentions that the plaintiffs will make at the trial hereof.

6. Defendants' interrogatories XXI to XXVI, inclusive, are objected to on the ground that they ask for opinions and conclusions which are within the province of the court to decide. Interrogatory XXV is also argumentative.

7. Defendants' interrogatories XXVII and XXVIII are objected to as calling for comparisons, as well as for an opinion and for a conclusion which is within the province of the court to decide.

At the hearing in this matter, the plaintiffs will rely upon the file in this case and upon the annexed Points and Authorities and upon the objections given above.

Dated at Los Angeles, California, this 17th day of February, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

## Points and Authorities

"It is the ascertainment of facts that is the object of discovery proceedings as contrasted with opinions, conclusions and contentions."

—Cinema Amusements v. Loew's, Inc., 7 F.R.D. 318, 320.

"That contentions, opinions and legal conclusions may not be required by interrogatories is sustained by numerous decisions."

—U.S. v. Columbia Steel Co., 7 F.R.D. 183, 185.

"Interrogatories 26, 29, 31, 32 and 33 are all objectionable as asking for plaintiff's contentions or opinions."

—Sutherland Paper Co. v. Grant Paper Box Co., 8 F.R.D. 416, 418.

"It has been held by many courts that interrogatories requiring expression of opinions, or for conclusions, are objectionable."

"It may also be pointed out that interrogatories which seek to require the responding party to make comparisons are objectionable. Boysell Co. v. Colonial Coverlet Co., D.C., 29 F.Supp. 123; Looper v. Colonial Coverlet Co., D.C., 29 F.Supp. 125."

—Porter v. Montaldo's, 71 F.Supp. 372, 375.

—See also Canuso v. City of Niagara Falls, 4 F.R.D. 362.

"Interrogatories propounded by defendants calling for opinions and requiring plaintiffs to make comparisons of structures were held subject to objection in Carter Bros. v. Cannon, D.C. Tenn., 2 F.R.D. 174."

—Hoak v. Empire Steel Corp., 5 F.R.D. 330,  
331.

“Interrogatories Nos. 2 and 4, as stated, call upon plaintiffs to compare the elements of the patent claims with defendant’s engine. These interrogatories demand neither an ultimate nor evidentiary fact, but call for an opinion.”

—Lanova Corp. v. National Supply Co., 29  
F.Supp. 119, 120.

“The objection is based upon the demand that the plaintiff furnish copies of certain licenses mentioned in the interrogatories.

“The objection must be sustained. The interrogatories are issued under the authority of the Federal Rules of Civil Procedure, Rule 33, 28 U.S.C.A., which does not authorize the demand made. If the defendants are entitled to the copies demanded they must show ‘good cause therefor’ \* \* \* as required by Rule 34.”

—Bruen v. Huff, 8 F.R.D. 322.

“Interrogatory 36 to Loews, Inc., reads: ‘If you have any written agreement with any or all of the other defendants \* \* \* attach copy or copies thereof to your answers to those interrogatories.’

“This interrogatory was objected to, and as the Rules do not require the attaching of copies, the objection is sustained.”

—Roth v. Paramount Film Distributing Corp., 4 F.R.D. 302, 305.

Receipt of copy acknowledged.

[Endorsed]: Filed Feb. 19, 1949.

[Title of District Court and Cause.]

PLAINTIFFS' ANSWERS TO CERTAIN OF  
DEFENDANTS' INTERROGATORIES

Comes now the plaintiff Earl F. Shores, and in answer to the defendants' interrogatories which have not been objected to, the said plaintiff states:

1. Answering defendants' interrogatory "I," the said plaintiff states that as to the group mentioned therein including "plaintiffs, or any of them, or others," at least one of that group did practice the method claimed in the patent in suit prior to September 13, 1935.

2. Answering interrogatory "II":

(a) Said method was first practiced about a year prior to that date.

(b) Said method was first practiced by the plaintiff [50] William J. Dubil, in South Gate, California.

(c) Answer given in (b).

(d) The minimum temperature at which the meat was actually sliced, prior to September 13, 1935, in the satisfactory practice of said method, is believed to be approximately 30° F.

(e) The products made by the practice of said method were sold to the public approximately the same time that the method was first practiced, as stated above.

3. Answering interrogatory "III"; One or

more of the plaintiffs prior to the issuance of the patent in suit did test or determine the temperature range within which the method or methods claimed in the patent in suit were best practiced.

4. Answering interrogatory "IV":

- (a) Said test or determination was made about a year prior to the application for the patent in suit in South Gate, California.
- (b) The test or determination was made by the plaintiff William J. Dubil.
- (c) Approximately 30° to 32° was determined to be suitable.
- (d) The method of temperature measurement employed were by a thermometer and by feeling the meat.
- (e) Such test or determination found that meat was not satisfactorily sliced thinly at a temperature of 28° F.; the slices were broken, slices were skipped and slices were thicker at one side than on another.
- (f) No test or determination was made at that time for thinly slicing meat at a temperature below 28° F.

5. Answering interrogatory "VI": The plaintiffs will contend at the trial of this action that claims 1, 2, 4 and 6 are [51] infringed by the defendants.

- (a) The defendants are charged to infringe by their preparation of fresh meat. Of course, infringe-

ment of the patent in suit is not claimed by selling or using the product of the patented invention.

6. Answering interrogatories "XVII" and "XVIII," except for the following, the plaintiff Earl F. Shores does not at this time have the names and addresses of any members of the general public who have been deceived by defendants' label into believing they were buying the thinly sliced meat of the plaintiffs', or any of them, or the name of any retail butcher who has been deceived by defendants' label on thinly sliced meat.

GUNDEERSON BROTHERS,  
11448 Long Beach Boulevard,  
Lynwood, California.

PARK MARKET,  
2818 E. Gage Avenue,  
Huntington Park, California.

GREATER ALL-AMERICAN  
MARKET,  
8351 E. Firestone Boulevard,  
Downey, California.

/s/ EARL F. SHORES.

Subscribed and sworn to before me this 23rd day of Feb., 1949.

[Seal]      /s/ VESTA NELSON,  
Notary Public in and for the County of Los Angeles, States of California.

Receipt of Copy acknowledged.

[Endorsed]: Filed Feb. 24, 1949. [52]

[Title of District Court and Cause.]

ANSWER TO AMENDED COMPLAINT, AND  
COUNTERCLAIM, OF DEFENDANTS  
RAYFORD CAMP & CO. and RAYFORD  
CAMP

Come now the defendants Rayford Camp & Co. and Rayford Camp and in answer to the Amended Complaint allege, aver, and deny as follows:

I.

Answering paragraph I of the Amended Complaint, defendants deny that the plaintiff William J. Dubil is the inventor of the Method of Preparing Fresh Meat covered by United States Letters Patent No. 2,052,221 and allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations of paragraph I of the Complaint. [62]

II.

Answering paragraph II of the Amended Complaint, defendants admit that United States Letters Patent No. 2,052,221 were issued on August 25, 1936, to the plaintiffs Dubil and Hubik for an alleged invention in Method of Preparing Fresh Meat, and defendants allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations of paragraph II of the Complaint.

III.

Answering paragraph III of the Amended Com-

plaint, defendants deny that anyone has the exclusive right to practice the method alleged to be covered by said patent and allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations of paragraph III of the Complaint.

#### IV.

Answering paragraph IV of the Amended Complaint, defendants allege that defendant Rayford Camp is a citizen of California and resident of the County of Los Angeles, State of California, and is carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co., but generally and specifically deny each and every remaining allegation contained in said paragraph.

#### V.

Answering paragraph V of the Amended Complaint, defendants admit that this Honorable Court has jurisdiction of the claim or cause of action for patent infringement stated in paragraphs I through VII of the Complaint herein, but defendants deny that this Honorable Court has jurisdiction of the claim, cause or causes of action stated in paragraphs VIII through X of said Complaint. [63]

#### VI.

Answering paragraph VI of the Amended Complaint, defendants generally and specifically deny each and every allegation contained therein.

**VII.**

Answering paragraph VII of the Amended Complaint, defendants deny committing any act or acts of infringement and admit the remaining allegations of paragraph VII of the Complaint.

**VIII.**

Answering paragraph VIII of the Amended Complaint, defendants deny that any trade-mark and label have come to be associated with the plaintiff Shores in the mind of the public, and defendants allege that they have no knowledge or information sufficient to enable them to form a belief as to the truth of the remaining allegations contained in paragraph VIII of the Complaint.

**IX.**

Answering paragraph IX of the Amended Complaint, defendants admit that defendants' label contains the words "Camp Steak" arranged in a curve or arch adjacent the picture of the head of a beef animal, with the picture of the head of the animal arranged prominently and centrally of the label, but defendants generally and specifically deny each and every remaining allegation contained in paragraph IX of plaintiffs' Complaint.

**X.**

Answering Paragraph X of the Amended Complaint, defendants generally and specifically deny each and every allegation contained therein.

**XI.**

Answering Paragraph XI of the Amended Com-

plaint, defendants generally and specifically deny each and every allegation contained therein. [64]

Further answering the Amended Complaint with respect to the Claim or Cause of Action for Patent Infringement alleged in Paragraphs I through VII thereof, and for Separate, Alternate and Further Defenses Thereto, Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

A. That these defendants have not infringed pretended Letters Patent No. 2,052,221 or any claim or claims thereof;

B. That pretended Letters Patent No. 2,052,221 were not granted by the Commissioner of Patents within the authority granted him under due form of law or after due proceedings were had with respect to the application filed by or on behalf of plaintiffs or any of them, and said pretended Letters Patent were irregularly granted without proper or due consideration of the application for same;

C. That William J. Dubil was not the original or first inventor of that which is alleged to be patented in said pretended Letters Patent, No. 2,052,221, in suit, or any material or substantial part thereof, but on the contrary, prior to the supposed invention or discovery thereof, the method or other thing or things alleged to be patented by said pretended Letters Patent No. 2,052,221, and particularly that which is described in the pretended claims thereof and are material and substantial parts thereof, have been patented and/or described in certain

prior printed publications and/or Letters Patent, the numbers of which, the names of the patentees thereof, and the dates of the said Letters Patent being as follows:

Patentee	Number	Date of Issue
Harden F. Taylor	1,864,284	June 21, 1932
Harden F. Taylor	1,864,285	June 21, 1932
Harry H. McKee and Floyd Seaver	2,137,897	November 22, 1938
Harry H. McKee	2,140,162	December 13, 1938

D. That, prior to any supposed discovery and/or invention by William J. Dubil, that which is alleged to be patented by pretended Letters [65] Patent No. 2,052,221, and particularly that which is described and claimed therein and are material and substantial parts thereof, had been invented, used by and/or known to the patentees identified in Paragraph C hereof, and in addition thereto by the following persons:

By Whom Used	Where Used
Rayford Camp	Los Angeles County, Calif.
S. D. Baird	Los Angeles County, Calif.
E. J. Hubik	Los Angeles County, Calif.

E. That in view of the state of the art at and before the alleged invention or inventions of pretended Letters Patent No. 2,052,221, or attempted to be defined in any claim or claims of said pretended Letters Patent, said claims, or any of them, cannot now be so interpreted as to bring within their purview as an infringement thereof, any method of process as used by these defendants;

F. That while the alleged application for pretended Letters Patent No. 2,052,221 was pending in the United States Patent Office the applicant there-

for so limited and confined the claims of said alleged application under the requirements of the Commissioner of Patents that plaintiffs, or any of them, cannot now seek for or obtain a construction for any claim of said pretended Letters Patent sufficiently broad to cover any method or process used by these defendants;

G. That the alleged invention of pretended Letters Patent No. 2,052,221, in view of the state of the art as it existed at the date of the alleged invention or inventions, does not involve invention or contain any patentable novelty but consists of the mere adaption of well known methods or devices for the required uses, involving merely the skill expected of one in the art to which said pretended Letters Patent pertain;

H. That pretended Letters Patent No. 2,052,221, and each and every one of the claims thereof, is invalid and void because the patentee thereof failed to particularly point out and distinctly claim the parts, combinations, [66] or methods alleged to constitute the invention or discovery thereof;

I. That plaintiffs have employed and are now employing said pretended Letters Patent No. 2,052,221 improperly and without the sanction of law to restrain commerce in and secure a limited monopoly of unpatented material, to wit, thinly sliced beef, in an effort to extend the monopoly of said pretended Letters Patent No. 2,052,221 beyond its lawful scope, wherefore plaintiffs are not entitled

to assert said Letters Patent against these defendants.

Further Answering Plaintiffs' Amended Complaint with respect to the claims or Causes of Action for Trade-Mark Infringement and Unfair Competition alleged in paragraphs VIII through X thereof and for Separate, Alternate, and Further Defenses Thereto, Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

J. That the alleged trade-mark "Chip Steak" is merely descriptive of the goods or merchandise with which it is used, or of the class, character, or quality of said goods or merchandise and is not and has not, at any time since the alleged use thereof by plaintiffs, been the proper subject of any trademark registration;

K. That the alleged trade-mark "Chip Steak" comprises or consists of words which are and have been, prior to the alleged use thereof by plaintiffs, in the public domain and may not be exclusively appropriated by plaintiffs for use in connection with the sale of thinly sliced steaks;

L. That this Honorable Court has no jurisdiction over the cause or causes of action for trade-mark infringement and unfair competition alleged in paragraphs VIII through X of the Amended Complaint herein.

M. That one Edward Munyon acted as a salesman of the laminated steaks made by defendant Rayford Camp from about February, 1948, to and

including February 14, 1949, selling said laminated steaks in the County of Los Angeles, State of California. Said laminated steaks were made by one or more processes charged by plaintiffs to infringe Letters [67] Patent No. 2,052,221, here in suit. Said Munyon sold said laminated steaks of said defendant over a route owned and/or controlled by defendant Rayford Camp. The list of customers serviced in said route was and is the property of defendant Rayford Camp. The list of customers on such route was and is a confidential list. On or about February 11, 1949, and while said Munyon was still selling said laminated steaks manufactured by defendant Rayford Camp, and without the knowledge or consent of said defendant, the plaintiff Shores and said Munyon discussed a plan under which said Munyon was to stop selling said laminated steaks made by defendant Rayford Camp and was to commence selling the "Chip Steaks" manufactured by plaintiff Shores, and it was so understood and agreed at that time or thereafter, and further that said Munyon was to solicit the sale of said "Chip Steaks" to the same customers on said route, or some of them, to whom he had previously sold the laminated steaks made by defendant. That in pursuance of said understanding and agreement between the plaintiff Shores and said Munyon, said Munyon on or prior to February 14, 1949 commenced to sell and offer to sell said "Chip Steaks" made by plaintiff Shores to said customers to whom he had previously sold said laminated steaks of defendant Rayford Camp, and since that date has

continued to do so. That since on or about February 14, 1949 said Munyon has sold said "Chip Steaks" to customers of defendant Rayford Camp, misleading them into believing that they were purchasing said laminated steaks made by defendant. That said acts of plaintiff Shores and said Munyon have been with the deliberate intent and purpose by both of them to injure and damage the business of defendant Rayford Camp. That as a result of said acts of plaintiff Shores and said Munyon and otherwise, plaintiff Shores is guilty of unclean hands and is barred from maintaining this action in equity and from obtaining any recovery or relief herein.

For a Counterclaim against Plaintiffs Edward J. Hubik and William J. Dubil to the Claim or Cause of Action for Patent Infringement Alleged in Paragraphs I through VII of the Amended Complaint Herein, [68] Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

## I.

That defendant-counterclaimant Rayford Camp is a citizen of the State of California and resident of the County of Los Angeles, State of California, and is carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co.

## II.

That on information and belief plaintiff-counterdefendants William J. Dubil and Edward J. Hubik are each citizens of the State of California and are the alleged owners of pretended United States Letters Patent No. 2,052,221.

## III.

That this is an action arising under the patent statutes of the United States, and the jurisdiction of this Court is founded thereon.

## IV.

That this counterclaim is brought under §247(d) of the Judicial Code, 28 U.S.C.A. Sec. 400, because there is an actual controversy now existing between the parties in respect of which these defendants need a declaration of their rights by this court, which controversy arises over the question of validity and infringement of United States Letters Patent No. 2,052,221 alleged to be owned by plaintiffs William J. Dubil and Edward J. Hubik, and of each and every one of the claims thereof, in that these plaintiffs have charged these defendants with infringing said Letters Patent.

## V.

That defendants adopt, repeat and reallege as paragraphs V to XIII, inclusive, of this counterclaim each and every one of the allegations contained in paragraphs A to I, inclusive, of defendants' answer above set forth with like effect as if fully herein repeated. [69]

For a Counterclaim Against Plaintiff Edward J. Hubik to the Claim or Cause of Action for Trademark Infringement Alleged in Paragraphs VIII through X of Plaintiffs' Complaint herein, Defendants Rayford Camp & Co. and Rayford Camp allege as follows:

## I.

That defendant-counterclaimant Rayford Camp is a citizen of California and resident of the County of Los Angeles, State of California, and is carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co.

## II.

That on information and belief plaintiff-counter-defendant Edward J. Hubik is a citizen of California and resident of the County of Los Angeles, State of California.

## III.

That on information and belief plaintiff-counter-defendant Edward J. Hubik on September 14, 1936, registered or caused to be registered in the office of the Secretary of the State of California at Sacramento, California, Registration No. 20515, the alleged trade-mark "Chip Steak."

## IV.

That the alleged trade-mark "Chip Steak" was and is not a proper subject of trade-mark registration and was and is registered contrary to and in violation of the laws of the State of California and is subject to cancellation thereunder in that said alleged trade-mark is merely descriptive of the goods or merchandise with which it is used, or of the class, character, or quality of such goods or merchandise and comprises and consists of words which are and have been, prior to any use thereof by the plaintiff-counterdefendant, in the public domain. [70]

Wherefore, these defendants pray for judgment against plaintiffs herein as follows:

- (a) That the Complaint and Amended Complaint herein be dismissed.
- (b) For declaratory judgment adjudging said Letters Patent No. 2,052,221, and each of the claims thereof, invalid and void and that said Letters Patent have not been infringed by these defendants.
- (c) That said trade-mark "Chip Steak" is invalid and void and ordering the registration thereof cancelled pursuant to Section 14246 of the Business and Professions Code of the State of California.
- (d) That these defendants have not been guilty of any acts of unfair competition or trade-mark infringement.
- (e) That these defendants recover from plaintiffs, and each of them, reasonable attorneys' fees.
- (f) That these defendants recover from plaintiffs the taxable costs of this action.
- (g) That these defendants be granted such other and equitable relief as may be proper.

Dated: At Los Angeles, California, this 4th day of March, 1949.

HARRIS, KIECH, FOSTER &  
HARRIS

FORD HARRIS, JR.,

By /s/ FORD HARRIS, JR.,

Attorneys for Defendants Rayford Camp & Co. and  
Rayford Camp.

Receipt of Copy acknowledged.

[Endorsed]: Filed March 8, 1949. [71]

[Title of District Court and Cause.]

PLAINTIFFS' ANSWERS TO DEFENDANTS'  
INTERROGATORIES V(a), VII, VIII, IX,  
X and XVI.

Comes now the plaintiff Earl F. Shores, and in answer to defendants' interrogatories V(a), VII, VIII, IX, X and XVI, the said plaintiff states:

V(a). The "exact" temperature range or limits within which meat must be at the time of slicing in performing the method of the patent in suit is unknown to this plaintiff. Temperatures vary with different kinds of meat, depending upon the fatty constituent. The claims call for "approximately" 30° F. to 32° F., which degrees are not believed to be "exact." This plaintiff states that it is believed that the method described by the defendant Rayford Camp in lines 6 to 14 of page 29, of his deposition taken January 18, 1949, is within the temperature range or limits within which meat must be at the time of slicing in performing the method of the [77] patent in suit. Deponent does not believe that meat may be at any lower temperature, at the time of slicing, in performing the method of the patent in suit, than that used by the defendant as aforesaid, and that meat cannot be satisfactorily sliced for the present purpose at higher than 32° F.

VII. There are not sufficient facts stated in interrogatory VII to definitely determine whether the method stated in lines 4 to 10 of page 27, in the deposition of the defendant Rayford Camp,

taken on January 18, 1949, will be contended by the plaintiffs at the trial hereof to infringe the patent in suit. If the meat is not first frozen and then the temperature raised for slicing, it will not be contended that such method is an infringement of the patent in suit. If, however, such process is that the meat is first frozen at 25° F., and later raised to a slicing temperature, at the time of slicing, then such method will be contended that it is an infringement of the patent in suit.

VIII. The plaintiffs will contend at the trial of this action that the method described by the defendant Rayford Camp in lines 6 to 14 of page 29, in his deposition taken January 18, 1949, is an infringement of the patent in suit.

IX and X. This plaintiff at this time does not know of any other method used by the defendants, than those referred to in interrogatories VII and VIII, so is unable to state whether any other method used by the defendants will be contended at the trial hereof to be an infringement. If any other method is used by the defendants which appears to be an equivalent to that referred to in interrogatory VIII, it will also be contended to be an infringement of the patent in suit. No such other method is known to this plaintiff at the present time.

XVI. The plaintiffs will contend at the trial of this action that the simultaneous use of defendants' label in the territory of the plaintiff Shores is calculated to and will deceive [78] the public into buy-

ing defendants' meat as the product of the plaintiff Shores because of the defendants' substantially identical arrangement of the waxed paper between the steaks that consists of six (6) laminations of very thin, fresh meat, because of the arrangement of subject matter on the two labels, because of the similarity of the names "Chip Steaks" and "Camp Steak," because of the arrangement of these names in an arch or curve, because of the central location of the head of a beef animal, because of the distinctive and contrasting coloring of the head of the beef animal, because defendants' label places in the hands of the retail butchers the means for deceiving the public, because of the arrangement of the labels in a stack of said steaks with portions thereof projecting from the stack, because of the similarity of the labels as a whole, and because of the use thereof.

/s/ EARL F. SHORES.

Subscribed and sworn to before me this 5 day of March, 1949.

[Seal] /s/ R. J. LONSDORF,

Notary Public in and for the County of Los Angeles, State of California.

My Commission Expires Jan. 18, 1952.

Receipt of Copy acknowledged.

[Endorsed]: Filed March 10, 1949. [79]

[Title of District Court and Cause.]

### STIPULATION

It is hereby stipulated by and between counsel for the above named parties that the annexed Amended Complaint may be filed in the above case.

Dated at Los Angeles, California, this 4th day of March, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

HARRIS, KIECH, FOSTER &  
HARRIS,  
FORD HARRIS, JR.,

By /s/ FORD HARRIS, JR.,  
Attorneys for defendants Rayford Camp & Co., and  
Rayford Camp.

The annexed Amended Complaint is ordered filed,  
this 10th day of March, 1949.

/s/ LEON K. YANKWICH,  
Judge, U.S. District Court.

[Endorsed]: Filed March 11, 1949. [85]

[Title of District Court and Cause.]

## AMENDED COMPLAINT

Infringement of United States Letters Patent  
No. 2,052,221

The plaintiffs complaining of the herein named defendants allege:

### I.

That the plaintiff William J. Dubil, a resident of Turlock, County of Stanislaus, State of California, is the inventor of the Method of Preparing Fresh Meat covered by U.S. Patent No. 2,052,221, hereinafter referred to as the patent in suit, and the said Dubil is the owner of an undivided one-half ( $\frac{1}{2}$ ) interest in and to the entire right, title and interest of the patent in suit. That the plaintiff Edward J. Hubik, a resident of North Long Beach, County of Los Angeles, State of California, is the owner of the other undivided one-half ( $\frac{1}{2}$ ) interest in and to the patent in suit, as shown by an instrument of assignment duly recorded in the United [86] States Patent Office prior to the issuance of said patent and as shown upon the face of said patent.

### II.

That on August 25, 1936, United States Letters Patent No. 2,052,221 were duly and legally issued to the plaintiffs Dubil and Hubik for an invention in Method of Preparing Fresh Meat; and since that date plaintiffs Dubil and Hubik have been and still are the owners of the said Letters Patent.

## III.

That the plaintiff Earl F. Shores, a resident of Los Angeles, County of Los Angeles, State of California, who is and has been doing business under the fictitious firm name of Chip Steak Company of Los Angeles, California, has the exclusive right to practice the method covered by said patent, throughout the County of Los Angeles, State of California, except the cities of Long Beach and Pomona, and except that territory which is bounded on the north by Slauson Avenue, on the south by Century Boulevard, on the west by Santa Fe Boulevard, and on the east by Atlantic Boulevard, the latter bounded territory lying wholly within the cities of Huntington Park and South Gate, in the County of Los Angeles, State of California. The County of Los Angeles, in the State of California (with the foregoing exceptions), is hereinafter referred to as said territory.

## IV.

That, upon information and belief, the above-named defendants are citizens of California, and residents of the County of Los Angeles, State of California, and are carrying on a business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co. That the true names of the defendants John Doe, Jane Doe and John Doe Co., are unknown to the plaintiffs at this time, but leave of court is requested to substitute their true names when ascertained by the plaintiffs. [87]

## V.

That this Honorable Court has jurisdiction of the cause of action herein, as the same is a suit in equity arising under the patent laws of the United States.

## VI.

That each of the defendants has been and is infringing said Letters Patent in said territory by preparing slices of fresh meat in accordance with the patented invention, and will continue to do so unless enjoined by this Court.

## VII.

That the plaintiffs have placed the number of the patent in suit on sheets of paper separating slices of fresh meat prepared under the patent in suit when such slices have been publicly offered for sale, and have given written notice to the defendants of their said infringement.

For a Second, Further and Additional Cause of Action Against the Defendants, the Plaintiffs Allege:

## VIII.

That the plaintiff Hubik originally adopted and used the trade-mark "Chip Steak" and registered same in the office of the Secretary of the State of California, at Sacramento, California, on September 14, 1936, Registration No. 20,515, and ever since such date notice of registration thereof has appeared on the labels used successively by the plaintiffs

Hubik and Shores, and each of them in said territory. That continuously since 1938, except for a period during the last war, when meat became very scarce, and continuously from the first part of 1946 to the present time, said periods being hereinafter referred to as such times, the plaintiff Shores has sold very thinly sliced, fresh meat molded in a round shape, with six (6) of such slices laid one upon another or laminated, to form a steak, hereinafter referred to as said laminated steaks. That the [88] labels used by the plaintiff Shores during such times, in connection with the sale in said territory of such thinly sliced, fresh meat, prepared in accordance with the method covered by the patent in suit, has consisted of waxed paper sheets bearing the trade-mark "Chip Steaks," with the trade-mark "Chip Steaks" appearing on said labels in a curve or arch adjacent a prominent and central picture of the head of a beef animal. The plaintiff Shores has during such times used said labels in said territory by placing same between said laminated steaks of very thinly sliced, fresh meat, produced in accordance with the patent in suit, by selling said laminated steaks, so labeled, in said territory. That by reason of the competent and efficient manner in which the plaintiff Shores has during such times conducted and is now conducting his said business, and by reason of the extensive advertising of said laminated steaks and selling same under the trade-mark "Chip Steaks," and by reason of the good will that has been built up during such times,

the said laminated steaks, so labeled, have come to be associated in said territory with the plaintiff Shores, in the mind of the public.

## IX.

That since February or March, 1948, the defendants have been and are selling very thin slices of fresh meat molded in a round shape with six (6) of such slices laid one upon another or laminated, to form a steak, hereinafter referred to as defendants' said laminated steaks. That the defendants since February or March, 1948, have been and are using in said territory, in connection with their sale of defendants' said laminated steaks, labels simulating the said labels of the plaintiff Shores. That defendants' labels contain the words "Camp Steak" arranged in a curve or arch adjacent the picture of the head of a beef animal, with the picture of the head of the animal arranged prominently and centrally of the label. That the defendants, and each of them, use said labels in the advertising of defendants' said laminated steaks by placing such labels, printed [89] on waxed paper, between defendants' said laminated steaks in the same manner as plaintiff Shores does and has done for a number of years, as stated. That the thinly sliced meat of the plaintiffs and defendants, sold in said manner and under said labels, are practically indistinguishable by the ordinary customer at the time same are offered to the public. That the use of such labels of the defendants in said territory in connection with the sale of defendants' said laminated steaks is calculated

to and will deceive the public into believing that they are buying the said laminated steaks of the plaintiff Shores when they are in fact buying the defendants' said laminated steaks, whereby irreparable injury is being done the plaintiffs, and each of them, by the actions of the defendants, and each of them, herein complained of.

## X.

That the defendant Rayford Camp prior to February, 1948, acted as a salesman for the plaintiff Shores for the sale of said "Chip Steaks" to butchers and markets in the Santa Monica area, in the County of Los Angeles, State of California, which route was owned and/or controlled by the plaintiff Shores. That the list of customers serviced in said route was and is the property of the plaintiff Shores. That such list of customers was and is a confidential list. That in February or March, 1948, the defendant Rayford Camp, in violation of said rights of the plaintiff Shores in and to said list of customers, and after terminating his connection with the said plaintiff Shores, wrongfully solicited the customers included in said list in said area, whom the defendant Rayford Camp had gotten to know by selling them "Chip Steaks." That the defendant Rayford Camp on or about and since the latter date has urged, and has endeavored to induce, said customers to purchase defendants' said laminated steaks, sold under the name of "Camp Steaks," with the result that some of said former customers of "Chip Steaks" of the plaintiff Shores

ceased purchasing plaintiff Shores' said laminated steaks, sold under [90] the trade-mark "Chip Steaks," and said customers ever since have been purchasing defendants' said laminated steaks from the defendant Rayford Camp, which unfair competition on the part of the defendant Rayford Camp has done and is doing irreparable injury to the business of the plaintiff Shores.

## XI.

That the plaintiffs have given the defendants due notice of the infringement upon plaintiff's said trade-mark and of defendants' unfair competition in the sale of defendants' laminated steaks and in the manner of displaying, advertising and using its mark herein complained of, but the defendants neglected and refused, continue to neglect and refuse to cease any of said acts complained of, and will continue to do so unless restrained by this court. The plaintiffs have no speedy or adequate remedy at law.

Wherefore, plaintiffs demand (a) preliminary and final injunctions against further infringement upon said patent and trademark and against further unfair competition by the defendants and those controlled by the defendants, (b) defendants' profits, (c) general damages not less than a reasonable royalty, and (d) an assessment of costs against the defendants.

/s/ C. G. STRATTON,

Attorney for Plaintiffs. [91]

State of California,  
County of Los Angeles—ss.

Earl F. Shores being by me first duly sworn, deposes and says: that he is one of the plaintiffs in the above entitled action; that he has read the foregoing Amended Complaint and knows the contents thereof; and that the same is true of his own knowledge, except as to the matters which are therein stated upon information or belief, and as to those matters that he believes it to be true.

/s/ EARL F. SHORES.

Subscribed and sworn to before me this 3rd day of March, 1949.

[Seal] /s/ VESTA NELSON,  
Notary Public in and for said County and State of California.

Receipt of Copy acknowledged.

[Endorsed]: Filed March 11, 1949.

[Title of District Court and Cause.]

### MOTION TO STRIKE

Come now the above-named plaintiffs by their counsel and move to strike paragraph "M" from the Answer to Amended Complaint and Counterclaim of Defendants Rayford Camp & Co. and Rayford Camp.

As grounds therefor the plaintiffs will rely upon the annexed Points and Authorities and upon the depositions and papers in the above file.

This Motion is not made for the purpose of delay and is made in good faith.

Dated at Los Angeles, California, this 10th day of March, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

### Points and Authorities

The Answer to the Amended Complaint and Counterclaim of the defendants (paragraph M) alleges as a bar to maintaining the action the defense of "unclean hands." It is submitted that this doctrine is subject to strict limitation of relevancy to the cause of action. To deny a litigant his day in court because of inequitable conduct, the conduct must have infected the cause of action and must relate to the activities concerning which the complaint is made.

The alleged conduct of the plaintiff, Shores, would have no relation whatsoever to a cause of

action for infringement of a patent, infringement of a trade-mark, or for the associated unfair competition relative to the infringements.

Germco Mfg. Co. v. McClellan, 107 Cal. App. 532 (1930).

“. . . The decision of the trial court having been based entirely on the proposition that plaintiff, with unclean hands, was in a court of equity, seeking relief, certainly it was highly prejudicial to allow evidence tending to show such fact of unclean hands to come into the case on wholly immaterial and irrelevant matters. . . . In the case at bar the trial court was vested with no discretion in the matter of admitting evidence upon these immaterial and irrelevant matters tending to show ‘unclean hands’ on the part of appellant.”

Western Union Telegraph Co. v. Commercial Pacific Cable Co., 177 Cal. 577 (1918).

“. . . The maxim that ‘He who comes into a court of equity must do so with clean hands,’ has reference to the particular transaction, in which relief is sought, and not to the general morals or conduct of the person seeking such relief.”

Keystone Driller Company v. General Excavator Company, 290 U.S. 240-247, 78 L. ed. 293.

“But courts of equity do not make the quality of suitors the test. They apply the maxim requiring clean hands only where some unconscionable act of one coming for relief has immediate and necessary

relation to the equity that he seeks in respect of the matter in litigation. They do not close their doors because of plaintiff's misconduct, whatever its character, that has no relation to anything involved in the suit but only for such violations of conscience as in some measure affect the equitable relations between the parties in respect of something brought before the court for adjudication. Story, Eq. Jur. §100. Pom. Eq. Jur. §399. They apply the maxim, not by way of punishment for extraneous transgressions but upon considerations that make for the advancement of right and justice. They are not bound by formula or restrained by any limitation that tends to trammel the free and just exercise of discretion." (Underlines added.)

First Trust & Savings Bank et al. v. Iowa-Wisconsin Bridge Co., 98 F. (2d) 416, (C.C.A. 8, 1938).

"This 'clean hands doctrine' is subject to the familiar limitation that a plaintiff is not barred from relief in a court of equity unless his wrong has an immediate and necessary relation to the equity for the enforcement of which he prays. Keystone Driller Co. v. General Excavator Co., 290 U.S. 240, 54 S.Ct. 146, 78 L.Ed. 293; Talbot vs. Independent Order of Owls, 8 Cir., 220 F. 660; Olsness v. Home Ins. Co., 8 Cir., 14 F. 2d 907; Trice v. Comstock, 8 Cir., 121 F. 620, 61 L.R.A. 176; Primeau v. Granfield, 2 Cir., 193 F. 911."

Receipt of copy acknowledged

[Endorsed]: Filed March 11, 1949.

[Title of District Court and Cause.]

## STIPULATION

It Is Hereby Stipulated by and between counsel for the above-named parties that the Amended Reply of Plaintiffs William J. Dubil and Edward J. Hubik to Counterclaims of Defendants shall be taken to be the reply of the last-mentioned plaintiffs to the counterclaims set forth in defendants' Answer to Amended Complaint and Counterclaim of Defendants Rayford Camp & Co., and Rayford Camp.

Dated at Los Angeles, California, this 11th day of March, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

HARRIS, KIECH, FOSTER &  
HARRIS,  
FORD HARRIS, JR.,  
By /s/ FORD HARRIS, JR.,  
Attorneys for Defendants.

So Ordered this 14th day of March, 1949.

/s/ LEON R. YANKWICH,  
Judge of U. S. District Court.

[Endorsed]: Filed March 14, 1949. [94]

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[Title of District Court and Cause.]

## STIPULATION

It is hereby stipulated by and between the parties

to the above-entitled action, through their respective attorneys, as follows:

(a) Uncertified printed copies or uncertified photostatic or photographic copies of United States and foreign Letters Patent may be offered and received in evidence, subject to all legal objections other than that such copies are secondary evidence, with the same force and effect as the originals, and that the printed dates of application and issuance of such Letters Patent shall be taken as *prima facie* evidence of the actual dates thereof respectively, subject to correction at any time for errors; and

(b) Photostatic or photographic copies of written documents may be offered and received in evidence in lieu of the originals thereof, but subject to all legal objections other than that such copies are secondary evidence, [95] provided that the party offering the same shall produce the originals thereof and permit the other party to compare the copy offered with the original thereof.

Dated At: Los Angeles, California, this 16th day of March, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

HARRIS, KIECH, FOSTER &  
HARRIS,  
By /s/ FORD HARRIS, JR.,  
Attorneys for Defendants.

[Endorsed]: Filed March 17, 1949. [96]

[Title of District Court and Cause.]

### MOTION TO INSPECT

Come now the above-named plaintiffs and move that this Honorable Court enter an Order under Rule 34 of the Rules of Civil Procedure, to permit the entry upon defendants' place of business at 11871 Florence Avenue, Culver City, California, for the purpose of inspecting, measuring, surveying or photographing the carrying out of the process or method carried on by the defendants as described in the defendant Rayford Camp's deposition taken on January 18, 1949, page 29, lines 6 to 14 thereof, and for the purpose of testing the refrigeration equipment used by the defendants in the tempering room, and as grounds therefor the plaintiffs show the following:

1. The patent in suit is upon the method or process of preparing thinly sliced fresh meat.
2. The plaintiffs have no way of knowing the process carried out by the defendants, which is charged to infringe, other than by an inspection of the defendants' plant carrying out such process. The only information the plaintiffs have at the present time is the unsupported statement of the defendant Rayford Camp himself.
3. The defendants invited the plaintiffs to visit said plant of the defendants for the purpose of inspecting the process employed by the defendants which is charged to infringe in this case, and thereafter, prior to the appointed time, such invitation

was withdrawn by the defendants, which is stated in the following words in the deposition of the defendant Rayford Camp, taken on January 27, 1949, beginning on page 8, line 14, and ending on page 9, line 2:

"Q. I wanted to place in the record the fact that at the close of your deposition last week your counsel invited the plaintiffs and plaintiffs' counsel to come to your plant at 10:30 a.m. to witness the way you make your steaks. You recall that, I take it?

"A. I believe that there was a discussion of that nature.

"Q. And such an invitation was made?

"A. I don't recall.

Mr. Harris: I will stipulate that it was made.

Mr. Stratton: I will accept the stipulation.

"Q. Then I believe you are aware that the invitation was withdrawn?

Mr. Harris: I will so stipulate.

Mr. Stratton: I accept the stipulation."

The only excuse given by defendant's counsel for not agreeing to such inspection is that the defendant claims to have some secret matters at his plant, but that is not sufficient excuse to prevent plaintiffs seeing the process involved here.

This Motion is not made for the purpose of delay and is made in good faith.

At the hearing on this Motion the plaintiffs will rely upon the annexed Points and Authorities, and

upon the depositions and the papers in the file in the above case.

Dated at Los Angeles, California, this 10th day of March, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

### Points and Authorities

The plaintiffs are entitled to inspect the place of business of the defendants and witness the carrying on of the process charged to infringe.

- Rule 34, Rules of Civil Procedure
- Corbett v. Columbia Transportation Co.,  
5 F.R.D. 217 (U.S. Dist. Ct., W.D. N.Y.  
1946)
- Farr v. Delaware, Lackawanna & Western  
R. Co., 8 F.R.S. 34.25 (U.S. Dist. Ct., S.D.  
N.Y. 1944)
- Mulligan v Eastern Steamship Lines, Inc.  
6 F.R.D. 601 (U.S. Dist. Ct., S.D. N.Y.,  
1946)

Receipt of Copy acknowledged.

[Endorsed]: Filed March 14, 1949.

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[Title of District Court and Cause.]

### ORDER RE INSPECTION OF PLANTS

This matter came on to be heard upon the plaintiffs' Motion to Inspect the defendants' place of business, and after considering the defendants'

Memorandum in opposition thereto, and after hearing the arguments of counsel, the Court being advised in the premises,

Hereby Orders that the plaintiffs' counsel, C. G. Stratton, a Notary Public, and not more than two other persons (neither of whom shall be one of the plaintiffs in this case) shall be given access to the defendants' place of business at 11871 Florence Avenue, Culver City, California, on Wednesday, March 23, 1949, at 2:00 p.m., at which time the defendant Rayford Camp, or one or more employees at his direction, will demonstrate for such parties the process charged to infringe the patent in suit, and more particularly the [97] process described by the defendant Rayford Camp on page 29, lines 6 to 14 thereof, of his deposition taken on January 18, 1949; that plaintiffs' said representatives may make all necessary inspection and temperature tests on said days incidental to the carrying out of said tests; and that the plaintiffs' said counsel may designate a representative of some testing concern to call at defendants' said place of business at 4:30 p.m. Monday and again on Tuesday, March 21 and 22, 1949, for the purpose of placing and sealing in different places in the refrigerators at the defendants' said place of business, including attaching and sealing thermometers to the molds containing the meat to be sliced by the defendants on Wednesday, March 23, in carrying out the process as aforesaid; and that the defendants will indicate to such representative on said visits which molds are to be employed in the said tests.

That the defendants' counsel, Ford Harris, Jr., a Notary Public, and not more than two other persons (neither of whom shall be the defendant Rayford Camp) shall be given access to the plaintiff Shores' place of business at 4151 South Main Street, Los Anglees, California, on Thursday, March 24, 1949, at 2:00 p.m. at which time the plaintiff Shores, or one or more employees at his direction, will demonstrate for such parties the process carried on under the patent in suit and which the plaintiffs will rely upon as showing commercial success of the patent in suit; that the defendants' said representatives may make all necessary inspection and temperature tests on said days incidental to the carrying out of said tests; and that the defendants' said counsel may designate a representative of some testing concern to call at plaintiff Shores' said place of business at 4:30 p.m. Tuesday and again on Wednesday, March 22 and 23, 1949, for the purpose of placing and sealing in different places in the refrigerators at the plaintiff Shores' said place of business, including attaching and sealing thermometers to the molds containing the meat to be sliced by the defendants on [98] Thursday, March 24, 1949, in carrying out the plaintiff Shores' process as aforesaid; and that the plaintiff Shores will indicate to such representative on said visits which molds are to be employed in the said tests.

That the plaintiff Shores may charge the defendants, and the defendants may charge the plaintiffs the following costs in connection with said tests:

the actual cost of any additional labor necessary for conducting said tests and the cost of actual materials used. No attorney's fees, time of the parties to this suit, overhead expense, rent, depreciation, power, salaries (other than the time of the persons actually doing the work) nor any machinery expense whatsoever shall be charged. The party desiring to file such a cost bill shall do so prior to the trial of this case, to be heard by the undersigned at some convenient time thereafter, which shall itemize the name of the employee doing the work, giving the actual time spent in hours and minutes and stating the exact character of the work done, and the usual salary paid such party for said length of time. The materials charged shall not be more than six (6) logs of meat of customary size sliced by the parties hereto, the amount to be sliced shall be determined by the party to be charged for such expense.

Done In Open Court, this 18th day of March, 1949.

/s/ LEON R. YANKWICH,  
U. S. District Judge.

Approved As To Form:

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

HARRIS, KIECH, FOSTER &  
HARRIS,  
FORD HARRIS, JR.,  
By /s/ FORD HARRIS, JR.,  
Attorneys for Defendants.

[Endorsed]: Filed March 18, 1949. [99]

[Title of District Court and Cause.]

## DEFENDANTS' ANSWERS TO PLAINTIFFS' INTERROGATORIES

Defendants answer plaintiffs' interrogatories as follows:

1 (a). No.

1 (b). No. .

2 (a). The file-wrapper references cited by the Patent Office during the prosecution of the application for the patent in suit may also be used at the trial.

2 (b). To establish invalidity of the patent in suit, defendants may also rely upon the testimony of the following witnesses: [100]

Name	Address
Rayford Camp	11871 Florence Avenue, Culver City, California
Al Rumley	Las Vegas, Nevada
Leonard Frederick	1334 No. Vine Street, Hollywood, California
Larry Frederick	1334 No. Vine Street, Hollywood, California
William Frederick	1334 No. Vine Street, Hollywood, California
John Badavini	Unknown
Louis Bryant	Unknown
Gordon Wells	Unknown
Robert Pierson	Unknown
Solomon Shapiro	Unknown
S. D. Baird	Inglewood, California
Other possible witnesses	are at this time unknown.

2 (c) Claim to Trade-Mark of William Frederick, filed with the Secretary of State of California on September 11, 1935, on the name "Strat-O-Fry Steak"; claim to Trade-Mark of William Frederick, filed with the Secretary of State of California on September 11, 1935, on the name "Strat-O-Steak"; advertisements appearing in the Hollywood Citizen News Newspaper in 1934 and 1935, advertising the laminated steak products made and sold by said Fredericks.

/s/ RAYFORD CAMP,  
Rayford Camp, individually and doing business as  
Rayford Camp & Co.

Subscribed and sworn to before me this 15th day  
of March, 1949.

[Seal]      /s/ JAMES HOGAN,  
Notary Public in and for the County of Los Angeles,  
State of California.

My Commission Expires Sept. 16, 1951.

Receipt of copy acknowledged.

[Endorsed]: Filed March 18, 1949. [101]

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At a stated term, to wit: The February Term.  
A.D. 1949, of the District Court of the United States  
of America, within and for the Central Division of  
the Southern District of California, held at the  
Court Room thereof, in the City of Los Angeles on  
Monday the 28th day of March in the year of our

Lord one thousand nine hundred and forty-nine.

Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For Court trial; C. G. Stratton, Esq., appearing as counsel for plaintiffs; Ford Harris, Jr., George M. Breslin, and W. L. Kern, Esqs., appearing as counsel for defendants;

Attorney Stratton makes a statement; Plf's Ex. 1 is admitted in evidence, and Plfs' Ex. 2 and 3 are marked for ident.

At 10:54 a.m. court recesses for ten minutes. At 11:05 a.m. court reconvenes herein and all being present as before, Attorney Stratton resumes opening statement to the Court.

At 11:06 a.m., Attorney Harris makes opening statement to the Court for defendants.

At 11:37 a.m., Lee Allen Schmidt is called, sworn, and testifies for plaintiff.

At noon court recesses to 2 p.m. At 2 p.m. court reconvenes herein and all being present as before, Attorney Stratton makes a statement.

At 2:03 p.m. Otis M. Gunderson is called, sworn, and testifies for plaintiff.

At 2:12 p.m. Rayford Camp, defendant, is called under Rule 43-B FRCP as a witness for plaintiffs and is cross-examined by Attorney Stratton. Plf's Ex. 4 is marked for ident.

At 3:20 p.m. court recesses for ten minutes. At 3:33 p.m. court reconvenes herein and all being

present as before, defendant Rayford Camp resumes the stand and testifies on further cross-examination by Attorney Stratton.

At 4:04 p.m. Court declares a recess in this trial until 11 a.m. March 29, 1949.

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At a stated term, to wit: The February Term. A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles on Tuesday the 29th day of March in the year of our Lord one thousand nine hundred and forty-nine.

Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further Court trial; C. G. Stratton, Esq., appearing as counsel for plaintiffs; Ford Harris, Jr., W. L. Kern, Esq., and Geo. M. Breslin, Esq., appearing as counsel for defendants; and Thos. B. Goodwill, Reporter, being present and reporting these proceedings;

Rayford Camp, heretofore sworn, resumes the stand and testifies further on cross-examination by Attorney Stratton under Rule 43-B FRCP. Plf's Ex. 5 and 6 are marked for ident., and later admitted in evidence. At noon court recesses to 2 p.m. At 2 p.m. court reconvenes herein and all being present as before, Court orders that the trial proceed.

Rayford Camp resumes the stand and testifies further on examination by Attorney Stratton under Rule 43-B, FRCP. Plf's Ex. 7, 8, 9, and 10 are marked for ident. and later admitted in evidence. At 2:55 p.m. Edward Munyon is called, sworn, and testifies for plaintiff. At 3:20 p.m. court recesses for ten minutes. At 3:32 p.m. court reconvenes herein and all being present as before, Court orders trial proceed. Plf's Ex. 11 is marked for ident.

At 3:55 p.m. Court declares a recess in the trial of this cause until 10 a.m., March 30, 1949.

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At a stated term, to wit: The February Term. A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles on Wednesday, the 30th day of March in the year of our Lord one thousand nine hundred and forty-nine. Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further Court trial; C. G. Stratton, Esq., appearing as counsel for plaintiffs; Ford Harris, Jr., Warren L. Kern, and Geo. M. Breslin, Esqs, appearing as counsel for defendants; at 10:12 a.m. court reconvenes herein;

Statements are made to the Court respectively by Attorneys Stratton and Harris. Robert M. Bonus,

at 10:13 a.m., is called, sworn, and testifies for plaintiff. At 11:12 a.m. court recesses for ten minutes.

At 11:21 a.m. court reconvenes herein and all being present as before, Robert M. Bonus resumes the stand and testifies further. At 12:03 p.m. court recesses to 2 p.m.

At 2 p.m. court reconvenes herein and all being present as before, Robert M. Bonus resumes the stand and testifies further.

At 2:56 p.m. Ronald Wellington Arnold is called, sworn, and testifies for plaintiff.

At 3:58 p.m. Court declares a recess in the trial of this cause until 10 a.m., March 31, 1949.

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At a stated term, to wit: The February Term. A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles on Thursday the 31st day of March in the year of our Lord one thousand nine hundred and forty-nine.

Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further Court trial; C. G. Stratton, Esq., appearing as counsel for plaintiffs; Ford Harris, Jr., W. L. Kern, and G. M. Breslin, Esqs, appearing as counsel for defendants; Court declares a recess herein until 11 a.m. today.

At 11 a.m. court reconvenes herein and all being present as before, Attorney Stratton makes a statement to the Court.

Donald M. Urton, at 11:07 a.m., is called, sworn, and testifies for plaintiff. Plf's Ex. 12 and 13 are marked for ident., and later admitted in evidence.

At noon court recesses to 2 p.m. At 2 p.m. court reconvenes herein and all being present as before, Donald M. Urton resumes the stand and testifies further. Deft's Ex. A is marked for ident.

Hal Gross, at 2:18 p.m., is called, sworn, and testifies for plaintiff.

Wm. T. Carpenter, at 2:30 p.m., is called, sworn, and testifies for plaintiff. Plf's Ex. 14 and 15 are marked for ident. and later admitted in evidence.

At 2:54 p.m. court recesses for ten minutes. Court reconvenes herein and all being present as before, Wm. T. Carpenter resumes the stand and testifies further.

Edw. J. Hubik, at 3:49 p.m., is called, sworn, and testifies for plaintiff. Plf's Ex. 16 is marked for ident. and later admitted in evidence.

At 4:02 p.m., Court declares a recess in the trial of this cause to 10 a.m., April 1, 1949.

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At a stated term, to wit: The February Term. A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles on Friday the 1st day of April in the year of our Lord

one thousand nine hundred and forty-nine.

Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further Court trial; C. G. Stratton, Esq., appearing as counsel for plaintiffs; Ford Harris, Jr., Warren L. Kern, and George M. Breslin, Esqs, appearing as counsel for defendants; at 10:06 a.m. Attorney Stratton makes a statement. Edw. J. Hubik, at 10:12 a.m., heretofore sworn, resumes the stand and testifies further. At 10:42 a.m. Earl F. Shores is called, sworn, and testifies for plaintiffs. Plfs' Ex. 2 and 17 are marked for ident., and later admitted in evidence. At 11:09 a.m. court recesses for ten minutes.

At 11:22 a.m. court reconvenes herein and all being present as before, Earl F. Shores testifies further. Plfs' Ex. 18, 19, 20, 21, and 22, respectively, are admitted in evidence. At 12:05 p.m. court recesses to 2 p.m.

At 2 p.m. court reconvenes herein and all being present as before, Earl F. Shores testifies further.

Albert M. Rumley is called out of order at 2:13 p.m. and testifies for defendant. Defts' Ex. B, C, and D are marked for ident.

At 3:19 p.m. court recesses for ten minutes. At 3:30 p.m. court reconvenes herein and all being present as before. Earl F. Shores testifies further. Plfs' Ex. 23 and 24 are admitted in evidence.

At 4 p.m. Court declares a recess in this trial until 10 a.m., April 4, 1949.

At a stated term, to wit: The February Term. A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles, on Monday the 4th day of April in the year of our Lord one thousand nine hundred and forty-nine.

Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further court trial; C. G. Stratton, Esq., appearing as counsel for plaintiffs; Ford Harris, Jr., W. L. Kern, and Geo. M. Breslin, Esqs, appearing as counsel for defendants; Plfs' Ex. 11 for ident. is ordered withdrawn by counsel for defendants.

Earl F. Shores, heretofore sworn, resumes the stand at 10 a.m. Plfs' Ex. 25 is marked for ident. and later admitted in evidence.

Arthur B. Lewis, at 10:43 a.m., is called, sworn, and testifies for plaintiff.

At 10:50 a.m. court recesses for ten minutes. At 11:03 a.m. court reconvenes herein and all being present as before, Witness Lewis resumes the stand and testifies further. At 11:56 a.m. court recesses to 2 p.m. today.

At 2:10 p.m. court reconvenes herein and all being present as before, except Attorney Breslin, who is absent, Court orders trial proceed;

Arthur B. Lewis resumes the stand and testifies further.

Attorney Stratton reads deposition of Wm H. Sloan into the record. Plfs' Ex. 26 to 30 incl. are marked for ident. and later admitted in evidence.

Attorney Stratton having presented for filing a petition for an order to show cause why the defendant Rayford Camp should not be held in contempt of Court together with order for signature of the Court, the Court declines to sign said order. At 4:03 p.m. plaintiffs rest.

Court orders cause continued to 10 a.m., April 5, 1949.

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[Title of District Court and Cause.]

### DEFENDANTS' OBJECTIONS TO PLAINTIFFS' INTERROGATORIES TO WILLIAM H. SLOAN

Pursuant to Rule 32 C(3) of the Federal Rules of Civil Procedure, defendants hereby object to the following written interrogatories propounded by the plaintiffs herein to William H. Sloan, for the reasons hereinafter stated:

- A. Interrogatories 4, 5, and 6.
  - (a) There is no proper foundation for the question.
  - (b) The question is not relevant to any issues involved in this action.
- B. Interrogatories 7 and 8.
  - (a) There is no proper foundation for the question.

- (b) The question calls for an answer which is hearsay.
- (c) The question is not relevant to any issues involved in this action.
- (d) The question calls for an answer which is not the best evidence of the facts which are sought.

Dated: At Los Angeles, California, this 25 day of February, 1949.

HARRIS, KIECH, FOSTER &  
HARRIS,  
FORD HARRIS, JR.,  
By /s/ FORD HARRIS, JR.,  
Attorneys for Defendants.

Receipt of Copy acknowledged.

[Endorsed]: Filed April 4, 1949.

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At a stated term, to wit: The February Term A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California held at the Court Room thereof, in the City of Los Angeles on Tuesday the 5th day of April in the year of our Lord one thousand nine hundred and forty-nine.

Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further court trial; C. G. Stratton, Esq., ap-

pearing as counsel for plaintiffs; Ford Harris, Jr., W. L. Kern, and Geo. M. Breslin, Esqs., appearing as counsel for defendants;

Counsel stipulate that the meat exhibits in this case may be destroyed, said exhibits being Plfs' Ex. 4, 7, 8, 9, 17, 18, 19, 20, 21, and 22, and the Court so orders.

At 10:05 a.m. Attorney Harris moves to dismiss the case and argues in support thereof. At 10:33 a.m. Attorney Stratton argues in reply. Attorney Harris argues further. The Court makes a statement and denies said motion of defendant to dismiss.

At 11:04 a.m. court recesses for ten minutes. At 11:25 a.m. court reconvenes herein and all being present as before, Court orders trial proceed.

Defts' Ex. A, E, and F, and F-1, F-2, F-3, F-4, F-5, and F-6, respectively, are admitted in evidence. Defts' Ex. G and H are marked for ident. and later admitted in evidence.

Rayford Camp, heretofore sworn, is called as a witness for defendants and testifies on direct examination by Attorney Harris.

At noon court recesses to 2 p.m. At 2 p.m. court reconvenes herein and all being present as before, Court orders trial proceed. Marie Zellner, Reporter, is present and reports the proceedings.

Rayford Camp resumes the stand and testifies further, and is withdrawn.

At 2:50 p.m. Bernard V. Merge is called, sworn,

and testifies for defendants. Defts' Ex. I, J, and K are marked for ident. and later admitted in evidence. Defts' Ex. B, C, and D, heretofore marked for ident., are admitted in evidence.

At 3:05 p.m. court recesses for ten minutes. At 3:28 p.m. court reconvenes herein and all being present as before, Defts' Ex. L is admitted in evidence.

Rayford Camp resumes the stand and testifies further, on examination by Attorney Harris. Defts' Ex. M, N, and O, are marked for ident., and O is admitted in evidence.

At 3:54 p.m. Court declares a recess in the trial of this cause until 10 a.m., April 6, 1949.

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At a stated term, to wit: The February Term. A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles on Wednesday the 6th day of April in the year of our Lord one thousand nine hundred and forty-nine.

Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further court trial; C. G. Stratton, Esq., appearing as counsel for plaintiff; Ford Harris, Jr., W. L. Kern, and Geo. M. Breslin, Esqs., appearing

as counsel for defendants; at 10:06 a.m. court reconvenes herein;

Rayford Camp, heretofore sworn, testifies further, Plfs' Ex. 31 is admitted in evidence, and Plfs' Ex. 32 is marked for ident. and later admitted in evidence. At 11:13 a.m. court recesses for ten minutes.

At 11:25 a.m. court reconvenes herein and all being present as before, Rayford Camp testifies further.

At 11:44 a.m. F. M. Mushrush is called, sworn, and testifies for defendants.

At 12:07 p.m. court recesses to 2 p.m. At 2 p.m. court reconvenes herein and all being present as before, Court orders trial proceed.

Wm. Howard Frederick, at 2:02 p.m., is called, sworn, and testifies for defendants, and Defts' Ex. P is marked for ident. and later admitted in evidence, and Plfs' Ex. 33 is admitted in evidence.

Lawrence E. Frederick, at 2:38 p.m., is called, sworn, and testifies for defendants. At 3:25 p.m. court recesses for ten minutes.

At 3:36 p.m. court reconvenes herein and all being present as before, F. M. Mushrush, heretofore sworn, testifies further. Defts' Ex. M and N, for ident., are admitted into evidence, and Defts' Ex. Q is marked for ident.

At 3:59 p.m. Court declares a recess in this trial until 10 a.m., April 7, 1949.

At a stated term, to wit: The February Term. A.D. 1949, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles on Thursday the 7th day of April in the year of our Lord one thousand nine hundred and forty-nine. Present: The Honorable Charles C. Cavanah,  
District Judge.

[Title of Cause.]

For further Court trial; C. G. Stratton, Esq., appearing as counsel for plaintiffs; Ford Harris, Jr., and W. L. Kern, Esqs., appearing as counsel for defendants;

F. M. Mushrush, heretofore sworn, at 10 a.m., resumes the stand and testifies further. Plfs' Ex. 34 is admitted in evidence.

At 11:18 a.m. court recesses for ten minutes. At 11:28 a.m. court reconvenes herein and all being present as before, Witness Mushrush testifies further.

Earl F. Shores, heretofore sworn, is called under Rule 43, FRCP, and testifies on cross-examination by Attorney Harris.

Rayford Camp, heretofore sworn, is recalled at 11:33 a.m. and testifies on direct examination by Attorney Harris, Jr.

Defts' Ex. R is marked for ident., and Defts' Ex. R, S, T, and U are admitted in evidence.

Edw. J. Hubick, heretofore sworn, is recalled at 11:38 a.m., under Rule 43-B FRCP, and testifies on examination by Attorneys Harris and Stratton,

respectively. Plfs' Ex. 35 and 36 are marked for ident. and later admitted in evidence. At 11:50 a.m. defendants rest.

Witness Robert M. Bonus, heretofore sworn, is called in rebuttal and testifies for plaintiffs on direct examination by Attorney Stratton.

At noon court recesses to 2 p.m. today for further trial.

At 2 p.m. court reconvenes herein and all being present as before, Attorney Breslin, of counsel for defendants, still being absent;

Witness Bonus resumes the stand and testifies further on cross-examination by Attorney Harris.

Plaintiffs rest in rebuttal at 2:03 p.m., and there is no surrebuttal. Attorney Stratton commences his argument to the Court at 2:03 p.m.

At 2:55 p.m. Court declares a recess for ten minutes.

At 3:04 p.m. court reconvenes herein and all being present as before, Attorney Stratton argues further.

At 3:05 p.m. Attorney Harris commences his argument to the Court, and closes at 3:50 p.m.

At 3:50 p.m. Attorney Stratton resumes his argument for plaintiff in reply to the Court, and the Court orders that each side have ten days to file memo., and seven days thereafter to answer opposing memorandum; in other words, all briefs are to be filed by April 25, 1949, and that the case then will stand submitted.

In the United States District Court, Southern  
District of California, Central Division  
Civil No. 8649-Y

WILLIAM J. DUBIL, EDWARD J. HUBIK, and  
EARL F. SHORES,

Plaintiffs;

vs.

RAYFORD CAMP & COMPANY, RAYFORD  
CAMP, JOHN DOE, JANE DOE, and JOHN  
DOE CO.,

Defendants.

OPINION

Cavanah, District Judge.

In the present action the plaintiffs assert that the plaintiff William J. Dubil is the inventor of the Method of Preparing Fresh Meat covered in the patent in suit, and that the plaintiffs Edward J. Hubik and Earl F. Shores are now the owners thereof. That the plaintiff Earl F. Shores, a resident of Los Angeles County, State of California, doing business under the fictitious firm name of "Chip Steak Company" of Los Angeles, California, has the exclusive right to practice the method covered by the patent, throughout the County of Los Angeles, except the cities of Long Beach and Pomona and certain other alleged territory.

That the defendants are carrying on a business in Los Angeles County under the fictitious name of Rayford Camp & Company, and are now and have been infringing said Letters Patent in said territory

by preparing slices of fresh meat in accordance with the patented invention, and will continue to do so unless enjoined by this court. That the plaintiffs have placed the number of the patent in suit on sheets of paper separating slices of fresh meat prepared under the patent when such slices have been publicly offered for sale and have given written notice to the defendants of their [112] infringement.

For a second and further cause of action, the plaintiffs allege, that the plaintiff Hubik originally adopted and used the trade-mark "Chip Steak" and registered same in the office of the Secretary of State of California on September 14, 1936. That continuously since 1938, except for the period during the last war, and from the first part of 1946 to the present time, the plaintiff Shores has sold very thinly sliced, fresh meat, molded in a round shape, with six of such slices laid one upon the other to form a steak, and the method covered by the patent has consisted of waxed paper sheets bearing the trade-mark "Chip Steaks," appearing in a curve adjacent a central picture of a head of a beef animal.

That since February or March, 1948, the defendants have been and are selling very thin slices of fresh meat molded in a round shape with six of such slices laid one upon the other to form a steak, and are using labels simulating the labels of the plaintiff Shores, and containing the words "Camp Steak" arranged in an arch adjacent to the picture of the head of a beef animal, and are using the labels in

the advertising of defendants' said steaks, and to deceive the public in believing that they are buying the steaks of the plaintiff Shores.

The defendants answer and place in issue the material allegations of plaintiffs' complaint and assert (a) that the Letters Patent in suit are invalid and have not been infringed by the defendants; (b) that the alleged trade-mark "Chip Steaks" is invalid; (c) that the defendants have not been guilty of any acts of unfair competition or trademark infringement; and (d) urge recovery upon their alleged counterclaims.

Under the issues thus presented, and recognizing the general rule that in this class of cases the burden of proof to establish the allegations of plaintiffs' complaint rests upon the plaintiffs by a preponderance of the evidence that is clear [113] and convincing, we then approach an analysis of the evidence in which there appears to be considerable repetition, confusion, and a keen conflict which presents to the mind a lack of clearness and confusion as to the method adopted by the parties in adopting the process when in preparing the meat for use and sale. But the first question to be considered is, was the patent in suit valid for want of invention as the defendants urge. The plaintiff was not the original and first inventor or discoverer of the material part of the thing patented as it had been in public use or on sale in this country for more than one year before his application for a patent, and is indefinite and will not work.

The patent in suit was issued on August 25, 1936,

and the process to be patentable must possess novelty. 35 U.S.C.A., sec. 31, p. 186. From a study of the prior art patents in evidence, each of the steps of the process described and claimed in the patent in suit and the combination of such process steps has been heretofore taught by the disclosures of the prior arts disclosed by the patents to Taylor, Nos. 1,864,284, and 1,864,285, and patents to McKee Nos. 2,140,162 and 2,137,897.

The patent office was misled and did not consider the prior art patents of the McKee and Taylor patents in granting the application for the patent in suit and, due to such failure, is of particular significance with respect to the presumption of validity which normally would aid in upholding it if destroyed. Hann v. Venetian Blind Corporation, 21 Fed. Supp. 913; Mettler v. Peabody Engineering Corp., 77 Fed. 2d 56 (C.C. App. 9th).

The process of preparing meat by the specific steps of the patent in suit is old in the art, therefore, invention is not shown. The Supreme Court has said that, ". . . To claim the merit of invention the patented process must itself possess novelty. The application of an old process to a new and closely analogous [114] subject matter, plainly indicated by the prior art as an appropriate subject of the process, is no invention." Paramount Publix Corporation v. American Tri-Ergon Corporation, 294 U.S. 464, 79 L.ed. 997; Dow Chemical Co. v. Halliburton, etc. Co., 324 U.S. 320, 89 L.ed. 973; Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U.S. 84, 86 L.ed. 58.

Invention is not shown because the patentee in suit specified in his claims exact temperature and time limitations required in the performance of his steps. For example, the slicing temperature range of 30° to 32°F. is broadly covered in the disclosure of the McKee patent 2,137,897, which specifies 0° to 32°F. The greater always includes the lesser. *Newton Steel Co. v. Surface Combustion Co.*, 75 Fed. 2d 305. Commercial success alone is not sufficient to validate a patent. *Heath v. Frankel*, 153 Fed. 2d 369; *Standard Parts, Inc. v. Toledo Pressed Steel Co.*, 93 Fed. 2d 336; *Weidhaas v. Loew's, Inc.*, 125 Fed. 2d 544, in which certiorari denied, 316 U.S. 684, 86 L.ed. 1757..

The evidence discloses that prior uses of the process described in the patent in suit were made by the defendant and others in the preparation of "Strato-Steaks." The statute requires that the alleged invention be not known or used by others before the patentees' invention or discovery thereof. Title 35 U.S.C.A., sec. 31, p. 186; *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 70 L.ed. 651; *Barber v. Otis Motor Sales Co.*, 271 Fed. 171, cert. den. 256 U.S. 693, 65 L.ed. 1175; *Torrey v. Hancock*, 184 Fed. 61; *National Mach. Corp. v. Bentall Mach. Co., Inc.*, 241 Fed. 72; *Columbus Dental Mfg. Co. v. Ideal Interchangeable Tooth Co., Inc.*, 294 Fed. 422.

The claims in the patent in suit are broader and more indefinite than the alleged invention, as its claims specify [115] in performing the process that the meat shall be thawed to a temperature of ap-

proximately 30° to 32°F. and then sliced into thin slices. This temperature range is contended by plaintiffs to be highly critical, yet, the evidence establishes that the process could not be performed within that entire temperature range. The alleged process is for slicing meat within a different temperature range than the 30° to 32°F. Where the claims, as here, do not specify a complete operative range of conditions but require the user to experiment, the claims are indefinite resulting in the patent becoming invalid. *Tucker v. Spalding*, 80 U.S. 453, 20 L.ed. 515; *Merrill v. Yeomans*, 94 U.S. 573, 24 L.ed. 235; *Standard Oil Co., etc., v. Tide Water Associated Oil Co.*, 154 Fed. 2d 579; *Eisenstein v. Fibiger*, 160 Fed. 686.

The evidence discloses that the patent in suit is invalid for the reasons thus stated as it is fully anticipated by the prior arts, there is no invention disclosed. There was prior public use, that the claims therein are indefinite and broader than the alleged invention, and were issued on misrepresentations to the United States Patent Office.

The conclusion having been reached that the patent in suit is invalid, we need not consider the question of whether defendants infringed it. *Cuno Engineering Corporation v. Automatic Devices Corp.*, 314 U.S. 84, 86 L.ed. 58.

The mere fact that a consent decree of this court, upholding the validity of the patent in suit is not controlling in the present action, as the defenses here were not before the court with respect to

invention, prior art and the other contentions here made by the defendants. Murray Ohio Mfg. Co. v. E. C. Brown Co., 124 Fed. 2d 426, 428; Warner Bros. Co. v. American Lady Corset Co., 136 Fed. 2d 93.

The further contention of the plaintiffs that there was infringement of the California registered trade-mark and unfair competition in the sale by the defendants of their product: [116] The evidence fails to establish this claim. The trade-mark "Chip Steaks" is merely descriptive and is known to the trade by that name, and the plaintiffs cannot have all exclusive rights to it. Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 83 L.ed. 73. The trade-mark was improperly registered in the State of California, Sections 14242, 14246, California Code. Further the evidence here does not support the claim of unfair competition in the sale of Camp Steaks. There does not seem to be confusion between plaintiffs' and defendants' goods in the sale thereof, and the defendants have not engaged in any acts of unfair competition or infringement of the alleged trade-mark.

The further conclusion is reached under the evidence that the defendants are not entitled to recover from the plaintiffs upon their counterclaim as the evidence is conflicting and confusing.

Decree will be entered for the defendants and against the plaintiffs that plaintiffs are not entitled to recover against the defendants, and that the defendants are not entitled to recover on their counter-

claims; and that defendants recover the sum of \$20,000.00 as attorney fees and costs against the plaintiffs.

Counsel for defendants prepare Findings and Decree.

[Endorsed]: Filed May 23, 1949. [117]

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[Title of District Court and Cause.]

### PETITION BY THE PLAINTIFFS

To the Honorable Charles C. Cavanah, United States District Judge:

The undersigned plaintiffs respectfully submit that the intent of Congress in the patent statute allowing for attorney's fees, is to restrict such an award to those cases which are not brought or conducted in good faith or with a sound basis.

It is believed that it would be an extremely dangerous precedent and would be a serious deterrent to industrial and commercial advancement and development of our country if the courts should allow extremely large and penalizing attorney's fees against a patentee who in good faith seeks a determination of what he honestly believes to be an infringement of a patent that is *prima facie* valid, and especially where the validity of that patent has been generally acquiesced in for years. Such potential award would, in most cases, prevent an ordinary patentee from asserting his legal right accorded him by his patent for fear of bearing a burden of

an extreme penalty in the form of attorney's fees, in event of failure. Patent litigation would become a "rich man's" privilege.

Inventors who in good faith, and in reliance upon the patent laws, expend their time and money to try to advance a certain field of human endeavor would be subject to the danger of bankruptcy if the Court should happen to declare the patent to be invalid on unexpected grounds and as a penalty assessed large attorney's fees which to the ordinary inventor is a back-breaking burden to the point of bankruptcy. A patentee should be able to resort to the courts without fear of being penalized by having very heavy attorney's fees allowed against him in case he should be honestly mistaken in his belief as to the validity of his patent.

It is respectfully submitted that attorney's fees should be allowed only in aggravated cases, similar to the practice of the courts in exercising their discretionary powers to treble damages in a patent case where the infringement of a defendant is found to be wilful and deliberate. Even despite this power in the court, it very rarely happens that treble damages are awarded, even in extreme cases.

The appearance of an infringer leaves the patentee to an election of two alternatives, (1) to permit the infringement and resulting detriment to the business, which naturally tends to decrease and/or eliminate net return, or, (2) to assert his rights based upon his patent in a court of law, with a possible heavy penalty if the patent which he thought was valid (because it was issued to him by the

United States Patent Office) is finally held to be invalid. These plaintiffs are unable to bear the burden of paying the attorney's fees awarded in this case without disastrous or near disastrous results.

The three plaintiffs in this action are typical of ordinary patentees and licensees. Dubil is a small town builder with a modest income. Hubik is a butcher in his own small meat market. Shores operates his own meat business as an individual. All three were acting in good faith and relied upon the patent and upon the recognition by others of its validity, over a number of years.

There existed honest and substantial reason to believe the patent in suit was valid, especially in view of the defendant Camp's undenied efforts to try to obtain a license under the patent in suit for \$2500.00 from the agent Carpenter, and after the war Camp trying to buy plaintiff Shores' business and license under the patent in suit.

It is believed the plaintiffs have shown their good faith in this case so that in an humble spirit they approach this Honorable Court with the respectful plea that they should not be punished for their honest opinion by being assessed what is to them an enormous and oppressive amount of attorney's fees.

WILLIAM J. DUBIL and

EDWARD J. HUBIK

By /s/ EDWARD J. HUBIK

/s/ EARL F. SHORES

Receipt of Copy acknowledged.

[Endorsed]: Filed July 22, 1949.

[Title of District Court and Cause.]

DONALD C. RUSSELL AFFIDAVIT RE  
PRIOR DECISIONS OF THIS COURTState of California,  
County of Los Angeles—ss.

Donald C. Russell, of the aforesaid County and State, being first duly sworn, on oath deposes and says that he is an attorney-at-law, practicing in Los Angeles, California, and that he has made an investigation of what he believes to be all the patent cases filed since August 1, 1946 (the date that 35 U.S.C.A. Sec. 70, relating to attorney's fees in patent infringement cases first went into effect), by the United States District Court, for the Southern District of California, Central Division, with reference to judgments for attorney's fees, apart from the case of Dubil v. Camp, No. 8649-Y.

The following is a list of patent cases relating to attorney's [139] fees that affiant was able to compile by checking active and closed dockets of said Court:

- (a) Brown v. McGill                          No. 5470-BH  
Trial appeared to be two days. Held for plaintiff. Each party bore expenses.
- (b) Macpherson v. Radcliff                No. 5484-PH  
Held for plaintiff. No attorneys' fees.
- (c) Lasar v. Kent Engineering Co.                          No. 5549-WM  
Trial more than one week. Held for plaintiff. Attorneys' fees not awarded.

- (d) Gibbs v. Hicks dba. Skill-A-Line  
No. 5565-W  
Injunction decreed. Attorney's fees not awarded.
- (e) Marvin Landplane Co. v. Dawson Mfg. Co.  
No. 5785-WM  
Attorneys' fees were reserved. Not found awarded.
- (f) Byron-Jackson v. Ingersoll Rand  
No. 4023-WM  
Pre-trial two days. Trial appeared to be seven days. Held for defendant. Attorneys' fees \$3,000.00.
- (g) Helbrush & Monogram Mfg. Co. v. Finkle  
No. 5453-O'C  
Trial one day. Held for Defendant. Attorneys' fees \$500.00. Harris, Kiech, Foster & Harris, defendant's attorneys in the present case, filed a brief Amicus Curiae objecting to \$500.00 as attorney's fees. See entire brief in another affidavit filed contemporaneously herewith.
- (h) Gibbs v. Faulkner No. 5566-Y  
Trial appeared to be for three days. Held for plaintiff. Attorneys' fees \$500.00. [140]
- (i) Gate-Way, Inc. v. Hillgren No. 6778-O'C  
Pre-Trial one day. Trial one day. Held for defendant. Attorney for defendant asked \$3,300.00 fees. Awarded \$1,500.00. Motion

entered by plaintiff to amend Findings of Fact and Conclusions of Law. Still pending.

- (j) Reverse Stitch v. California Reverse Stitch  
No. 7398-O'C  
Pre-trial one day. Trial two or four days; argument in court as to trial time. Held for plaintiff. Attorneys' fees \$500.00.
- (k) Long v. Deats & Acme Appliance  
No. 7701-PH  
Trial appeared to be four days. Held for plaintiff. Attorneys' fees denied.
- (l) Maitlen & Benson v. Thermacote  
No. 7820-PH  
Jury trial appeared to be six days. Directed verdict for plaintiff. Each party bore own expenses.
- (m) Watt v. Mattson's of Hollywood  
No. 8181-BH  
Trial two days. Held for plaintiff. Attorneys' fees \$2,500.00.
- (n) Polizzi v. Firestone No. 5927-WM  
Pre-trial one day. Trial one day. Attorneys' fees \$800.00.
- (o) Ward & Butler v. Dunham No. 6192-WM  
Trial appeared to be three days. Held for defendant. Attorneys' fees \$500.00. [141]

- (P) Blanchard v. Pinkerton No. 7734-Y  
Trial appeared to be three days. Held for defendant. Attorneys' fees not awarded.
- (q) Moebs v. Estate of Jesse F. Brown No. 7950-BH  
Held for defendant. Attorneys' fees not awarded.
- (r) National Lead Co. v. Standard Oil No. 4112-B  
National Lead Co. v. Shell No. 4113-B  
These cases were consolidated. Trial appeared to be twenty-eight days. Attorneys' fees were mentioned but left blank in the record. Also left blank in COB 49/102 and COB 49/104 of each case respectively.
- (s) York Corp. v. Refrigeration Engineering No. 4166-PH  
Trial appeared to be eight days. Attorneys' fees were mentioned but not awarded.

It will be noted that in four (4) of the above cases the attorneys' fees were \$500.00, eleven (11) of them granted no attorneys' fees, one of them granted \$800.00, one \$1,500.00, and one \$2,500.00, and the highest ever given by this Court, (apart from *Dubil et al. v. Camp, et al., supra*), were \$3,000.00.

That if the formula sometimes used that \$100.00 per day be awarded attorney's fees, counting the days of trial and an equal number of days of preparation, were applied, this would in the present

case make nine (9) days of trial, nine (9) days of preparation, and four (4) hours of preliminary hearings, or a total of less than nineteen (19) days. At \$100.00 per day, by this rule the attorneys' fees would be less than \$1,900.00. If eighteen (18) and a fraction days were charged for, the sum of \$20,000.00 would be more than \$1,000.00 per day for office work [142] and court work. That, it is submitted, would appear excessive and out of line with the attorneys' fees heretofore entered by this Court.

Another view of the case is that defendants in any event would only be entitled to attorneys' fees on the patent end of the case and are not entitled to attorneys' fees on the trade-mark infringement or the unfair competition part of the case. Attorneys' fees undeniably were never awarded for trade-mark and unfair competition cases prior to August, 1946. A statute in derogation of the common law should, in accordance with the well-known rule, be strictly construed. Therefore, the statute allowing attorneys' fees in a "patent case" should, it is submitted, be limited to patent matters and not extended to trade-mark and unfair competition matters.

Assuming that the trade-mark infringement and unfair competition phases of this case took one-half of the time, that would mean that the \$20,000.00 would be awarded for about four and one-half (4½) days, plus about four (4) hours for the court work on preliminary motions. An equal amount of preparation would make less than ten (10) days for

the trial and preparation of the patent side of this case, or over \$2,000.00 per day for such work.

/s/ DONALD C. RUSSELL.

Subscribed and sworn to before me this 22nd day of July, 1949.

[Seal] /s/ VESTA NELSON,

Notary Public in and for said County and State.

Receipt of copy acknowledged.

[Endorsed]: Filed July 22, 1949. [143]

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[Title of District Court and Cause.]

DONALD C. RUSSELL AFFIDAVIT RE  
PRIOR PROCEEDINGS IN THIS CASE

State of California,  
County of Los Angeles—ss.

Donald C. Russell, of the aforesaid County and State, being first duly sworn, on oath deposes and says that he is an attorney-at-law, practicing in Los Angeles, California; that he has made a careful search of the file in the above entitled case and finds the following facts from such file, or by being present on such occasions:

Affiant carefully examined the docket, record and file in the present case of Dubil v. Camp, supra, and as a result thereof states that no pre-trial was conducted in said case. That as a result thereof finds that only two plant inspections were made in said

case: one consisted of a half day at the plant of the [145] of the defendant Camp, on the afternoon of March 24, 1949. The other plant inspection was at the plant of the plaintiff Shores. That the plaintiff's counsel was at the said plaintiff's plant less than one hour at the time of such inspection, which was on March 25, 1949. That no accounting has been had in said case. That the following depositions were taken:

Name	Date Taken	Estimated Time (Hrs.)
1. Rayford Camp	January 18, 1949	1 $\frac{3}{4}$
2. Earl F. Shores	January 18, 1949	1 $\frac{1}{2}$
3. Edward J. Hubik	January 19, 1949	1
4. Rayford Camp	January 27, 1949	$\frac{1}{2}$
5. William J. Dubil	January 27, 1949	1
6. Rayford Camp	February 11, 1949	1 $\frac{1}{4}$
7. Earl F. Shores	February 25, 1949	1 $\frac{1}{6}$
8. Edward Munyon	February 25, 1949	$\frac{1}{2}$
9. William H. Sloan	March 2, 1949	$\frac{1}{2}$

(Taken on written interrogatories in Chicago. No counsel was present.)

That the trial of this case took nine days, to wit, March 28 to 31, and April 1 and 4 to 7, 1949. That the trial was conducted by the Honorable Charles C. Cavanah, District Judge from the State of Idaho. Judge Cavanah did not sit in said case and was not present at any of the proceedings therein prior to the first day of the trial thereof, to wit, March 28, 1949.

That on November 1, 1948, there was a hearing before the Honorable Leon R. Yankwich, District Judge of this Court, on the defendants' Motion brought by the defendant to dismiss the second count of plaintiffs' Complaint for lack of jurisdiction.

tion of this Court. That said Motion was decided adversely to the defendants. The hearing took less than one (1) hour.

On February 28, 1949, there was a hearing before the said Judge Yankwich on plaintiffs' objections to defendants' 28 interrogatories. The plaintiffs' answered 7 interrogatories without objection and objected to 21 of them. Of those 21, the Court stated that the plaintiffs did not have to answer  $15\frac{2}{3}$  of them, and ordered the plaintiffs to answer  $5\frac{1}{3}$  of the 21 interrogatories objected to. The latter hearing took less than one (1) hour.

The only other hearings in said case were on March 17th and March 21st, 1949, respectively, on plaintiffs' Motion to inspect defendants' plant and plaintiffs' Motion to strike paragraph "M" from the Answer to the Amended Complaint and Counter-claim. The Court granted the plaintiffs' Motion to inspect defendants' plant and permitted the defendant to amend said paragraph at said hearing, and after it was amended, denied the Motion to strike said paragraph. Said hearings each took approximately one (1) hour or less.

/s/ DONALD C. RUSSELL.

Subscribed and sworn to before me this 22nd day of July, 1949.

[Seal]      /s/ VESTA NELSON,  
Notary Public in and for said County and State.

Receipt of copy acknowledged.

[Endorsed]: Filed July 22, 1949. [147]

[Title of District Court and Cause.]

DONALD C. RUSSELL AFFIDAVIT RE  
HARRIS, KIECH, FOSTER & HARRIS  
BRIEF ON ATTORNEYS' FEES

State of California,  
County of Los Angeles—ss.

Donald C. Russell, of the aforesaid County and State, being first duly sworn, on oath deposes and says that he is an attorney-at-law, practicing in Los Angeles, California; that the following is a brief that Harris, Kiech, Foster & Harris, Esqs., counsel for the defendants here, filed as Amicus Curiae in the case of Helbrush et al. v. Finkle, No. 11,761, in the United States Circuit Court of Appeals for the Ninth Circuit, about thirteen months ago, relating to attorneys' fees under the new statute (35 U.S.C.A. § 70). That brief was joined in by C. G. Stratton, counsel for plaintiffs in the instant case, and eleven other attorneys in Los Angeles, San Francisco, and Stockton, [129] California. That said brief reads in full as follows:

"Brief As Amicus Curiae"

"It is an Abuse of the Trial Court's Discretion to Award Attorneys' Fees to a Prevailing Defendant Sued for Infringement of Letters Patent Unless There is Some Evidence of Special Circumstances Justifying Such Award. (All underlined matter printed in black-face in original brief.)

"In a patent infringement action attorneys' fees may be awarded by the Trial Court in its discretion

pursuant to 35 U.S.C.A. 70, as amended in 1946, which provides in part:

" . . . The Court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.'

"The statute does not imply that attorneys' fees should in every instance be awarded the prevailing party but requires the Trial Court to apply its best judgment to a determination of the proper circumstances under which an award should be made; and in doing so the Trial Court must act in conformity with established precedent and the intent and purpose of the statute conferring such discretion. Action by the Trial Court, according to its own will or pleasure without reference to determining principles, constitutes an abuse of discretion which the Appellate Court may set aside.

Bowles v. Quon, 154 F. (2d) 72, 73 (C. C. A. 9, 1946). [130]

"(a) It Was Not the Purpose of the Amended Statute, 35 U.S.C.A. 70, to Award Attorneys' Fees to the Prevailing Defendant in a Patent Infringement Suit Except Under Special Circumstances Resulting in a Gross Injustice.

"The expressed purpose of Congress in passing the amendment to 35 U.S.C.A. 70, under which the Trial Court made the award, herein, is stated in Senate Report No. 1503, June 14, 1946, which was adopted by the Senate Committee on Patents from a report of the House Committee on Patents. The relevant portion reads as follows:

“ ‘By the second amendment the provision relating to attorney’s fees is made discretionary with the court. It is not contemplated that the recovery of attorney’s fees will become an ordinary thing in patent suits, but the discretion given the court in this respect, in addition to the present discretion to award triple damages, will discourage infringement of a patent by anyone thinking that all he would be required to pay if he loses the suit would be a royalty.

“ *The provision is also made general so as to enable the court to prevent a gross injustice to an alleged infringer. (Italics are ours.)*”

“An infringement suit brought merely to vex or harass the defendant without any substantial likelihood of recovery or reasonable grounds for belief in the validity of the patent or infringement thereof might well result in a gross injustice to an alleged infringer forced at great cost to defend such action. It is suits of this type the statute obviously seeks to thwart by providing the hazard of an additional penalty which may be imposed on those who litigate in bad faith; but for the Trial Court to apply [131] this same penalty to the ordinary patent suitor, who, in good faith and with reasonable chances for recovery, brings his action to protect his due right, is to condemn the innocent with the guilty and thereby negate the beneficial purpose of the amendment. An award of attorneys’ fees by the Trial Court in such an instance disregards the statutory intent and is an abuse of the Court’s discretion.

“(b) The Award of Attorneys’ Fees to the Prevailing Party in a Patent Infringement Suit in the Absence of Special Circumstances Is Contrary to Well Established Precedence.”

“Prior to the enactment of the amendment to 35 U.S.C.A. 70 heretofore quoted, it was long established that an allowance of attorneys’ fees to the successful party in a patent infringement action was improper. The basis of this rule was explained at some length by the Supreme Court in *Oelrichs v. Williams*, 82 U.S. 211; 21 L. Ed. 43 (1872), as resting on sound public policy:

“‘... It is the settled rule that counsel fees cannot be included in the damages to be recovered for the infringement of a patent. *Teese v. Huntington*, 23 How. 2 (64 U.S., XVI, 479); *Whittemore v. Cutter*, 1 Gall. 429; *Stimpson v. The Railroads*, 1 Wall., Jr., 164 . . .’ (p. 45).

“‘... In debt, covenant and assumpsit damages are recovered, but counsel fees are never included. So in equity cases, where there is no injunction bond, only the taxable costs are allowed to the complainants. The same rule is applied to the defendant, however unjust [132] the litigation on the other side, and however large the expensa litis to which he may have been subjected. The parties in this respect are upon a footing of equality. There is no fixed standard by which the honorarium can be measured. Some counsel demand much more than others. Some clients are willing to pay more than others. More counsel may be employed than are

necessary. When both client and counsel know that the fees are to be paid by the other party there is danger of abuse. A reference to a master, or an issue to a jury, might be necessary to ascertain the proper amount, and this grafted litigation might possibly be more animated and protracted than that in the original cause. It would be an office of some delicacy on the part of the court to scale down the charges, as might sometimes be necessary.

*“We think the principle of disallowance rests on a solid foundation, and that the opposite rule is forbidden by the analogies of the law and sound public policy.”* (p. 45) (Italics in last paragraph are ours.)

“The present amendment to 35 U.S.C.A. 70, being in derogation of a long established rule of law forbidding counsel fees, should be strictly construed as making only such change as is clearly indicated by the legislative expression and intent.

Shaw v. Merchants National Bank, 101 U.S. 575, 25 L. Ed. 892 (1880).

Further precedent for the interpretation of the new amendment is the judicial construction placed upon a substantially [133] similar statute relating to attorneys' fees in copyright cases. That statute (17 U.S.C.A. 40), after providing for the allowance of full costs, states:

“In all actions, suits, or proceedings under this title, except when brought by or against the United States or any officer thereof, full costs shall be al-

lowed, and the court may award to the prevailing party a reasonable attorney's fee as part of the costs. (Mar. 4, 1909, c.320, § 40, 35 Stat. (1084).'

"While the language of the two statutes is not identical, they are similar in effect and legal import. The Courts have consistently interpreted the provisions of the copyright statute as discretionary only and have generally refused to award attorneys' fees to the prevailing party except under special circumstances where dictated by equity and good conscience. This Court, for example, in construing the copyright section in *Buck v. Bilkie*. 63 F. (2) 447 (C.C.A. 9, 1933), said:

"Under section 40 of the act (17 U.S.C.A., § 40), "the Court may award to the prevailing party a reasonable attorneys' fee." Any such award is clearly discretionary: We find no abuse of discretion in the denial of attorneys' fees, inasmuch as infringement ceased immediately on what defendant testified to have been the first notice received.' (p. 447).

"Although the amendment to 35 U.S.C.A. 70 is too recent to have received extensive judicial interpretation, in a number of well reasoned District Court opinions counsel fees have been denied in the exercise of the Court's discretion under this section. [134] "In Juniper Mills, Incorporated v. J. W. Landenberger & Co., 76 U.S. P.Q. 300 (Advance Sheet) (D. C. E. D. Pa., 1948), Judge Kirkpatrick, on plaintiff's motion for an award of attorneys' fees, stated:

“ ‘It has never been supported that counsel fees are normally allowable to a successful party as part of the costs. In most, if not all, cases, where statutory authority has been given to the court to allow them, the intention has been to make the allowance something in the nature of a penalty for some sort of unfair, oppressive or fraudulent conduct on the part of the losing party. I think this was the reason why the 1946 amendment made the award discretionary with the court and I believe the court should not award an attorney’s fee as costs in an ordinary normal patent case.’ (p. 300)

“Similarly, in the case of *Lincoln Electric Co. v. Linde Air Products Co.*, 74 Fed. Supp. 293 (D. C., N. D. Ohio, 1947) (75 U.S.P.Q. 267), the Court held that in an ordinary patent action an award to the prevailing defendant was not authorized by the statute:

“‘. . . It is apparent from the wording of the statute and its history that an award of attorneys’ fees should not be made in an ordinary case. The court is invested with discretionary power where it is necessary to prevent gross injustice. The case at bar presents a situation which is not unusual in patent matters. This court finds no special circumstances of gross injustice . . . This Court does not consider that the action by the plaintiff was absolutely [135] unwarranted or unreasonable. Since the award asked by the defendant is contrary to long established practice, a clear showing of the

conditions indicated in the statute must be made to entitle the applicant to the relief sought. The circumstances and conditions surrounding the parties in this litigation do not warrant an award of attorneys' fees to the prevailing party . . .' (p. 294)

"The Lincoln Electric case is quoted with approval by Judge Starr in *National Brass Company v. Michigan Hardware Company*, 76 U.S.P.Q. 186 (Advance Sheet) (D.C., W.D. Mich., 1948). After reviewing extensively the judicial interpretation of the provision permitting attorneys' fees in copyright cases and reasoning from such construction to interpret the new patent provision, the Court concluded:

'A careful review of the pleadings, testimony, and circumstances in the present case clearly indicates that it was the usual and ordinary suit for infringement of patent and that it was instituted in good faith and vigorously prosecuted. The court finds no evidence indicating bad faith or dilatory, harassing or vexatious tactics on the part of the plaintiff. There appear to be no special circumstances and no equitable considerations which would justify an award of attorneys' fees to the defendant . . .' (p. 187)

"It is apparent that a Trial Court in awarding attorneys' fees in the absence of special circumstances, fails to construe the new amendment in accordance with its express purpose and intent and fails to look to the history of the amendment, the judicial interpretation of analogous statutes, [136]

and the decisions of other Courts in determining principles and proper guidance.

"It is submitted that it will be of great assistance to the District Courts of this Circuit, the patent bar, and patent litigants if this Court will clearly state the rule to be that in awarding reasonable attorneys' fees to the prevailing party in accordance with the provision of 35 U.S.C.A. 70, as amended in 1946, the Court should award such fees only in a case involving bad faith or dilatory, harassing, or vexatious tactics on the part of the losing party or similar special circumstances establishing inequitable conduct by such party.

"Dated: At Los Angeles, California, this 19th day of May, 1948.

"Respectfully submitted,

"HARRIS, KIECH, FOSTER &  
HARRIS, WARD D. FOSTER,  
WARREN L. KEARN,

By WARD D. FOSTER,

Amicus Curiae."

/s/ DONALD C. RUSSELL.

Subscribed and sworn to before me this 22nd day of July, 1949.

[Seal] /s/ VESTA NELSON,

Notary Public in and for said County and State.

Receipt of copy acknowledged.

[Endorsed]: Filed July 22, 1949. [137]

[Title of District Court and Cause.]

MEMORANDUM OF DEFENDANTS WITH RESPECT TO PLAINTIFF'S AFFIDAVITS, PETITION, AND OBJECTIONS TO PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW.

Plaintiffs have submitted to this Court a petition, affidavits, and detailed objections to the proposed Findings of Fact and Conclusions of Law heretofore filed by Defendant Rayford Camp in accordance with the Court's request. The main purpose of these documents, it is clear, is to alter the decision of the Court as set forth in the opinion rendered herein on May 23, 1949, particularly with respect to the award to Defendants of attorneys' fees in the sum of Twenty Thousand Dollars (\$20,000.00).

Defendant Rayford Camp, in drafting the proposed findings to which objection is made, has sought to abide by and incorporate the decision actually reached by the Court after a very complete and thorough trial lasting for nine days and followed by lengthy oral arguments. Plaintiffs, on the other hand, are still arguing the case.

By these objections, which are mere arbitrary statements, for the most part, unsupported by references to the record, the Plaintiffs apparently hope to eliminate a sufficient number of findings to weaken the Court's judgment for appeal purposes

and leave but a shred of the evidence or factual structure on which it may be sustained.

In addition, Plaintiffs submit a petition and various affidavits of an employee of counsel, Donald C. Russell, not to correct an alleged error in the proposed findings to bring them in line with the opinion, but to persuade the Court that it decided improperly the amount of attorneys' fees.

Clearly, it is not the purpose of objections to proposed findings to reargue the case, just decided, or petition for a change of decision. Counsel, if he believes the decision is in error as to any point, may, after entry of judgment, move to amend the findings in accordance with Rule 52(b) of the Federal Rules of Civil Procedure or subsequently bring an appeal.

As stated by Judge Yankwich in a recent unfair competition case, *Brooks Bros. v. Brooks Clothing of California, Ltd.*, 5 F.R.D 14 (D.C. S.D.Cal. 1945), in which both sides tried unsuccessfully by objections to findings to persuade the Court more favorably after a lengthy trial and full opinion had been rendered:

"This case has had the fate of all strongly contested cases in which the judgment of the Court, because it does not grant either side all they ask, satisfies neither. This has brought on the very situation which I have sought to avoid—namely, that of having each side attempt, even before the Findings were signed, to change the decision arrived at on May 5, 1945. . . .

\* \* \* \*

“This is contrary to our practice. For it is assumed that when counsel for the prevailing party, on order of court, prepares findings which are unfavorable to him, he does not waive the right to question them on appeal from the judgment which carries them into effect, if the portion of the judgment based on these findings is separable from the portion favorable to him.

“The defendant, in turn, has filed objections, which reach practically every finding, except those which contain narrative facts not in dispute. If allowed, there would be little, if anything, left to sustain the judgment.” (p. 15)

Defendant’s Findings of Fact are fully supported by the evidence, but we hesitate to re-brief and re-argue the case (as Plaintiffs have done in their “objections”) without leave of the Court. If the Court is in doubt as to the propriety of any of our findings, we respectfully ask leave to support them by a further memorandum. Similarly, on the question of attorneys’ fees and costs, we stand ready to establish the many hundreds of hours of work put in by Defendant’s counsel in defense of this unwarranted action, and shall be pleased to have an opportunity to do so.

It is respectfully requested, therefore, that the Court make findings of fact and conclusions of law, and enter judgment, as submitted by Defendant

Rayford Camp in accordance with the opinion previously rendered herein.

Dated: At Los Angeles, California, this 26th day of July, 1949.

HARRIS, KIECH, FOSTER &  
HARRIS,

FORD HARRIS, JR.,  
WARREN L. KERN,

By /s/ FORD HARRIS, JR.,

Attorneys for Defendants.

BODKIN, BRESLIN & LUDDY,  
GEORGE M. BRESLIN,

Of Counsel.

Receipt of Copy acknowledged.

[Endorsed]: Filed July 27, 1949.

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[Title of District Court and Cause.]

## FINDINGS OF FACT AND CONCLUSIONS OF LAW

Pursuant to Rule 52 of the Rules of Civil Procedure and Rule 7 of the Local Rules of the District Court of the United States for the Southern District of California, the Court makes the following findings of fact and conclusions of law.

### Findings of Fact

#### I.

The plaintiffs William J. Dubil and Edward J.

Hubik are citizens and residents of the State of California, and plaintiff Earl F. Shores is a citizen and resident of the State of California, doing business in the County of Los Angeles, State of California, under the fictitious name of Chip Steak Company of Los Angeles, California. [138]

## II.

The defendant Rayford Camp is a citizen and resident of the State of California, doing business in the County of Los Angeles, State of California, under the fictitious name of Rayford Camp & Co. Defendant Camp is the only defendant in this action.

## III.

The patent in suit, United States Letters Patent No. 2,052,221, on Method of Preparing Fresh Meat, was issued on August 25, 1936, to the plaintiffs William J. Dubil and Edward J. Hubik upon application Serial No. 40,416, filed in the United States Patent Office on September 13, 1935 by plaintiff William J. Dubil. No evidence was offered by plaintiffs as to the date of the alleged invention of the subject matter of patent No. 2,052,221, in suit. Consequently, such alleged invention is considered as made on September 13, 1935, the date upon which the application for the patent in suit was filed in the Patent Office. At all times, since prior to the issuance of patent No. 2,052,221, in suit, plaintiffs Dubil and Hubik have each owned an undivided one-half interest therein.

## IV.

The plaintiffs William J. Dubil and Edward J. Hubik, by license agreement dated August 26, 1948, purported to grant to plaintiff Earl F. Shores the exclusive right to practice the method of said United States Letters Patent No. 2,052,221 throughout the County of Los Angeles, State of California, except the cities of Long Beach and Pomona, and except that territory which is bounded on the north by Slauson Avenue, on the south by Century Boulevard, on the west by Santa Fe Avenue, and on the east by Atlantic Boulevard, all in the City of Los Angeles. [139]

## V.

The defendant has employed two methods or processes of preparing fresh meat, one of which has been referred to in this case as defendant's "No. 1 Process", and the other of which has been referred to herein as defendant's "No. 2 Process". Defendant's No. 1 Process generally consists in freezing fresh meat to a slicing temperature, e.g., below 28° F., and then slicing it while at such temperature. Defendant's No. 2 Process generally consists in subjecting fresh meat to a relatively low temperature (e.g., around 0° F.) for a period of time (e.g., fifteen to nineteen hours), then subjecting the meat to a higher temperature (e.g., 28° F. or below) for a second period of time, and then slicing the meat.

## VI.

Defendant's No. 1 Process is generally described

in patent No. 2,052,221 in suit, but is not claimed therein, and plaintiffs admit that it does not infringe any claim of the patent in suit. Plaintiffs admit that neither claim 3 nor claim 5 of the patent in suit is infringed by any process or method practiced by the defendant. Plaintiffs contend, however, that claims 1, 2, 4, and 6 of patent No. 2,052,221, in suit, are infringed by the No. 2 Process practiced by the defendant.

## VII.

The patent in suit, No. 2,052,221, describes and claims a method of preparing fresh meat. Said patent describes, and each of the claims 1, 2, 4, and 6 of the patent claims, a process consisting of a series of steps which, as illustrated in typical claim 1, in sequential order, are: first, freezing fresh meat solid throughout; second, thawing the meat to approximately 30° to 32° F. throughout; and third, slicing the meat into thin slices. [140]

## VIII.

Each of the steps of the process described and claimed in the patent in suit, and the combination of such process steps, as set forth in each of the claims in suit, is old in the art of preparing fresh meat and had been previously taught by the disclosures of: United States Letters Patent No. 1,864,284, to Taylor, issued June 21, 1932, in evidence as Exhibit F-2; United States Letters Patent No. 1,864,285, to Taylor, issued June 21, 1932, in evidence as Exhibit F-3; United States Letters Patent

No. 2,137,897, to McKee, issued November 22, 1938, on application Serial No. 486,737, filed October 6, 1930, in evidence as Exhibit F-4. Claims 1, 2, 4, and 6 of the patent in suit, No. 2,052,221, and each of them, are void and invalid for lack of novelty in view of said disclosures of said prior-art patents.

## IX.

In granting the patent in suit, No. 2,052,221, the United States Patent Office overlooked and did not consider the most pertinent prior-art patents, namely, Taylor, No. 1,864,284, McKee, No. 2,137,897, and McKee, No. 2,140,162, the latter two patents being pending in the Patent Office on applications filed prior to the application for the patent in suit at the time of the grant thereof. The specifications of the applications for said McKee patents No. 2,137,897 and No. 2,140,162, as originally filed in the Patent Office, were substantially identical in all material respects to the specifications appearing in said patents as issued, in evidence as Exhibits F-4 and F-5, respectively. Consequently, said McKee patents No. 2,137,897 and No. 2,140,162 are both prior art as to the invention in suit. Any presumption of validity arising from the grant of the patent in suit, No. 2,052,221, is fully rebutted by the evidence. [141]

## X.

Although the patent in suit discloses and claims a slicing temperature range of 30° to 32° F. in the performance of the process of the patent in suit, such temperature range is within the slicing tem-

perature range of 0° to 32° F. broadly disclosed in the McKee patent No. 2,137,897, defendant's Exhibit F-4, and the mere selection of such narrower slicing temperature limits by the patentee of the patent in suit did not involve any invention.

## XI.

An attempt was made by plaintiffs at the trial to prove invention by a showing of the commercial success of laminated steaks of the type produced by the claimed process. However, the plaintiff Shores and the plaintiff's witness Urton, both of whom testified to substantial production and sales of laminated steaks, did not actually produce such steaks according to the process claimed in the patent in suit, but admitted that they employed a slicing temperature without the 30° to 32° F. range specified in the claims of the patent in suit, and none of the evidence introduced by plaintiffs proved that any commercial success of the laminated steaks was actually attributable to the specific process claimed in the patent in suit.

## XII.

The process defined by claims 1, 2, 4 and 6 of patent No. 2,052,221, in suit, was known and used in the United States by defendant Camp and others more than two years prior to the filing date of the application for the patent in suit and long prior to any alleged date of invention of the subject matter of the patent in suit by the patentee thereof. In the year 1933, defendant Camp and the witness

Rumley were employed as butchers in the meat concession at the Jess Willard Market in Hollywood, California, such meat concession being owned by the witnesses [142] William Fredrick and Laurence Fredrick. Commencing in the year 1933, defendant Camp, the witnesses, Rumley and Laurence Fredrick, and others commercially practiced the process disclosed in the patent in suit and set forth in claims 1, 2, 4, and 6 thereof at said Jess Willard Market, in the making of frozen laminated steak products, and such products were substantially continuously sold commercially by said Fredricks in said Jess Willard Market and in other markets in meat concessions located in Los Angeles, California, and owned by said Fredricks until at least the year 1938. In the year 1934, said Fredricks adopted the name "Strato-Steak" for said products and thereafter used the same thereon in connection with the sale of said products, William Fredrick making application for California State Trade-Mark registration on such name on September 11, 1935, as exemplified by Exhibit P in evidence. One such laminated steak product so made and sold by said Fredricks was composed of five to seven slices of fresh meat, sliced to approximately the thickness of chipped beef, substantially circular in form, and having a diameter of four to seven inches. Such laminated steak products were made by first freezing solid a substantially cylindrical piece of fresh meat, then thawing said meat to a temperature at which it was only partially frozen, and then slicing

the same into very thin slices, and assembling the slices into individual frozen steaks. The fact of such prior knowledge and use by defendant Camp and the witnesses Rumley, William Fredrick, and Laurence Fredrick, is established beyond a reasonable doubt, and adequate notice of such prior knowledge and use was given to plaintiffs prior to the trial of this action.

### XIII.

Although the patent in suit, No. 2,052,221, discloses and specifically claims a slicing temperature range of approximately 30° to 32° F., the evidence established that the claimed process could not be successfully performed within that entire 30° to 32° F. temperature range. Claims 1, 2, 4, and 6 of patent No. 2,052,221, [143] in suit, therefore overclaim the alleged invention, are fatally indefinite, and are invalid.

### XIV.

In connection with the prosecution before the United States Patent Office of the application for patent No. 2,052,221, in suit, the plaintiff Hubik by sworn affidavit, and plaintiff Dubil's attorney, as shown by the file-wrapper Exhibit E in evidence, represented in effect that fresh meat at a temperature of 26° F. to 28° F. could not be sliced to the thickness of ordinary chipped beef, and in reliance upon said representations the Patent Office granted the patent in suit. It was established at the trial that fresh meat at a temperature of 26° to 28° F.

can readily be sliced to such thickness. This was demonstrated in open court by a court room demonstration by defendant and by admissions by the plaintiff Hubik. Furthermore, the plaintiff Hubik admitted that he signed such affidavit with the intent that it be forwarded to the Patent Office in connection with the application for the patent in suit, and that at that time he knew that such fresh meat could be sliced to the thickness of chipped beef when the temperature of the meat was at 28° F. and below. Such representations made by plaintiffs Hubik and Dubil to the Patent Office were, therefore, knowingly false, and the patent was irregularly granted and is invalid as a result thereof. In view of such misrepresentations to the Patent Office, and his demeanor and manner while testifying, the testimony of the plaintiff Hubik in favor of the plaintiffs is entitled to no credibility in this action.

## XV.

Although in a previous decree of this Court in the case of Dubil v. Landau, et al, Case 247-B, the patent in suit was held valid, such prior decree against Landau was by consent of the parties. As indicated by defendant's Exhibits S, T, and U, introduced into [144] evidence, being the Findings of Fact and Conclusions of Law, the report of the Special Master and the Final Decree in that earlier case, the prior art pleaded in the present case was not then before the Court, nor were the other defenses on which findings have hereinabove been made.

## XVI.

The plaintiff Hubik adopted and used the name "Chip Steak" in or about the year 1936 for thinly sliced or laminated steaks produced and sold by said plaintiff, and on September 14, 1936 registered said name as a trade-mark in the office of the Secretary of State of the State of California, Registration No. 20,515.

## XVII.

Since 1938, plaintiff Shores has sold thinly sliced fresh meat molded in a round shape with six of such slices laid one upon another to form a steak, with labels consisting of waxed paper sheets with the name "Chip Steaks" appearing thereon in a curve or arch adjacent a picture of a beef animal, said sheets bearing such mark being placed between the laminated steaks sold by plaintiff Shores.

## XVIII.

Since March, 1948, the defendant Camp has used the trade-mark "Camp Steak" for thinly sliced or laminated steaks moulded in a round shape with six of such slices laid one upon another, the words "Camp Steak" being arranged in a curve or arch adjacent the picture of a head of a beef animal, and defendant Camp imprinted said mark on waxed paper sheets placed between the laminated steaks produced and sold by said defendant. [145]

## XIX.

The evidence establishes that the name "Chip Steaks" is descriptive of the nature of the product.

Such name, the evidence establishes, is the generic term by which laminated or thinly sliced steaks of various manufacture are known to the trade and public alike, and have been so known since long prior to any asserted adoption or use of such name by any of the plaintiffs. The name stands for a product and not for any one of the many numerous makers thereof, and is incapable of exclusive appropriation through acquisition of a secondary meaning pertaining to plaintiffs or their licensees.

## XX.

The defendant's label bearing the trade-mark "Camp Steak", Exhibit 3 in evidence, is so dissimilar to plaintiffs' label bearing the name "Chip Steaks", Exhibit 2 in evidence, in color scheme, legend and format, that no reasonable buyer would be misled by such labels into believing that defendant's goods were those of plaintiffs. The evidence establishes that there has been no confusion in the trade, or among members of the public, as to the source of the products of plaintiffs and defendant, respectively, and no one has been misled in any way by defendant's label, Exhibit 3 in evidence, Defendant Camp is entitled to continue to use his label, Exhibit 3 in evidence, upon laminated steak products without let or hindrance from the plaintiffs or their agents, licensees, or assignees.

## XXI.

Defendant Rayford Camp is not guilty of any infringement of any trade-mark of plaintiffs, or any of them. [146]

## XXII.

It is not a fact that the laminated steaks of plaintiff Shores bearing the name "Chip Steaks", on waxed paper sheets placed between the steaks, are produced in accordance with patent No. 2,052,221 in suit.

## XXIII.

It is not a fact that by reason of any competent or efficient manner in which the plaintiff Shores has conducted his business or by reason of any extensive advertising of laminated steaks sold under the name "Chip Steaks" or by reason of any good will built up, the laminated steaks so labeled and sold to the public by plaintiff Shores have come to be associated with the plaintiff Shores in the mind of the trade or public.

## XXIV.

The laminated steak products of the plaintiffs have certain physical features. They: are substantially circular; have a rosy red color; they approximately five inches in diameter; are made in steaks each having six thin layers; are packaged in cellophane; are sold with wax paper interposed between adjacent steaks; are each provided with a waxed label which is partially folded over the steak; are sold to the meat trade in white butcher paper; have layers which are about one thirty-second of an inch thick, or the thickness of chipped beef. All of said features were old and known in the meat art prior to any use thereof by plaintiffs and neither

separately nor collectively are the subject of any exclusive appropriation thereof by any of the plaintiffs. There is no evidence in this action that the use of any of such features by plaintiffs has come to identify the plaintiffs' goods with the plaintiffs, or any of them, in the mind of the trade or public. The evidence fails to establish that the use by defendant of any such features has misled or confused the trade or public as to the origin of defendant's goods. [147]

## XXV.

Comparing the packages of laminated steaks of plaintiff Shores, plaintiffs' Exhibits 17, 18, and 21, and defendant Camp, plaintiffs' Exhibits 19, 20, and 22, introduced into evidence with their labels and wrappings, plaintiffs' Exhibits 2 and 3, it is clear that they are so essentially different that no one of ordinary intelligence desiring to buy plaintiff Shores's "Chip Steaks" would be misled into buying defendant's "Camp Steaks", and there is no evidence that anyone has been so misled or otherwise confused thereby as to the origin of the goods of the parties.

## XXVI.

It is not a fact that the defendant Camp, since February or March, 1948, has been or is using in the territory of plaintiff Shores or elsewhere, in connection with the sale by said defendant of laminated steaks, labels simulating the labels of plaintiff Shores.

## XXVII.

It is not a fact that the thinly sliced meat of the plaintiffs and of defendant Camp are practically undistinguishable by the ordinary customer at the time the same are offered to the public.

## XXVIII.

It is not a fact that the use of the defendant's labels in connection with the sale of defendant's laminated steaks is calculated to or will deceive the trade or public into believing that they are buying the laminated steaks of the plaintiff Shores when they are, in fact, buying the defendant's said laminated steaks.

## XXIX.

It is not a fact that the acts of the defendant complained of have caused irreparable injury to plaintiffs or any of them. The evidence fails to establish any injury or damage to plaintiffs, [148] or any of them, resulting from the acts of the defendant complained of.

## XXX.

Prior to April, 1941, defendant Camp as an independent contractor sold "Chip Steaks" manufactured by plaintiff Shores. It is not a fact that the route upon which defendant sold "Chip Steaks" was owned or controlled by the plaintiff Shores, or that the list of customers serviced in said route was or is a confidential list or the property of the plaintiff, Defendant ceased the sale of such "Chip Steaks" manufactured by plaintiff Shores in April,

1941, and never sold them again. Defendant Camp did not formulate his plan and intent to manufacture or sell his present product "Camp Steaks", complained of, until the year 1947, more than six years after he ceased to sell the said "Chip Steaks" of plaintiff Shores.

### XXXI.

It is not a fact that in February or March, 1948, or at any other time, the defendant Rayford Camp violated any rights of the plaintiff Shores in and to any list of customers, or after terminating any connection with plaintiff Shores wrongfully solicited any customers whom the defendant Camp had gotten to know by selling them "Chip Steaks".

### XXXII.

Defendant's attorneys have been required to attend in Court on numerous separately contested motions in connection with this action prior to the trial thereof as well as at several pretrial hearings. Numerous depositions and plant inspections have been conducted, requiring the participation of such attorneys in addition to the nine days of trial time. The plaintiffs did not have justifiable cause for filing or prosecuting this action, [149] and trial of this action was unreasonably prolonged by plaintiffs. For all of which, defendant Rayford Camp is entitled to recover the sum of \$20,000.00<sup>1</sup> as attorneys' fees and costs against the plaintiffs, which I find to be a reasonable sum.

1. [In pencil above figures] —\$12,000

## Conclusions of Law

## I.

The Court has jurisdiction of the parties and the subject matter.

## II.

The presumption of validity accompanying the grant of United States Letters Patent No. 2,052,221, in suit, is rebutted and destroyed by the failure of the United States Patent Office to cite and consider the most pertinent prior art in granting said Letters Patent.

## III.

Each of the claims 1, 2, 4, and 6 of United States Letters Patent No. 2,052,221, in suit, is invalid and void for lack of novelty over the prior art.

## IV.

Each of the claims 1, 2, 4 and 6 of United States Letters Patent No. 2,052,221, in suit, is invalid and void for lack of invention.

## V.

Each of the claims 1, 2, 4 and 6 of United States Letters Patent No. 2,052,221, in suit, is invalid and void for the reason that the alleged invention thereof was known and used [150] by others in this country before the patentee's alleged invention or discovery thereof, and was in public use in this country for more than two years prior to the application therefor.

## VI.

Each of the claims 1, 2, 4 and 6 of United States Letters Patent No. 2,052,221, in suit, is invalid and void for indefiniteness in failing to comply with Section 33 of Title 35, United States Code.

## VII.

United States Letters Patent No. 2,052,221, in suit, and each of the claims thereof, is invalid and void for the reason that said patent was granted by the United States Patent Office upon material misrepresentations made to said Office to induce the issuance thereof.

## VIII.

The name "Chip Steak", or "Chip Steaks", is a generic term which is descriptive in nature, and plaintiffs have not acquired any exclusive right to the use thereof.

## IX

The name "Chip Steak" was improperly registered as a trade-mark in the State of California under Section 14,242 of the Business and Professions Code of the State of California and said registration thereof is invalid and void and should be cancelled pursuant to Section 14,246 of said Code.

## X.

Defendant Rayford Camp has not infringed any trade-mark of the plaintiffs, or any of them. [151]

## XI.

Defendant Rayford Camp has not engaged in any

unfair trade practices or unfair competition with plaintiffs, or any of them.

### XII.

Defendant Rayford Camp has not violated any confidential relationship with plaintiff Earl F. Shores nor appropriated to himself any trade secrets or secret and confidential customer lists belonging to said plaintiff.

### XIII.

Defendant Rayford Camp is entitled to judgment against the plaintiffs and each of them, dismissing the amended complaint herein and each of the counts therein stated.

### XIV.

Defendant Rayford Camp is entitled to recover reasonable costs and attorneys' fees against the plaintiffs or any of them, such costs and attorneys' fees to be in the amount of fifteen thousand dollars (\$15,000.00).

### XV.

Plaintiffs are entitled to judgment against the defendant Rayford Camp, dismissing the counter-claims set forth in his amended answer.

Judgment will be entered accordingly.

Dated: . . . . ., . . . . ., this 2nd day of August, 1949.

/s/ CHARLES C. CAVANAH,  
Judge.

Receipt of copy acknowledged.

[Endorsed]: Filed Aug. 4, 1949. [152]

In the United States District Court, Southern  
District of California, Central Division

Civil Action No. 8649-Y

WILLIAM J. DUBIL, EDWARD J. HUBIK, and  
EARL F. SHORES,

Plaintiffs,

vs.

RAYFORD CAMP & CO., RAYFORD CAMP,  
JOHN DOE, JANE DOE, and JOHN DOE  
CO.,

Defendants.

## JUDGMENT

This cause came on to be heard on November 1, 1948, February 28, 1949, March 21, 1949, March 28, 29, 30, 31, 1949 and on April 1, 4, 5, 6, and 7, 1949, and was tried in open Court, and upon consideration thereof and for good cause shown, it is hereby ordered, adjudged, and decreed as follows:

### I.

That United States Letters Patent No. 2,052,221, granted August 25, 1936, to William J. Dubil, for Method of Preparing Fresh Meat, is invalid and void at law as to all of the claims thereof.

### II.

That Trade-Mark Registration No. 20515, issued by the State of California to Edward J. Hubik on September 14, 1936, is invalid and void and should

be canceled pursuant to Section 14246 of the Business and Professions Code of the State of California.

### III.

That defendant Rayford Camp has not infringed any trade-mark of the plaintiffs, or any of them.

### IV.

That defendant Rayford Camp has not engaged in any unfair trade practices or unfair competition with plaintiffs, or any of them.

### V.

That the Bill of Complaint and the Amended Complaint are hereby dismissed with prejudice.

### VI.

That the Counterclaims of defendant are hereby dismissed with prejudice.

### VII.

That defendant Rayford Camp shall recover from the plaintiffs, jointly and severally, attorney's fees in the sum of \$15,000.00, and costs.

Dated: This 2nd day of August, 1949.

/s/ CHARLES C. CAVANAH,  
United States District Judge.

Receipt of copy acknowledged.

[Endorsed]: Filed and entered Aug. 4, 1949.

[Title of District Court and Cause.]

## AFFIDAVIT OF C. G. STRATTON

State of California,  
County of Los Angeles—ss.

C. G. Stratton, of the aforesaid County and State, being first duly sworn, on oath deposes and says:

That he is attorney for the plaintiffs in the case of Dubil, et al., v. Rayford Camp & Co., et al., No. 8649-Y, in the United States District Court, Southern District of California, Central Division.

That at the time the defendants' counsel served on the undersigned the Findings of Fact and Conclusions of Law filed in said case, no pencil marks appeared between lines 2 and 3 on p. 13 thereof, and more particularly the pencilled notation of “\$12,000.00” above the typewritten “\$20,000.00,” was not in said Findings at the time of said service. That upon the return of said Findings by the Trial Judge in said case, the pencilled notation “\$12,000.00” appeared above the typewritten figures “\$20,000.00.” That subsequent to the time of service of said Findings upon the plaintiffs, no one has had the legal right to enter said note of “\$12,000.00” in the Findings except the said Trial Judge.

That on p. 15 of said Conclusions of Law, in the third line of paragraph XIV, above “fifteen” there appears the word “twelve” which has been mostly erased, but the “twelve” can still be seen upon close examination. That between lines 3 and 4 of paragraph XIV, the figures “\$12,000.00,” although

mostly erased, still appear above the typewritten “\$15,000.00” upon close examination.

/s/ C. G. STRATTON.

Subscribed and sworn to before me this 11th day of August, 1949.

[Seal] /s/ VESTA NELSON,  
Notary Public in and for the County of Los Angeles,  
State of California.

Receipt of copy acknowledged.

[Endorsed]: Filed August 16, 1949.

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[Title of District Court and Cause.]

**PETITION TO STAY EXECUTION  
ON JUDGMENT**

Come now the above named plaintiffs and respectfully petition this Honorable Court for an Order staying the execution on the Judgment in the above case until the hearing set for Thursday, August 18, 1949, at 10:00 a.m., and as grounds therefor the plaintiffs show the following:

1. That the plaintiffs intend immediately upon the fixing of the supersedeas bond herein, to file a Notice of Appeal from the Judgment in this case, accompanied by the bond fixed by this Honorable Court.
2. That the filing of the Notice of Appeal has been delayed pending the fixing of the amount of the supersedas bond for the appeal in this case.

3. That the plaintiffs have been diligent in preparing for the appeal in this case. That this petition is not interposed for the purpose of delaying the appeal, and is made in good faith.

Dated this 16th day of August, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

So Ordered, this 16th day of August, 1949.

/s/ LEON R. YANKWICH,  
U.S. District Judge.

[Endorsed]: Filed August 16, 1949.

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[Title of District Court and Cause.]

NOTICE OF HEARING OF PETITION TO FIX  
AMOUNT OF SUPERSEDEAS BOND

To the above named defendants, and Harris, Kiech,  
Foster & Harris, Esqs., and Bodkin, Breslin &  
Luddy, Esqs.,

Greetings:

Please take notice that on Monday, August 22, 1949, at 10:00 o'clock a.m., or as soon thereafter as counsel can be heard, the plaintiff will present to this Honorable Court the annexed Petition to Fix Amount of Supersedeas Bond herein.

Dated at Los Angeles, California, this 11th day of August, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

[Title of District Court and Cause.]

**PETITION TO FIX AMOUNT  
OF SUPERSEDEAS BOND**

Come now the plaintiffs above named and under Rule 73(d) of the Rules of Civil Procedure, request this Honorable Court to fix a nominal amount for the supersedeas bond for the appeal in this case, or to order that the judgment of \$15,000.00 for attorneys' fees in this case be stayed pending appeal without the necessity of the plaintiffs posting any bond, and as grounds therefor show the following:

1. That the plaintiffs intend immediately upon the fixing of the supersedeas bond herein, to file a Notice of Appeal from the judgment in this case, accompanied by the bond fixed by this Honorable Court.
2. That on such appeal the plaintiffs are going to raise the points, among others, that the entry of a judgment for \$15,000.00 attorneys' fees in this case is excessive, is an abuse by the Court of its discretion, and is out of line with all precedents of this Court. There is no evidence in this case of defendants' attorneys' work other than nine (9) days in court for the trial of this case. There is no evidence in this case of any other work done by defendants' attorneys. There is no evidence as to what amount the defendants have paid their attorneys in this case, how much the defendants owe such attorneys, or how much was charged the defendants for this case.

3. That it would be a severe hardship on the plaintiffs to have to put up a \$15,000.00 bond. It is submitted that the defendants' attorneys are not entitled to an execution for attorneys' fees (as distinguished from a judgment for any other relief) until their services have been completed on appeal. Therefore, execution of attorneys' fees should be superseded pending the outcome of the appeal. Moreover, costs should be taxed in the usual manner and not entered arbitrarily by the Court without any foundation whatever.

4. This Honorable Court is respectfully requested to shorten the period prior to the hearing in this matter, due to the relatively short time required to file a Notice of Appeal, which period is now running.

At the hearing on this matter, the plaintiffs will rely upon the foregoing grounds, the record made in this case, including but not exclusively the affidavits of the said Donald C. Russell on file herein, and on the annexed affidavit of the undersigned.

Dated at Los Angeles, California, this 15th day of August, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

Receipt of copy acknowledged.

[Endorsed]: Filed August 16, 1949.

[Title of District Court and Cause.]

## ORDER RE SUPERSEDEAS BOND

This cause coming on to be heard this 18th day of August, 1949, the Court having considered the plaintiffs' Petition to Fix Amount of Supersedeas Bond, and having heard arguments by counsel for the plaintiffs and defendants and being fully advised in the premises,

Hereby Orders, Adjudges and Decrees that execution upon the judgment in the above entitled action be stayed down to and including Thursday, the 25th day of August, 1949; that after notice and hearing and good cause having been shown, this Court fixes the amount of the supersedeas bond for appeal in this case at One Thousand Dollars (\$1,000); that upon filing a Notice of Appeal and upon the posting of One Thousand Dollars (\$1,000) cash with the Clerk of this Court as a cash supersedeas bond for said appeal, on or before the 25th day of August, 1949, and upon filing of the statements hereinafter referred to, on or before said date, the judgment herein shall be stayed during the pendency of said appeal. That a surety bond in the sum of One Thousand Dollars (\$1,000), approved by this Court, may be substituted for said cash bond. That said statements shall be signed by the plaintiffs herein respectively and shall agree that during the pendency of the appeal in this case the plaintiffs severally will not, without the approval of this Court, nor

without notice to counsel for the defendants in the above case, dispose of the businesses of the said plaintiffs respectively, encumber them, or file voluntary petitions in bankruptcy respectively.

Dated this 22nd day of August, 1949.

/s/ LEON R. YANKWICH,  
United States District Judge.

Receipt of copy acknowledged.

[Endorsed]: Filed August 24, 1949.

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[Title of District Court and Cause.]

#### NOTICE OF APPEAL

Notice is hereby given that William J. Dubil, Edward J. Hubik, and Earl F. Shores, plaintiffs above named, hereby appeal to the United States Court of Appeals for the Ninth Circuit, from the final judgment entered in this action on the 4th day of August, 1949.

Dated at Los Angeles, California, this 18th day of August, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

Receipt of copy acknowledged.

[Endorsed]: Filed August 25, 1949.

[Title of District Court and Cause.]

DESIGNATION OF CONTENTS OF  
RECORD ON APPEAL

Come now the plaintiffs above-named, and designate that the complete record, all the proceedings and evidence of the above-entitled case shall be contained in the record on appeal.

Dated at Los Angeles, California, this 26th day of August, 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

Affidavit of service by mail attached.

[Endorsed]: Filed August 27, 1949.

[Title of District Court and Cause.]

STIPULATION TO EXTEND TIME TO FILE  
RECORD ON APPEAL AND TO DOCKET  
THE APPEAL

It Is Hereby Stipulated by and between the above named parties, by their respective counsel, that the plaintiffs may have down to and including Tuesday, November 22, 1949, within which to file the record on appeal in the above case, and to docket the appeal in the Court of Appeals, for the Ninth Circuit. This Stipulation is based upon the fact that other matters extraneous to this case may effect this appeal prior to said date.

Dated at Los Angeles, California, this 27th day of Sept., 1949.

/s/ C. G. STRATTON,  
Attorney for Plaintiffs.

HARRIS, KIECH, FOSTER &  
HARRIS,  
BODKIN, BRESLIN & LUDDY,

By /s/ [Illegible]

Attorneys for Rayford Camp & Co., and Rayford  
Camp.

The foregoing stipulated extension is hereby granted, this 3rd day of October, 1949.

/s/ LEON R. YANKWICH,  
U. S. District Judge.

[Endorsed]: Filed October 3, 1949.

WILLIAM J. DUBIL, EDWARD J. HUBIK, and  
EARL F. SHORES,

vs.

RAYFORD CAMP & CO., RAYFORD CAMP,  
JOHN DOE, JANE DOE, and JOHN DOE  
CO.

### ATTORNEYS

For Plaintiff:

C. G. STRATTON.

For Defendant:

WARREN L. KERN.

### COMPLAINT FOR INFRINGEMENT OF UNITED STATES LETTERS PATENT No. 2,052,221

Date	Plaintiff's Account	Received	Disbursed
9/16/48	C. G. Stratton .....	16.00	
10/13/48	Treas .....		15.00
1/14/49	Treas .....		.50
8/25/49	C. G. Stratton-Appl. ....	5.00	
10/14/49	Treas .....		5.50

### DOCKET ENTRIES

1948

Sept. 16—Fld Compl Infringmt Letters patent. Issd  
Sums. Md report JS-5.

Sept. 30—Fld Sums—retn svd.

Oct. 5—Md openg rept to Comr Patents.

Oct. 11—Fld stip & ord thereon dfts hv to & inc  
10/30/48 to plead or move.

1948

Oct. 21—Fld dft's not of mo retble 11/1/48 to dism  
2nd count of plf's compl for lack juris.

Nov. 1—Fld plf's pts & auths re dft's mo to dism  
2nd ct of compl. Fld plf's mo to strike  
part of compl. Ent ord denying both mos,  
dft to hv 10 da to ans.

Nov. 10—Fld dft's answer & counterclaim.

Nov. 20—Fld reply plf's Wm J Dubil & E J Hubik  
to dft's counterclaims.

Dec. 6—Ent ord setting trial 3/8/49.

1949

Jan. 11—Fld defts Not of takg depos.

Feb. 7—Fld defts Notice re: use patents during  
trial.

Feb. 8—Fld defts interrog.

Feb. 17—Fld pltfs interrog.

Feb. 19—Fld Stip & ord that pltfs may file amend  
reply. Fld plfs objects to defts interrogs  
with not of hrg thereon, ret 2/28/49.

Feb. 23—Fld defts Not of takg depos of Edw.  
Munion.

Feb. 24—Fld defts memo of pts & auths in oppos  
to pltfs objecs to interrog. Fld answers to  
certain of defts interrog of pltfs Earl F.  
Shores & Edw. J. Hubik.

1949

Feb. 28—Fld ea 3 depos Rayford Camp takn 1/18, 1/27, 2/11/49. Fld plfs answs to certain dfts interrogs. Fld plfs reply auth re plfs objs to dfts interrogs. Ent ord overrulg objs 5-A, 7/10 incl & 16; & sust objs 5-B, 5-C, 11/15 incl, 17/28 incl. Ent ord vacatg settg 3/8/49 & ent ord settg trial 3/28/49 bef J. Cavanah.

Mar. 2—Fld depos of Earl Floyd Shores takn 1/18/49. Fld depos of Edw. Joseph Hubik, takn 1/19/49. Fld depos of Walter Thomas Carey, takn 2/25/49.

Mar. 7—Fld sealed envelope, depos of Wm H. Sloan tkn behalf plfs.

Mar. 8—Fld defts, Rayford Camp Co & Rayford Camp, answer to amend compl & counter-claim.

Mar. 10—Fld pltfs answers to defts interrog V (a), VII, VIII, IX, X & XVI.

Mar. 11—Fld Stip & ord re: flg amend compl. Fld Amend Compl. Fld pltfs Not & Mot retble 3/21/49 to strke.

Mar. 14—Ent ord deft answ plfs interrogs by 3/18/49. Ent ord settg mot plf for inspection for hrg e/17/49 at 1 PM. Fld pltfs mot to inspect. Fld stip & ord amended reply pltfs to counterclaims shall be takn to be reply of last-mentioned pltfs

1949

to the counterclaims set forth in defts answer to amend compl & counterclaim, defts Rayford Camp & Co.

Mar. 16—Fld defts memo in oppos to pltfs mot to strike.

Mar. 17—Fld defts memo in oppos to pltfs mot to inspect. Fld Stip re: copies of letters patent, offered in evid, etc. Ent procs hrg mot pltf fld 3/14/49 for ord of insp. Ent ord grantg mot & ent ord on mot dft that similar inspect may be md of plfs process, on same condns.

Mar. 18—Fld defts answers to pltfs interrog.

Mar. 18—Fld order re: inspec of plants.

Mar. 21—Ent ord amending paragraph "M" dfts answ to amended compl by interlineation; & ent ord denying mot plfs to strike said parag & ent ord parag as amended remain.

Mar. 25—Fld depos of Wm. J. Dubil taken 1/27/49

Mar. 28—Ent proc on court trial before Judge Cavanah, and ent ord contg to 3/29/49, further court trail. Sw. 3 wits for plf. Fld. 1 plf ex.

Mar. 29—Ent proc on further court trial and ord contg to 3/30/49, further court trial. Sw. 1 wit for plf. Fld 6 plf's exs.

1949

Mar. 30—Ent proc on further court trial and ord contg to 3/31/49, further court trial. Sw. 2 wits for plf.

Mar. 31—Ent proc on further court trial and ord contg to April 1, 1949, further court trial. Sw 4 wits for plf. Fld 5 exs for plf.

Apr. 1—Ent proc on further court trial and ord contg to April 4th, 1949, further court trial. Sw 1 wit for plf. Sw 1 wit for deft. Fld 9 exs for plf.

Apr. 4—Ent proc on further court trial and ord contg to 4/5/49, further court trial. Sw. 1 wit. for plf. Fld 6 exs for plf. Enter order for and returned plf. Ex 11 for ident (thermometers in case) to counsel for plf and obtained receipt therefor on file cover. Ent proc on Pet od counsel for plf for OSC re contempt on deft Rayford Camp and ent order denying at this time. Lodged Petition for order to show cause re contempt of Rayford Camp and lodged form of Order not signed by the court. Filed deft's objections to plf's interrogs to William H. Sloan.

Apr. 5—Ent proc on further court trial and ord contg to April 6th, 1949, further court trial. Sw. 1 wit for defts. Fld 19 exs for defts. Ent order for, and returned to

1949

counsel for plf., for destruction, plfs, exs 4, 7, 8, 9, 17, 18, 19, 20, 21 and 22 (meat exhibits) in contaminated condition.

Apr. 6—Ent proc on further court trial, and ord contg to April 7th, 1949, further court trial. Sw. 3 wits for defts. Fld 3 exs for plfs. Fld 3 exs for defts.

Apr. 7—Ent proc on further court trial and ord submitting on briefs to be filed by each side simultaneously in 10 days, and on briefs to be filed by each side simultaneously within 7 days thereafter. Fld 3 exs for plfs. Fld 4 exs for defts.

Apr. 18—Fld plfs brief. Fld defts Brief.

Apr. 25—Fld answering brief of deft. Fld plfs reply brief.

May 3—Fld reptrs transc pcdgs 3/28/49, 3/29, 3/30, & 3/31, 4/1, 4/4, 4/5, & 4/6, & 4/7. (8vols).

May 23—Filed opinion of Judge Cavanah and ent order, pursuant thereto, in favor of the defendants and for counsel for the defendants to prepare Findings and Judgment. Mailed copy of Opinion to Attorney General, and to counsel on each side.

July 11—Fld 9 vols reporters transcript of proc of 3/28/49, 3/29/49, 3/30/49, 4/1/49, 4/4/49, 4/5/49, 4/6/49, 4/7/49, respectively.

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July 11—Fld stip & ord pltfs hv to & incldg 7/22/49  
to file objecs to findgs & judgmt.

July 12—Fld reptrs transc predgs 4/7/49.

July 22—Fld plfs petn. Fld affid Donald C. Russell  
re: prior decisions of this ct. Fld affid  
Donald C. Russell re: prior predgs in this  
case. Fld affid Russell re: Harris, Kiech,  
Foster & Harris brief on attys fees. Fld  
plfs objecs to defts prop findgs, etc. Mld  
orig to Jdg Cavanah.

July 27—Fld defts memo with respect to plfs affids,  
petn & objecs to prop findgs, etc. Mld orig  
to Jge Cavanah.

July 29—Fld reply by plfs to defts memo re objecs  
to prop findgs, etc., & judgt.

Aug. 4—Fld finds fact & concls law & fld & ent  
JBK 59/703 that US Pat 2,052,221 etc.  
is invalid & void & that Trade-Mark Regis  
20515 etc is invalid & void ; that deft Ray-  
ford Camp has not infringed plfs trade-  
mark or engaged in unfair compet, etc.,  
and dismiss compl & amend compl & deft's  
counterclaim, & judgmt favor deft Ray-  
ford Camp for \$15,000.00 atty fees & costs.  
Dktd. Not attys. Made JS 6. Made final  
Pat rept.

Aug. 16—Fld prae for & issd abstr judgmt.

1949

Aug. 16—Fld plts not of hrg of petn to fix amt of supersedeas bond. Fld ord shorten time hrg. petn retble 8/18/49 10 am. Fld petn to stay exec on judgt. Fld affid of C. G. Stratton.

Aug. 17—Fld defts memo with respect to plfs ptn to fix amt of supersedeas bond.

Aug. 18—Ent procs hrg mot plfs to fix amt supersed bd on app. Ent ord plfs file supersed bd on app in amt \$1000 accompanied by stmt plfs under oath to effect that during pend app they will not without approval ct etc dispose of business etc. Ent ord exec jgmt stayed till 5 pm, 8/25/49 & pfs hv till then to file bd & affs.

Aug. 24—Fld order re: supersedeas bond on appeal in amt \$1000.

Aug. 25—Fld plfs not of appeal with recpt svce thereon. Fld supersedeas bond amt \$1000. Fld statmt Earl F. Shores in connection with supersedeas bond. Fld statmt of Edw. J. Hubik. Fld statmt of Wm. J. Dubil.

Aug. 27—Fld desig of contents of record on appeal.

Sept. 1—Fld reptrs transc predgs. 8/18/49.

Oct. 3—Fld stip and ord that plfs hv to & incldg 11/22/49 to file and dkd rec on appeal.

## DEFENDANTS' EXHIBIT S

In the United States District Court, Southern  
District of California, Central Division

No. 247-B Civil

WILLIAM J. DUBIL and EDWARD J. HUBIK,  
Plaintiffs,  
vs.

DAVE LANDAU and BENJAMIN LEVY, a co-  
partnership, doing business under the fictitious  
name of EASTERN TENDERIZED STEAK  
COMPANY,

Defendants.

## FINAL DECREE

This cause coming on to be heard at this term  
of Court, and upon consideration thereof, it is  
Ordered, Adjudged and Decreed, as follows:

1. That United States Letters Patent No. 2,052,-  
221, dated August 25, 1939, being the Letters Patent  
in suit, are good and valid in law.
2. That the plaintiffs are the sole and exclusive  
owners of the entire right, title and interest in and  
to said Letters Patent No. 2,052,221.
3. That the defendant Benjamin Levy, has not  
violated the rights of said plaintiffs under said  
Letters Patent.

Done In Open Court this 11th day of March,  
1940.

/s/ C. E. BEAUMONT,  
U.S. District Judge.

Approved By:

.....  
David B. Head,  
Court Commissioner and  
Special Master.

Approved As To Form:

/s/ SAUL J. BERNARD,  
Attorney for defendant,  
Benjamin Levy.

Judgment entered Mar. 11, 1940.

Docketed Mar. 11, 1940.

Admitted April 7, 1949.

## DEFENDANTS' EXHIBIT T

In the United States District Court, Southern  
District of California, Central Division  
No. 247-B Civil

WILLIAM J. DUBIL and EDWARD J. HUBIK,  
Plaintiffs,  
vs.

DAVE LANDAU and BENJAMIN LEVY, a co-  
partnership, doing business under the fictitious  
name of EASTERN TENDERIZED STEAK  
COMPANY,

Defendants.

FINDINGS OF FACT AND  
CONCLUSIONS OF LAW

## Findings of Fact

## I.

That the ownership of U.S. Letters Patent No. 2,052,221, issued August 25, 1936, is admitted as being in the above named plaintiffs.

## II.

That the said Letters Patent cover a method of preparing fresh meat by which very thin slices of fresh meat may be produced; that the defendants, during several months immediately preceding the filing of this case, were co-partners, doing business under the firm name of Eastern Tenderized Steak Company, in the city of Los Angeles, state of

California; that the defendant Benjamin Levy, did not prepare, or cause to be prepared, fresh meat in a manner covered by any of the claims of said patent, and has not sold or caused to be sold within the state of California, or elsewhere, very thin slices of fresh meat prepared by the method covered by the claims of said Letters Patent.

### Conclusions of Law

#### I.

That the plaintiffs herein are the owners of U.S. Letters Patent No. 2,052,221, issued August 25, 1936.

#### II.

That claims "1 and 2," to "6" inclusive, of said patent, disclose patentable invention and are valid.

#### III.

That it has not been established that the said defendant, Benjamin Levy, has infringed any of the claims of said patent.

Done In Open Court this 11th day of March, 1940.

/s/ C. E. BEAUMONT,  
U.S. District Judge.

Approved By:

.....  
David B. Head,  
Court Commissioner and  
Special Master.

Approved As To Form:

/s/ HAL R. CLARK,  
Atty. for defendants.

By /s/ SAUL J. BERNARD,  
Attorneys for defendant,  
Benjamin Levy.

[U.S. District Court Seal]

Admitted April 7, 1949.

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DEFENDANTS' EXHIBIT U

In the United States District Court for the Southern  
District of California, Central Division

No. 247-C Civil

WILLIAM J. DUBIL, and EDWARD J. HUBIK,  
Plaintiffs,

vs.

DAVE LANDAU and BENJAMIN LEVY, a co-  
partnership, doing business under the fictitious  
name of EASTERN TENDERIZED STEAK  
COMPANY,

Defendants.

REPORT OF SPECIAL MASTER

To the Honorable Judges of the United States  
District Court, Southern District of California,  
Central Division:

The above entitled case was referred to the under-

## Defendants' Exhibit U—(Continued)

signed as special master for hearing and reporting to the Court. An amended answer was filed May 15, 1939. The case was set down for the taking of testimony on May 22, 1939. At that time the following appearances were made: Carlos G. Stratton, Esq. and Hal R. Clark, Esq. for the plaintiffs and Saul J. Bernard, Esq. for the defendants. When the case was called, the defendant Dave Landau, appearing for himself, discharged his counsel of record. Counsel thereupon withdrew. Defendant Landau thereafter entered into a stipulation with plaintiffs whereby he admitted validity of the patent in suit and that he had infringed the patent. A consent decree followed and was filed May 26, 1939. The case then proceeded against the defendant Benjamin Levy as an individual. Hereafter he is referred to as the defendant. The master now reports to the Court:

This is an action for infringement of Letters Patent No. 2,052,221 entitled "Method of Preparing Fresh Meat". The patent was issued to William J. Dubil, the applicant, and Edward J. Hubik, the assignee of a one half interest.

## The Patent In Suit

The patent describes a method of preparing very thin slices of meat. The object of this is to cut through the fibers of the meat so that when several of the thin slices are placed together to make a steak the resultant product is tender. In this manner the

**Defendants' Exhibit U—(Continued)**

cheaper and tougher cuts of meat can be utilized to better advantage.

The process is not complicated. A boneless piece of meat, or several pieces compressed together are subjected to temperatures of 18° to 25° for 48 hours or until the meat is frozen solid. The next step is to remove the solidity by partial thawing. This is done by subjecting the meat to temperatures of approximately 30° to 32° for 12 hours. Variations in time and temperature may be made depending upon the fatty content of the meat.

After the last step known as "tempering" the meat is of the proper consistency for slicing. This is done upon the ordinary slicing machine commonly seen in butcher shops. The meat is cut into slices of a thickness known as "No. 2". This is a very thin slice about that of chipped beef. Several slices are then put together to form a single steak or many slices may be compressed into a loaf. This is the finished product.

The following language in the patent is noted (p. 1, 11 9-14)

"Subjecting the meat to these temperatures for a week's time or more would chill the meat throughout to the desired consistency for slicing. However, to cut down the time for preparation, I freeze the meat solid first and then thaw out to said desired temperatures."

There are 6 claims in the patent. All but claim 2

Defendants' Exhibit U—(Continued)  
are in issue. All are drawn to the three steps outlined above. Claim 1 is the broadest:

"1. The method of preparing fresh meat, comprising first freezing the meat solid throughout, then thawing the meat to approximately 30° to 32°F. throughout, and then slicing same into very thin slices."

Claim 3 adds a fourth step to the process:

"3. The method of preparing fresh meat, comprising first freezing the meat solid, then thawing the meat to approximately 30° to 32°F. throughout, slicing same into very thin slices, compressing the slices into a mass of desired shape, and freezing the mass."

Claims 4 and 5 follow Claims 1 and 3 except that a freezing temperature of approximately 18° to 25° is specified.

"4. The method of preparing fresh meat, comprising: subjecting the meat to a temperature between approximately 18° to 25°F., depending on its fatty consistency, for a period of approximately 48 hours, then thawing the meat to approximately 30° to 32°F. for approximately 12 hours, and then slicing same into very thin slices."

"5. The method of preparing fresh meat comprising: compressing together separate pieces of fresh meat, subjecting the meat to a temperature between approximately 18° to 25°F., depending upon its fatty content, for a period of approximately 48

## Defendants' Exhibit U—(Continued)

hours, then thawing the meat to approximately 30° to 32°F. for approximately 12 hours, slicing same into very thin slices, compressing the slices into a desired shape, and then freezing the mass into a loaf."

Claim 6 is more specific as to the thickness of the slice:

"6. The method of preparing fresh meat comprising: freezing the entire mass of fresh meat, including the central part thereof, then thawing the meat for a relatively long interval, to wit, a number of hours, until the entire mass thereof has been raised to a substantially non-frozen condition throughout, to wit, to approximately 30° to 32°F., and then slicing the meat into very thin slices of approximately the thickness of "chipped" beef."

In slicing meat to the thickness specified the problem is to obtain slices of uniform thickness in an unmutilated form. If sliced while frozen, say at 26°, uneven slices and wedge shaped slices are produced. Sliced at temperatures above 33° the meat tends to pull apart with a ragged, uneven slice resulting. The most satisfactory results are obtained by using temperatures between 30° and 32°.

## The Prior Art

Some evidence was offered tending to prove that as early as 1932 the defendant, Benjamin Levy, while engaged in the butcher business in New York City cut frozen meat into thin slices, put them

## Defendants' Exhibit U—(Continued)

together into steaks and sold them. The evidence must be rejected as insufficient to establish the fact. However, if he did practice such a process it was known only to him and was not available to the art and consequently not a part of the art. The same applies to an alleged use at Fredericks Market, Hollywood, California.

Since the hearing of the case the record has been enlarged by the filing of certain papers from the Patent Office proceedings and copies of patents cited by the examiner during the prosecution of the application. These documents have been marked defendants exhibits E to J inclusive. The claims were allowed as presented in the application. The cited patents place no limitations on the claims when read in view of the specifications. Both the freezing and cutting of meat is, of course, old in the art.

The amended answer setting up prior use and invention by Benjamin Levy was filed too late in view of Sec. 4920R.S. to permit consideration of evidence of such prior use and invention as showing anticipation.

It appears that the patentee Dubil was the first to disclose a process whereby very thin slices of meat were produced for the purposes stated in the patent. The patent is presumptively valid and no evidence has been offered that overcomes that presumption.

## Defendants' Exhibit U—(Continued)

## The Defendant's Process

Within five months prior to the filing of this action, the defendants Levy and Landau were engaged in business as the Eastern Tenderized Steak Company. They sold a product made up of several thin slices of beef compressed together to form a steak. Prior to the trial of this case before the master the partnership was dissolved.

For proof of defendant's process plaintiffs rely on (1) the admissions made by the codefendant Landau in the stipulation filed May 26, 1939, (2) the identity of the product and (3) admissions of defendant Levy and his counsel (Plaintiffs Points and Authorities—pp 2-8).

The first contention must be rejected. The stipulation of May 26, 1939 in which Landau admits infringement was entered into after the dissolution of the partnership. It is the rule that admissions made by a co-partner after dissolution of the partnership in regard to past transactions do not charge his copartners. *Thompson vs. Bowman*, 6 Wall. 316, 18 L.Ed. 736. In that case Justice Field said:

“His admission of liability or of an agreement upon which liability might follow possessed no greater efficacy to bind his former copartners than a similar admission of any other agent of the co-partnership after his agency had terminated.”

The second point raises a question of the weight to be given evidence. “Identity of product is some evidence of identity of the process of manufactur-

Defendants' Exhibit U—(Continued)  
ing." Daniel Green Felt Shoe Co. vs. Dolgeville  
Felt Shoe Co., 205 Fed. 745. But standing alone it  
does not constitute proof of infringement. Bene vs.  
Jeantet, 129 U.S. 683, 32 L.Ed. 803.

From the testimony of the witnesses the defendant's process is found to have consisted of the following steps: (1) cuts of beef were placed in a refrigerator for a period of 12 to 24 hours. When in the judgment of Mr. Levy a piece of meat was ready for slicing he removed that piece from the refrigerator. He determined this by pressing his thumbnail into the meat. (2) The meat was placed in a slicing machine and sliced into very thin slices, approximately No. 2. (3) Several slices were then placed together and compressed to form a small steak. When wrapped the product was ready for market.

Samples of both plaintiffs' and defendant's product were offered in evidence (Exhibit 2 is defendant's product, Exhibit 5 is plaintiffs'). The several steaks received in evidence were turned over to the plaintiffs for freezing and preservation. They are available for the Court's inspection.

Defendant's product is made up of seven to ten thin slices of meat. The slices appear to be of uniform thickness but differ in size and shape. Plaintiffs' product is made up of uniform slices. Otherwise there is little difference in the two products.

### Infringement

Defendants, as heretofore found, does not carry the first step of his process further than to chill the

**Defendants' Exhibit U—(Continued)**

meat to a temperature at which it may be sliced into thin slices. This is probably in the range of 30° to 33°. He does not freeze the meat and then thaw to the temperature at which it is sliced. It follows that the defendant does not carry the first step of the process of the patent to completion. The second step of the patented process is not used. The third or slicing step is substantially used by the defendant.

The omission of an element, essential or not, avoids infringement. *Wright vs. Yuengling*, 155 U.S. 47, *Union Water Meter Co. vs. Desper*, 101 U.S. 332. *Lincoln vs. Waterbury Button Co.*, 291 Fed. 594 (aff. 297 Fed. 619). Infringement has been found in cases on process patents where additional steps were added, one step divided into two or more steps, or steps reversed or transported. However no case has been found holding infringement where a step is wholly omitted—see 48 C.J. p 317 et seq. and cases there cited. Even though limitations were unnecessarily written into the claim, if clear, they must prevail. *Philadelphia Rubber Works vs. Portage Rubber Co.* 241 Fed. 108.

Plaintiffs point out that the patent describes chilling of the meat to a desired temperature without freezing and subsequent thawing (patent p 1, 1 9-14). No claim was drawn to cover such a procedure. In *McClain vs. Ortmayer*, 141 U.S. 419, 423 Justice Brown said:

“--- while the specification may be referred to

Defendants' Exhibit U—(Continued)  
to limit the claim, it can never be made available to expand it."

In *Rip Van Winkle Wall Bed Co. vs. Murphy Wall Bed Co.*, 1 Fed. (2) 673, 678, the Circuit Court of Appeals for the Ninth Circuit said:

"--- anything disclosed but not claimed is dedicated to the public."

As heretofore pointed out the defendant does not freeze the meat and then raise it to the temperature for slicing. He does not follow the first step of the patent claims and he omits the second step. Further there was no evidence that defendant froze a mass or loaf of slices. This is a fourth step covered by claims 3 and 5.

It follows that the defendant has not infringed the claims of plaintiffs patent here in issue.

### Conclusions

(1) That this is a civil action under the patent laws of the United States over which this Court has jurisdiction.

(2) That title to Letters Patent No. 2,052,221 is vested in the plaintiffs William J. Dubil and Edward J. Hubik.

(3) That said Letters Patent are good and valid in law.

(4) That the defendant has not infringed said Letters Patent.

## Defendants' Exhibit U—(Continued)

## Recommendation

That a decree be entered in conformity with this report.

Respectfully submitted,

/s/ [Illegible]

Special Master.

[Endorsed]: Filed Aug. 30, 1939.

[U.S. District Court Seal]

Admitted April 7, 1949.

## UNITED STATES PATENT OFFICE

2,052,221

## METHOD OF PREPARING FRESH MEAT

William J. Dubl, Los Angeles, Calif., assignor of  
one-half to Edward J. Hubis, South Gate,  
Calif.

No Drawing. Application September 13, 1935.  
Serial No. 40,416

## 8 Claims. (Cl. 99—194)

My invention relates to a method of preparing meat for the trade, and more particularly to a method of preparing very thin slices of fresh meat.

If fresh meat is within the temperature range at which it is usually kept in a butcher shop for retail trade, it is too soft to be sliced very thin with the automatic meat slicer ordinarily used in butcher shops. The result is that the sheer teeth of the shear apart instead of slicing through them, and hence does not function properly on fresh meat, if very thin slices are desired. If the meat is frozen solid, it has been found too hard to be sliced in a slitter of the character mentioned.

An object of my invention is to prepare fresh meat whereby it may be sliced in one of said ordinary, automatic slicers, and by such means produce very thin slices of fresh meat.

Another object of the invention is to provide a method for taking tough, cheap cuts of fresh meat and slicing it very thin to render it tender and appetizing, and thus saleable at a higher price.

Still another object is to provide a loaf of fresh meat, ready sliced in very thin slices, which have been frozen together in a loaf shaped in section to simulate T-bone, rib, porterhouse steaks, or the like.

Further objects will appear in the course of the following description.

Referring more in detail to my invention, the first step in my method is to take either (a) a single piece of boneless, fresh meat the desired size, or (b) smaller, odd-sized pieces of boneless, fresh meat, which pieces are compressed into a loaf. If the second step is followed the smaller pieces may all be of the same variety of meat or they may be different varieties; to wit, pieces of pork, beef, lamb and/or veal compressed together.

It is important that the meat be boneless since the ordinary butcher shop is not equipped with slicers capable of cutting through bone and at the same time automatically slice very thin slices. Irrespective of whether step (a) or (b) is the first step, the single piece of meat or the compressed loaf of smaller pieces is then frozen.

The meat is frozen sufficiently for it to have rigidly to resist tearing of its fibers, but softness enough to permit it to be sliced on one of ordinary slicers. To produce this particular result, the meat should be from 30° to 32° fall temperatures mentioned herein are Fahrenheit), and approximately the same temperature throughout

the mass. The range of 30° to 32° is to take care of meat having different proportions of fat and lean meat, approximately 32° throughout having considerable fat, approximately 30° throughout has been found satisfactory. The range between these two temperatures is for successive proportions of fat to lean.

Subjecting the meat to these temperatures for a week's time or more would chill the meat throughout to the desired consistency for slicing. However, to cut down the time for preparation, I freeze the meat solid first and then thaw out to said desired temperatures.

Satisfactory results have been produced by subjecting the meat to temperatures of 18° to 25° for 48 hours, the temperature again depending upon the fatty content of the meat. However, lower temperatures may be used for correspondingly shorter periods, if desired, the function of this step being to freeze the meat solid. The next step is to remove the solidity from the meat by partially thawing. I have found that meat kept from 18° to 25° for 48 hours may be brought to the desired consistency by subjecting it to approximately 30° to 32° overnight (e. g., 12 hours), depending again on the fatty content of the meat.

The single piece of fresh meat or loaf of fresh meat is now the proper consistency to be sliced very thin by an ordinary automatic slicing machine commonly used in butcher shops. The thickness is known as a "No. 2" slice by those skilled in the trade, and is about the thickness of what is known in the trade as "chipped beef." The slicing operation is preferably done at a freezing temperature (32°) or less, in order that the thin slices may not thaw out further and lose their natural juices.

In practice these slices are stacked up, and four to six of these thin slices are used as a single steak. They may now be sold and used, or such steaks may be wrapped around and/or pierced by a skewer, and sold and used. However, it is preferred to compress the slices into a loaf while at said freezing temperature. The loaf may be the shape of T-bone, rib or porterhouse steaks, or may be the shape of boneless etc. The loaf is then frozen again, and is now ready for sale. Restaurants especially like meat in this form, for they may keep the loaves in their cooler and slice them down as needed.

It is to be understood that changes may be made in the details of the invention described 66

above, without departing from the spirit and scope of the invention.

Having thus described my invention, what I claim and desire to secure by Letters Patent is:

5 1. The method of preparing fresh meat, comprising first freezing the meat solid throughout, then thawing the meat to approximately 30° to 32° F. throughout, and then slicing same into very thin slices.

10 2. The method of preparing fresh meat, comprising first freezing the meat solid, then thawing the meat to approximately 30° to 32° F. throughout, and then slicing same into very thin slices at a freezing temperature.

15 3. The method of preparing fresh meat, comprising first freezing the meat solid, then thawing the meat to approximately 30° to 32° F. throughout, slicing same into very thin slices, compressing the slices into a mass of desired shape, and freezing the mass.

20 4. The method of preparing fresh meat, comprising: subjecting the meat to a temperature between approximately 18° to 25° F., depending on its fatty consistency, for a period of approxi-

mately 48 hours, then thawing the meat to approximately 30° to 32° F. for approximately 12 hours, and then slicing same into very thin slices.

5 5. The method of preparing fresh meat comprising: compressing together separate pieces of fresh meat, subjecting the meat to a temperature between approximately 18° to 25° F., depending upon its fatty content, for a period of approximately 48 hours, then thawing the meat to approximately 30° to 32° F. for approximately 12 10 hours, slicing same into very thin slices, compressing the slices into a desired shape, and then freezing the mass into a loaf.

6. The method of preparing fresh meat comprising: freezing the entire mass of fresh meat, 15 including the central part thereof, then thawing the meat for a relatively long interval, to wit, a number of hours, until the entire mass thereof has been raised to a substantially non-frozen condition throughout, to wit, to approximately 20 30° to 32° F., and then slicing the meat into very thin slices of approximately the thickness of "chipped" beef.

WILLIAM J. DUBLI.

## PLAINTIFFS' EXHIBIT No. 16

State of California  
Office of the  
Secretary of State

I, Frank M. Jordan, Secretary of State of the State of California, hereby certify:

That on the 14th day of September, 1936, Edward J. Hubik, 3251 Firestone Boulevard, South Gate, County of Los Angeles, State of California, filed in this office a Claim to the Trade Mark "Chip Steak."

I further certify it is set forth in the said Claim that said Edward J. Hubik is located and doing business at said address, being engaged in the business of preparing and selling meat and has adopted for his use a Trade Mark consisting of the words "Chip Steak" which is imprinted upon waxed paper in which slices of meat is wrapped and with which the meat is displayed.

I further certify that on said date the Secretary of State issued his official certificate of registration of said Trade Mark, numbered 20515, under the Great Seal of this State.

In Witness Whereof, I hereunto set my hand and affix the Great Seal of the State of California this 21st day of January, 1949.

/s/ FRANK M. JORDAN,  
Secretary of State.

By /s/ CHAS. J. HAGERTY,  
Deputy.

[The Great Seal of the State of California]

Admitted March 31, 1949.



S 649-5 civ  
 Federal vs Baynard Cook  
 P.D. EXHIBIT  
 No. IDENTIFIED  
 4/1/49 NO. 22 IN E.11  
 District Court, San Diego,  
 California

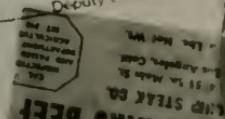
S 649-5 civ  
 Federal vs Baynard C.  
 P.D. EXHIBIT  
 No. IDENTIFIED  
 Date 4/1/49 NO. 12 IN E.11  
 Clerk, U.S. District Court, San Dist C.  
 California

AD. 1-914  
**CHIP STEAKS BEEF CHIP S**  
 CHIP STEAK CO.  
 4131 So. Main St.  
 Los Angeles, Calif.  
 3 Lbs. Net Wt.

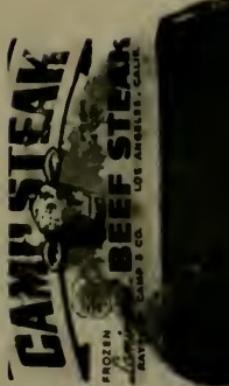


AD. 1-914 CHIP  
 4131  
 Los A  
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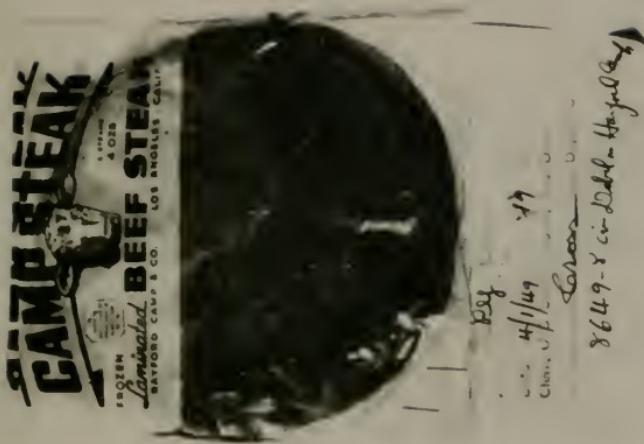
**BEEF CHIP STEAK**  
 AD. 1-914 CHIP STEAK  
 4131 So. Main  
 Los Angeles  
 3 Lbs. Net Wt.





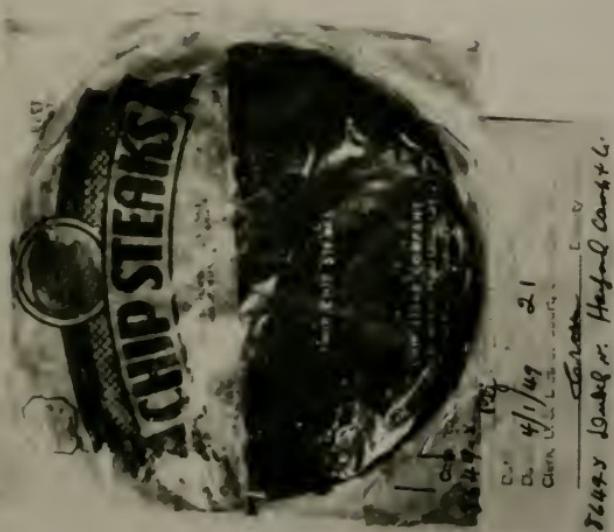






Buy  
U.S. 4/1/49 49  
Chewy  
Lamb

8649-Y Civilian Hospital



C.U.  
D. 4/1/49 21  
Chewy  
Lamb

8649-Y Hospital Hospital



PLAINTIFFS' EXHIBIT No. 27

In the United States District Court, Southern  
District of California, Central Division

No. 247-C Civil

WILLIAM J. DUBIL and EDWARD J. HUBIK,  
Plaintiffs,

vs.

DAVE LANDAU and BENJAMIN LEVY, a Co-  
partnership, doing business under the fictitious  
name of EASTERN TENDERIZED STEAK  
COMPANY,

Defendants.

FINAL DECREE

This cause coming on to be heard at this term of  
Court, and upon consideration thereof, it is

Ordered, Adjudged and Decreed as follows:

1. That United States Letters Patent No. 2052,-  
221, dated August 25, 1936, being the Letters Patent  
in suit, are good and valid in law.
2. That the plaintiffs are the sole and exclusive  
owners of the entire right, title and interest in and  
to said Letters Patent No. 2052,221.
3. That the defendant Dave Landau, one of the  
copartners in the Eastern Tenderized Steak Co., has  
infringed upon claims 1 and 3 to 6, inclusive, of said  
Letters Patent, and each of them, and has violated

the exclusive rights of said plaintiffs thereunder by using the method or process covered thereby and by selling very thin slices of fresh meat prepared by said method or process, all within the City of Los Angeles, County of Los Angeles, State of California, within the six (6) years next preceding the filing of this suit.

4. That a Writ of Injunction issue out of and under the Seal of this Court, directed to the defendant Dave Landau, perpetually enjoining and restraining the said defendant, his associates, attorneys, clerks, servants, agents, workmen, employees and confederates, and each of them, from directly or indirectly practicing, causing to be practiced, or threatening to practice the method or process covered by claims 1 and 3 to 6, inclusive, of said Letters Patent, or any of them, and from directly or indirectly selling the product of such method or process, and from in anywise infringing said Letters Patent and contributing to the infringement of said Letters Patent by others and conspiring with others to so infringe said Letters Patent, in any way whatsoever.

Done In Open Court this 26th day of May, 1939.

/s/ G. COSGROVE,  
U.S. District Judge.

Approved By:

/s/ DAVID B. HEAD,  
Court Commissioner and  
Special Master.

Approved As To Form:

/s/ IRWIN H. ROTH,  
Attorney for defendant  
Dave Landau.

Judgment entered May 26, 1939.

Docketed May 26, 1939.

[U.S. District Court Seal.]

Admitted April 4, 1949.

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[Title of District Court and Cause.]

#### CERTIFICATE OF CLERK

I, Edmund L. Smith, Clerk of the United States District Court for the Southern District of California, do hereby certify that the foregoing pages numbered from 1 to 195, inclusive, contain the original Bill of Complaint; Notice of and Motion to Dismiss the Second Count of Plaintiff's Complaint for Lack of Jurisdiction; Plaintiffs' Motion to Strike Part of Complaint; Answer and Counter-Claim of Defendants Rayford Camp & Co. and Rayford Camp; Notice Under 35 U.S.C. 69; Defendants' Interrogatories Under Rule 33; Plaintiffs' Interrogatories Under Rule 33; Stipulations re and Amended Reply of Plaintiffs William J. Dubil and Edward J. Hubik to Counterclaims of Defendants; Separate Answers of Plaintiffs to Certain of Defendants' Interrogatories; Answer to Amended Complaint and

Counterclaim of Defendants Rayford Camp & Co. and Rayford Camp; Plaintiffs' Separate Answers to Defendants' Interrogatories V(a), VII, VIII, IX, X and XVI; Stipulation and Order re and Amended Complaint; Stipulation and Order re Amended Reply; Stipulation re uncertified copies of Patents; Order re Inspection of Plaintiffs; Defendants' Answers to Plaintiffs' Interrogatories; Defendants' Objections to Plaintiffs' Interrogatories to William H. Sloan; Petition for an Order to Show Cause Why Defendant Rayford Camp Should Not be Held in Contempt of Court and be Punished Accordingly; Form of Order re Contempt; Opinion; Objections to Defendants' Proposed Findings of Fact and Conclusions of Law and Judgment; Affidavit of Donald C. Russell re Prior Decisions of this Court; Affidavit of Donald C. Russell re Prior Proceedings in this Case; Affidavit of Donald C. Russell re Harris, Kiech, Foster and Harris Brief re Attorney's Fees; Findings of Fact and Conclusions of Law; Judgment; Affidavit of C. G. Stratton; Order re Supersedeas; Notice of Appeal; Designation of Record on Appeal and Order Extending Time to Docket Appeal and full, true and correct copies of Minute Orders Entered November 1, 1948, March 28, 29, 30, and 31 and April 1, 4, 5, 6 and 7, 1949 and of the Docket Entries which, together with the original reporter's transcript of proceedings on March 28, 29, 30, and 31 and April 1, 4, 5, 6 and 7, 1949, in nine volumes, and original plaintiffs' exhibits 1, 2, 3, 5, 6, 10, 12-16, 23-36 and original de-

fendants' exhibits A-F, F-1, F-2, F-e, F-4, F-5, F-6, G-U, all inclusive, transmitted herewith, constitute the record on appeal to the United States Court of Appeals for the Ninth Circuit.

I further certify that my fees for preparing and certifying the foregoing record amount to \$8.85 which sum has been paid to me by appellants.

Witness my hand and the seal of said District Court this 18 day of November, A.D. 1949.

EDMUND L. SMITH,  
Clerk.

[Seal] By /s/ THEODORE HOCKE,  
Chief Deputy.

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[Title of District Court and Cause.]

CERTIFICATE OF CLERK TO  
SUPPLEMENTAL TRANSCRIPT

I, Edmund L. Smith, Clerk of the United States District Court for the Southern District of California, do hereby certify that the foregoing documents are the original Plaintiffs' Points and Authorities re Defendants' Motion to Dismiss the Second Count; Notice and Plaintiffs' Objections to Defendants' Interrogatories; Motion to Strike and Points and Authorities; Motion to Inspect and Points and Authorities; Memorandum of Defendants with Respect to Plaintiffs' Affidavits, Petition, and Objections to Proposed Findings of Fact and Conclusions of Law; Petition to Stay Execution of Judg-

ment; Notice of Hearing and Petition to Fix Amount of Supersedeas Bond and Petition by the Plaintiffs which constitute the supplemental transcript of record on appeal to the United States Court of Appeals for the Ninth Circuit.

Witness my hand and the seal of said District Court this 21st day of December, A.D. 1949.

EDMUND L. SMITH,  
Clerk.

[Seal] By /s/ THEODORE HOCKE,  
Chief Deputy.

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[Endorsed]: No. 12403. United States Court of Appeals for the Ninth Circuit. William J. Dubil, Edward J. Hubik and Earl F. Shores, Appellants, vs. Rayford Camp & Co., and Rayford Camp, Appellees. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed November 19, 1949.

/s/ PAUL P. O'BRIEN,  
Clerk of the United States Court of Appeals for the  
Ninth Circuit.

In the United States Court of Appeals  
for the Ninth Circuit

No. 12403

WILLIAM J. DUBIL, EDWARD J. HUBIK, and  
EARL F. SHORES,

Appellants,

vs.

RAYFORD CAMP & CO., RAYFORD CAMP,  
JOHN DOE, JANE DOE, and JOHN DOE  
CO.,

Appellees.

STATEMENT OF POINTS TO BE  
RELIED UPON ON APPEAL

Come now the above-named appellants and show  
this Honorable Court that upon appeal these ap-  
pellants will rely upon the following errors of the  
Lower Court:

I.

That the Lower Court erred in holding that it  
had jurisdiction to try and in trying the second,  
further and additional cause of action set forth in  
the Complaint in this case.

II.

The Lower Court erred in not granting the de-  
fendants' "Motion to Dismiss the Second Count of  
Plaintiffs' Complaint for Lack of Jurisdiction."

## III.

The Lower Court erred in assessing any attorneys' fees whatever in this case.

## IV.

The Lower Court erred in paragraph XXXII of the Findings in finding that defendants' attorneys have been required to attend numerous contested motions prior to trial, or that any pre-trial was conducted in this case, and erred in finding that "numerous" depositions and plant inspections requiring their attendance were conducted, and erred in finding that this action by plaintiffs was unjustifiably filed or prosecuted or was unreasonably prolonged.

## V.

The Lower Court erred in paragraph XXXII of the Findings in finding that either Twenty Thousand Dollars (\$20,000.00) or Twelve Thousand Dollars (\$12,000.00) (the Court was apparently undecided as to which sum he wanted to assess) is a reasonable sum for attorneys' fees and costs in this action; that the Lower Court abused its discretion in such finding without any showing whatever as to what a reasonable attorneys' fee would be in this case; and the Lower Court erred in not having the actual costs taxed, as is the practice in the Lower Court, instead of lumping them together with the attorneys' fees without any proof whatever as to what the actual costs were.

The Lower Court erred in paragraph XV of the Findings in finding that the art pleaded in the pres-

ent case was not before the Court in *Dubil v. Landau and Levy*, No. 247-B; erred in not finding that the subject matter of two of the four prior patents relied upon here were before the Court in *Dubil v. Landau and Levy*; and erred in not holding that the Court previously held the patent in suit valid in a contested case in its decree against Levy in said case.

### VII.

The Lower Court erred in paragraph XIV of the Conclusions, in concluding that the defendant Camp is entitled to recover attorneys' fees and costs in the amount of Fifteen Thousand Dollars (\$15,000.), or any other amount, or that Fifteen Thousand Dollars (\$15,000.00) is a reasonable amount for such.

### VIII.

The Lower Court erred in paragraph VII of the Judgment, in adjudging that the defendant shall recover attorneys' fees and costs in the sum of Fifteen Thousand Dollars (\$15,000.00), or any other amount.

Dated in Los Angeles, California, this 10th day of November, 1949.

/s/ C. G. STRATTON,  
Attorney for Appellants.

[Title of Court of Appeals and Cause.]

**DESIGNATION OF RECORD MATERIAL TO  
THE CONSIDERATION OF THE POINTS  
TO BE RELIED UPON ON APPEAL.**

Come now the above-named appellants and designate the following documents as the record material to consideration of the points to be relied upon on appeal, the pages being the page numbers in the record of the District Court in this case:

Documents	Pages (each inclusive)
Bill of Complaint.....	2-7
Motion to Dismiss the Second Count of Plaintiff's Complaint for Lack of Jurisdiction .....	9-18
Minute Order Entered November 1, 1948.....	20
Plaintiffs' Motion to Strike Part of Complaint .....	21
Answer and Counterclaim of Defendants Rayford Camp & Co. and Rayford Camp..	23-31
Notice Under 35 U.S.C. 69.....	33-34
Defendants' Interrogatories Under Rule 33..	36-41
Plaintiffs' Interrogatories Under Rule 33....	43-44
Stipulation of February 11, 1949.....	46
Amended Reply of Plaintiffs William J. Dubil and Edward J. Hubik to Counter-claims of Defendants .....	47-49

Plaintiffs' Answers to Certain of Defendants' Interrogatories .....	50-52
Answer to Amended Complaint and Counterclaim of Defendants Rayford Camp & Co. and Rayford Camp .....	62-71
Plaintiffs' Answers to Defendants' Interrogatories V(a), VII, VIII, IX, X, and XVI .....	77-79
Stipulation of March 4, 1949 .....	85
Amended Complaint .....	86-92
Stipulation of March 11, 1949 .....	94
Stipulation of March 16, 1949 .....	95-96
Order Re Inspection of Plants.....	97-99
Defendants' Answers to Plaintiffs' Interrogatories .....	100-101
Defendants' Objections to Plaintiffs' Interrogatories to William A. Sloan.....	103-104
Minute Order Entered March 28, 1949.....	109A
Minute Order Entered March 29, 1949.....	109B
Minute Order Entered March 30, 1949.....	109C
Minute Order Entered March 31, 1949.....	109D
Minute Order Entered April 1, 1949.....	109E
Minute Order Entered April 4, 1949.....	110
Minute Order Entered April 5, 1949....	111A-111B
Minute Order Entered April 6, 1949.....	111C

Minute Order Entered April 7, 1949....	111D-111E
Opinion .....	112-117
Donald C. Russell Affidavit Re Prior Decisions of this Court.....	139-144
Donald C. Russell Affidavit Re Prior Proceedings in this Case.....	145-148
Donald C. Russell Affidavit Re Harris, Kiech, Foster & Harris Brief on Attorneys' Fees .....	149-158
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Order Re Supersedeas Bond.....	181-182
Notice of Appeal.....	184
Designation of Contents of Record on Appeal .....	186
Stipulation to Extend Time to File Record on Appeal and to Docket the Appeal, and Order Granting Extension.....	188-189
Docket Entries .....	190-195
Certificate of Clerk of District Court....	Last Page

#### Exhibits

Plaintiffs' Exhibits 1, 16, 27, 28, 29, and 30, and Defendants' Exhibits S, T, and U.

Dated at Los Angeles, California, this 15th day  
of November, 1949.

/s/ C. G. STRATTON,  
Attorney for Appellants.

Receipt of Copy acknowledged.

[Endorsed]: Filed November 19, 1949.

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[Title of Court of Appeals and Cause.]

**COUNTERDESIGNATION BY APPELLEES  
OF ADDITIONAL PARTS OF RECORD**

Appellees hereby designate additional parts of the record which they think are material for the consideration of the appeal herein:

**Documents**

Memorandum of Points and Authorities in Support of Defendants' Motion to Dismiss the Second Count of Plaintiffs' Complaint for Lack of Jurisdiction.

Plaintiffs' Points and Authorities re Defendants' Motion to Dismiss the Second Count.

Plaintiffs' Objections to Defendants' Interrogatories dated February 17, 1949.

Notice of Taking Deposition upon Written Interrogatories dated February 17, 1949.

Defendants' Cross Interrogatories to William H. Sloan dated February 25, 1949.

Motion to Inspect dated March 10, 1949.

Motion to Strike dated March 10, 1949.

Petition for an Order to Show Cause Why the Defendant Rayford Camp Should Not Be Held in Contempt of Court and Punished Accordingly.

Petition by the Plaintiffs.

Memorandum of Defendants' with Respect to Plaintiffs' Affidavits, Petition, and Objections to Proposed Findings of Fact and Conclusions of Law dated July 26, 1949.

Petition to Fix Amount of Supersedeas Bond dated August 15, 1949.

Petition to Stay Execution on Judgment dated August 16, 1949.

Statement of Points to Be Relied upon on Appeal dated November 10, 1949.

Dated: At Los Angeles, California, this 23rd day of November, 1949.

HARRIS, KIECH, FOSTER  
HARRIS,  
FORD HARRIS, JR,  
WARREN L. KERN,

By /s/ FORD HARRIS, JR.,  
Attorneys for Appellees.

Receipt of copy acknowledged.

[Endorsed]: Filed November 25, 1949.